Notice from the European Patent Office dated 1 April 2010 concerning amendment of the Guidelines for Examination in the European Patent Office

1. By decision of the President of the EPO dated 19 November 2009, the Guidelines for Examination have been amended pursuant to Article 10(2) EPC. The amendments are being published in the form of a complete "April 2010" edition of the Guidelines. These have been revised following consultation with the Standing Advisory Committee before the EPO (SACEPO). The amended Guidelines will apply as from 1 April 2010.

2. The updated Guidelines for Examination are published in all three EPO languages on the EPO website (*www.epo.org/patents/law/legal-texts/guidelines.html*) and are available for downloading free of charge. They will also be issued in paper form.

3. The English draft of these Guidelines was published on the EPO website in November 2009 in order to accommodate public interest in gaining the earliest possible access to information on the future amendments.

4. It should be noted that the "April 2010" edition of the Guidelines for Examination is the only valid official version, and supersedes the "April 2009" edition as from 1 April 2010.

Amendments to the Guidelines for Examination in the European Patent Office

5. Since the last complete new edition in December 2007, the Guidelines have been updated in view of the fee changes (see notice dated 1 April 2009, OJ EPO 2009, 336). As part of this update, Parts A - D of the "April 2009" edition were published in electronic form. Part E was not affected by these amendments.

6. The current amendments bring the Guidelines for Examination into line with the new or amended Rules 36, 57, 62a, 63, 64, 69, 70a, 135, 137 and 161 EPC, which enter into force on 1 April 2010 (see Administrative Council decisions CA/D 2/09 and CA/D 3/09 of 25 March 2009 amending the Implementing Regulations to the EPC, OJ EPO 2009, 296, 299, and the notices from the Office dated 20 August 2009, OJ EPO 2009, 481, and 15 October 2009, OJ EPO 2009, 533).

7. It should be noted that the Guidelines have not been fully revised. In one instance, where the Guidelines are still to be revised, several passages do not completely reflect current examination practice. Furthermore, once the work as regards content had been concluded, recent publications or decisions that appeared subsequently could no longer be taken into account. Thus, the relevant notice dated 14 September 2009 (OJ EPO 2009, 486), applies, for example, with respect to the filing of a certified copy of an earlier application to which reference is made, notwithstanding the relevant sections A-II, 4.1.3.1 and A-IV, 1.3.1 of the Guidelines.

8. Amendments to the new or amended rules can be found, in particular, in the following passages:

(a) Rule 36 (Divisional applications): **A-III, 14; A-IV, 1 to 1.3.3; A-VIII, 1.3; C-III, 7.10, 7.11.1 and 7.11.4; C-VI, 1.1.4, 3.4, 5.2 and 9.1.3;**

(b) Rule 62a (Applications containing a plurality of independent claims): **B-III, 3.7, 3.10 and 3.11; B-IV, 2.1; B-VIII, 4 and 5; B-X, 3.1 and 8; B-XII, 7; C-III, 3.3; C-VI, 4.7, 5.2, 5.6 and 8.2;**

(c) Rule 63 (Incomplete search): **B-IV, 1.3; B-VIII, 3 and 5; C-II, 4.9; C-III, 4.1, 5 and 6.3; C-IV, 2.2 and 4.1; C-VI, 4.7, 5.2, 5.6 and 8.2;**

(d) Rule 64 (European search report where the invention lacks unity): **B-VII, 1.2**;

(e) Rule 69 (Information about publication): **A-VI, 2.1;**

(f) Rule 70a (Response to the extended European search report): **A-V, 2.1; A-VI, 2.1, 2.4, 2.5 and 3; B-XII, 1.2, 3.3, 3.9 and 9; C-III, 6.3, 7.10; C-IV, 2.2 and 4.1; C-VI, 1.1, 1.1.1, 3.2, 3.4 and 3.5; E-IX, 5.4 and 5.7;**

(g) Rule 135 (Further processing): **A-III, 14; A-IV, 1.1.1.5; E-VIII, 2.1;**

(h) Rule 137 (Amendment of the European patent application): **B-XII, 2, 2.2 and 9; C-VI, 2.1, 3.1 to 3.3, 3.5.1, 4.1, 4.7, 4.9, 5.2, 5.6, 5.7, 9.1.4 and 14.4;**

(i) Rule 161 (Amendment of the application after entry into the European phase): **A-VI, 2.4; A-VII, 7; C-III, 7.11; C-VI, 3.5.1 and 9.4; E-IX, 4a, 5.1 and 6.3.3.**

9. Amendments were made to chapter **C-IV, 11** concerning inventive step, in which the range of board of appeal decisions cited should be particularly noted.

10. Furthermore, the following sections of the Guidelines have been updated with regard to the following topics:

(a) Electronic filing of documents: **A-II, 1.3, 3.1; A-IV, 1.3.1; A-IX, 3.2; E-IX, 2;**

(b) Filing of priority documents: **A-II, 5.4.3; A-III, 6.7; A-VII, 3.5; C-V, 3.3;**

(c) Supplementary European search report: **A-XI, 9.3.1; B-II, 4.3;**

(d) Publications on the internet: **B-III, 2.5; B-IV, 2.3; C-IV, 6.2; D-V, 3.1.3;**

(e) Postponement of oral proceedings: **E-III, 7.**

11. A number of amendments were made in the light of decisions of the Enlarged Board of Appeal and the other boards of appeal: see **C-III, 3.3, 4.2, 4.12, 4.16, 4.20 and 7.1; C-IV, 2.3.5, 4.1, 4.4, 4.8.1 and 5.4; C.VI, 5.2, 5.3.2 and 9.1.4; D-I, 4; D-V, 6.2; E-III, 7, 8.5 and 8.6; E-VI, 2 and E-X, 1.2**.

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List of Contents

General Part

Contents		a
1.	Preliminary remarks	1
2.	Explanatory notes	1
2.1	Overview	1
2.2	Abbreviations	2
3.	General remarks	3
4.	Work at the EPO	4
5.	Survey of the processing of applications and patents at the EPO	4
6.	Contracting States to the EPC	5
7.	Extension to states not party to the EPC	6

Part A – Guidelines for Formalities Examination

Contents		a
Chapter I	Introduction	I-1
Chapter II	Filing of applications and examination on filing	II-1
Chapter III	Examination of formal requirements	III-1
Chapter IV	Special provisions	IV-1
Chapter V	Communicating the formalities report; amendment of application; correction of errors	V-1
Chapter VI	Publication of application; request for examination and transmission of the dossier to Examining Division	VI-1
Chapter VII	Applications under the Patent Cooperation Treaty (PCT) before the EPO acting as a designated or elected Office	VII-1
Chapter VIII	Languages	VIII-1
Chapter IX	Common provisions	IX-1
Chapter X	Drawings	X-1
Chapter XI	Fees	XI-1
Chapter XII	Inspection of files; communication of information contained in files; consultation of the Register of European Patents; issuance of certified copies	XII-1

Part B – Guidelines for Search

Contents		a
Chapter I	Introduction	I-1
Chapter II	General	II-1
Chapter III	Characteristics of the search	III-1
Chapter IV	Search procedure and strategy	IV-1
Chapter V	Preclassification (routing) and official classification of European patent applications	V-1
Chapter VI	The state of the art	VI-1
Chapter VII	Unity of invention	VII-1
Chapter VIII	Subject-matter to be excluded from the search	VIII-1
Chapter IX	Search documentation	IX-1
Chapter X	Search report	X-1

Chapter XI	The abstract	XI-1
– Annex	Checklist for considering the abstract (see XI, 5)	XI-3
Chapter XII	The search opinion	XII-1

Part C – Guidelines for Substantive Examination

Contents		a
Chapter I	Introduction	I-1
Chapter II	Content of a European patent application (other than claims)	II-1
– Annex	Units recognised in international practice and complying with Rule 49(11) (see II, 4.16)	II-17
Chapter III	Claims	III-1
Chapter IV	Patentability	IV-1
– Annex	Examples relating to the requirement of inventive step – indicators (see IV, 11.13)	IV-43
Chapter V	Priority	V-1
Chapter VI	Examination procedure	VI-1

Part D – Guidelines for Opposition and Limitation/Revocation Procedures

Contents		a
Chapter I	General remarks	I-1
Chapter II	The Opposition Division	II-1
Chapter III	Opposition	III-1
Chapter IV	Procedure up to substantive examination	IV-1
Chapter V	Substantive examination of opposition	V-1
Chapter VI	Procedure for the examination of the opposition	VI-1
Chapter VII	Details and special features of the proceedings	VII-1
Chapter VIII	Decisions of the Opposition Division	VIII-1
Chapter IX	Costs	IX-1
Chapter X	Limitation and revocation procedure	X-1

Part E – Guidelines on General Procedural Matters

Contents		a
Introduction		1
Chapter I	Communications and notifications	I-1
Chapter II	Procedure for amendments to documents	II-1
Chapter III	Oral proceedings	III-1
Chapter IV	Taking and conservation of evidence	IV-1
Chapter V	Derogations from the language of the proceedings in oral proceedings	V-1
Chapter VI	Examination by the EPO of its own motion; facts, evidence or grounds not submitted in due time; observations by third parties	VI-1
Chapter VII	Interruption and suspension of the proceedings	VII-1
Chapter VIII	Time limits, loss of rights, further and accelerated processing and re-establishment of rights	VIII-1
Chapter IX	Applications under the Patent Cooperation Treaty (PCT)	IX-1
Chapter X	Decisions	X-1
Chapter XI	Appeals	XI-1
Chapter XII	Request from a national court for a technical opinion concerning a European patent	XII-1

Chapter XIII Registering transfers, licences, other rights, etc. XIII-1

General Part

Contents

1.	Preliminary remarks	1
2.	Explanatory notes	1
2.1	Overview	1
2.2	Abbreviations	2
3.	General remarks	3
4.	Work at the EPO	4
5.	Survey of the processing of applications and patents at the EPO	4
6.	Contracting States to the EPC	5
7.	Extension to states not party to the EPC	6

1. Preliminary remarks

In accordance with Art. 10(2)(a) of the European Patent Convention (EPC), the President of the European Patent Office (EPO) had adopted, effective as at 1 June 1978, the Guidelines for Examination in the European Patent Office.

These Guidelines have been and will be updated at regular intervals to take account of developments in European patent law and practice. Amended or new text (as compared to the latest previous version only) is indicated by a vertical line in the right-hand margin. Mere deletions are indicated by two horizontal lines in the right-hand margin. Usually, updates only involve amendments to specific sentences or passages on individual pages, in order to bring at least part of the text more closely into line with patent law and EPO practice as these continue to evolve. It follows that no update can ever claim to be complete. Any indication from readers drawing the attention to errors as well as suggestions for improvement are highly appreciated and may be sent by e-mail to: patentlaw@epo.org

The Guidelines for Examination in the European Patent Office are also published by the EPO in an electronic, searchable form on the Internet via the EPO website:

http://www.epo.org

2. Explanatory notes

2.1 Overview

The main body of these Guidelines comprises the following five parts:

Part A: Guidelines for Formalities Examination;

Part B: Guidelines for Search;

Part C: Guidelines for Substantive Examination;

Part D: Guidelines for Opposition and Limitation/Revocation Procedures; and

Part E: Guidelines on General Procedural Matters.

Parts A and C deal with the requirements and procedure for formalities and substantive examination, respectively, regardless of the stage in the procedure. Thus, in particular, Part A covers formalities examination in grant and opposition proceedings.

Part E deals with procedural matters relevant to several or all of the stages in procedure at the EPO.

The following notices relating to this and other recent updates have been published in the Official Journal of the European Patent Office:

Re April 2010 update:	OJ 4/2010;
Re April 2009 update:	OJ 5/2009, 336-337;
Re December 2007 update:	OJ 11/2007, 589 - OJ 11/2007, 592;
Re June 2005 update:	OJ 7/2005, 440 - 443;
Re December 2003 update:	OJ 12/2003, 582 - 585;
Re October 2001 update:	OJ 10/2001, 464 - 465;
Re February 2001 update:	OJ 2/2001, 115 - 116;
Re June 2000 update:	OJ 5/2000, 228 - 234;
Re July 1999 update:	OJ 7/1999, 510 - 522.

It will be noted that each Part of the Guidelines is divided into Chapters, each sub-divided into numbered sections which are further sub-divided into paragraphs. Cross-references to other paragraphs within the same Part are in a standard form quoting in each case the Chapter, section and paragraph number (thus, e.g., III, 6.5 means paragraph 6.5 in section 6 of Chapter III). If the cross-reference is to another Part of the Guidelines it also includes the relevant letter of that Part (thus, e.g., C-III, 6.5 would be used if it were desired to refer to paragraph 6.5 of Chapter III of Part C in, say, Part A).

Marginal references to articles and rules without further identification indicate the Articles or Rules of the European Patent Convention which provides authority for what is stated. It is believed that such references avoid the need for extensive quotation from the EPC itself.

It goes without saying that whenever "his" or "he" is used in relation to examiner, applicant, inventor, etc., this should be understood as "her or his" and "she or he", respectively.

2.2 Abbreviations

In the Guidelines, the following abbreviations are used:

EPC	European Patent Convention
EPO	European Patent Office
OJ	Official Journal of the European Patent Office
Art.	Article
RFees	Rules relating to Fees
WIPO	World Intellectual Property Organization
PCT	Patent Cooperation Treaty
ISA	International Searching Authority
WO-ISA	Written Opinion of the International Search Authority
IPEA	International Preliminary Examining Authority
IPRP	International Preliminary Report on Patentability
IPER	International Preliminary Examination Report
EESR	Extended European Search Report
ADA	Arrangements for deposit accounts
AAD	Arrangements for the automatic debiting procedure
BNS	back-file conversion numerical system
rec.	recital
Prot. Art. 69	Protocol on the Interpretation of Art. 69 EPC
Prot. Centr.	Protocol on the Centralisation of the European patent system and on its introduction (Protocol on Centralisation)
EVL	Electronic virtual library

References to the European Patent Convention (EPC) are references to the European Patent Convention as amended by the Act revising the EPC of 29 November 2000 and the

decision of the Administrative Council of 28 June adopting the new text of the European Patent Convention (OJ EPO Special editions No. 4/2001, pages 56 et seq; No. 1/2003, pages 3 et seq; No. 1/2007, pages 1 to 88) and the Implementing Regulations as adopted by decision of the Administrative Council of 7 December 2006 (OJ Special edition No. 1/2007, pages 89 et seq).

Where necessary, reference is made to the European Patent Convention of 5 October 1973 as amended by the act revising Article 63 EPC of 17 December 1991 and by the decisions of the Administrative Council of 21 December 1978, 13 December 1994, 20 October 1995, 5 December 1996, 10 December 1998 and 27 October 2005.

The reference to Articles and Rules – and their paragraphs – of EPC 2000 will be as follows: "Article 123, paragraph 2" will be: "Art. 123(2)", "Rule 29, paragraph 7" will be: "Rule 29(7)". Articles and Rules of EPC 1973, of the PCT and Articles of the Rules relating to Fees are referred to in a similar way, e.g. "Art. 54(4) EPC 1973", "Art. 33(1) PCT" and "Art. 10(1) RFees" respectively. Only where deemed appropriate, i.e. in order to avoid confusion, will references to Articles and Rules of the EPC be provided with the extension "EPC 2000".

Decisions and opinions of the Enlarged Board of Appeal will only be referred to with their capital letter, their number and the number and page of the Official Journal they were published in, e.g. "G 2/88, OJ 4/1990, 93". Decisions of the Technical Boards of Appeal and the Legal Board of Appeal will be referred to in the same way, e.g., "T 152/82, OJ 7/1984, 301" and "J 4/91, OJ 8/1992, 402", where they have been published in the OJ, and "T 169/88, not published in OJ", if not. It is noted that all decisions and opinions of the Enlarged Board of Appeal and all decisions of the boards of appeal of the EPO are published on the Internet (http://www.epo.org) (see the Notice from the Vice-President Directorate-General 3 dated 3 July 2002, OJ 8-9/2002, 442).

The arrangements for deposit accounts and their annexes, including the arrangements for the automatic debiting procedure plus explanatory notes, are published from time to time as a Supplements to the Official Journal of the EPO.

3. General remarks

3.1 These Guidelines give instructions about the practice and procedure to be followed in the various aspects of the examination of European applications and patents in accordance with the European Patent Convention and its Implementing Regulations (see section 5).

The search and examination practice and procedure as regards PCT applications, as far as the international phase is concerned, are not the subject of these Guidelines, but are dealt with in the **PCT International Search and Preliminary Examination Guidelines**. Whenever considered appropriate, options given in the latter Guidelines and the way they are dealt with by the European Patent Office when acting as Receiving Office, International Searching Authority or International Preliminary Examining Authority are the subject of separate notices published in the Official Journal of the EPO and on the EPO website. It is important to note that Art. 150 EPC states that in case of conflict between the PCT and the EPC, the provisions of the PCT prevail.

These Guidelines are addressed primarily to EPO staff but it is hoped that they will also be of assistance to the parties to the proceedings and patent practitioners, since the success of

the European patent system depends on the good cooperation between the parties and their representatives on the one hand and the EPO on the other.

3.2 The Guidelines are intended to cover normal occurrences. They should therefore be considered only as general instructions. The application of the Guidelines to individual European patent applications or patents is the responsibility of the examining staff and they may depart from these instructions in exceptional cases. Nevertheless, as a general rule, parties can expect the EPO to act in accordance with the Guidelines until such time as they – or the relevant legal provisions – are amended. Notices concerning such amendments are published in the Official Journal of the EPO and on the EPO website.

It should be noted also that the Guidelines do not constitute legal provisions. For the ultimate authority on practice in the EPO, it is necessary to refer firstly to the European Patent Convention itself including the Implementing Regulations, the Protocol on the Interpretation of Article 69 EPC, the Protocol on Centralisation, the Protocol on Recognition, the Protocol on Privileges and Immunities and the Rules relating to Fees, and secondly to the interpretation put upon the EPC by the Boards of Appeal and the Enlarged Board of Appeal.

3.3 Where a decision or an opinion of the Enlarged Board of Appeal is referred to, this is to inform the reader that the practice described has been adopted to take account of the decision or opinion referred to. The same applies to decisions of the Legal or Technical Boards of Appeal.

3.4 As regards the search, the EPO also carries out searches for national patent applications from certain countries. The instructions in Part B apply in the main also to such searches.

3.5 These Guidelines do not deal with the Community Patent Convention.

4. Work at the EPO

4.1 The setting up of the EPO represented a major step forward in the history of patents. Its reputation depends on all employees, regardless of nationality, working harmoniously together and giving of their best. But it is on the search and examination, more than anything else, that the EPO will be judged by the patent world.

4.2 Employees of the EPO work with colleagues who not only speak a different language but also come from a different patent background with different training. Some may also have had experience in their national patent office. It is important therefore to remember that all employees in the EPO are working under a common system as laid down in the EPC. They should all apply the same standard and in some instances this will mean abandoning previous habits and ways of thought. This is particularly important for examiners working on the substantive examination and oppositions.

4.3 It is also important that the various departments of the EPO and various staff within the same department should not attempt to duplicate one another's efforts. For example, Examining Divisions should not attempt to check the formalities work performed by the Receiving Section or to duplicate the search work performed by the Search Division. One of the purposes of the Guidelines is to make clear where the demarcations of responsibility lie.

4.4 It should not be forgotten that the reputation of the EPO will depend not only on quality but also on the speed with which it deals with its work. The EPC imposes various time limits on the parties. Generally speaking there are no corresponding time limits imposed on the EPO, but the European patent system will be judged a success only if examiners and other employees also operate with reasonable expedition.

4.5 Finally, it should hardly need stating that all European applications and patents, regardless of their country of origin and the language in which they are written, should receive equal treatment. An international patent system can be credible only if all trace of national bias is absent.

5. Survey of the processing of applications and patents at the EPO

5.1 The processing of a European application and of a European patent is carried out in a number of distinct steps which may be summarised as follows:

(i) the application is filed with the EPO or a competent national authority;

(ii) the Receiving Section examines the application to determine if a date of filing can be accorded to the application;

(iii) the formal examination of the application is undertaken by the Receiving Section;

(iv) in parallel with the formal examination the Search Division draws up an EESR, a copy of which is forwarded to the applicant;

(v) the application and the search report are published by the EPO either together or separately;

(vi) on receipt of a request from the applicant, or, if the request has been filed before the search report has been transmitted to the applicant, on confirmation by the applicant that he desires to proceed further with the European patent application, the application is subjected to a substantive examination and an examination of formalities necessary for grant by the Examining Division;

(vii) provided the requirements of the EPC are met, a European patent is granted for the States designated;

(viii) the specification of the European patent is published by the EPO;

(ix) any person may give notice of opposition to the European patent granted; after examining the opposition, the Opposition Division decides whether to reject the opposition, maintain the patent in amended form, or to revoke the patent;

(x) the patent proprietor may request limitation or revocation of the granted patent; the Examining Division will decide whether this request is to be granted

(xi) if the European patent is amended, the EPO publishes a new specification of the European patent amended accordingly.

5.2 Any decision by an EPO first-instance department which adversely affects a party is subject to review before a Board of Appeal of the EPO. With the exception of matters of importance to the question of interlocutory revision, the appeals procedure is not dealt with in these Guidelines.

6. Contracting States to the EPC

The following states are Contracting States* to the EPC (date of effect of the ratification in brackets):

Austria	(1 May 1979)
Belgium	(7 October 1977)
Bulgaria	(1 July 2002)
Croatia	(1 January 2008)
Cyprus	(1 April 1998)
Czech Republic	(1 July 2002)
Denmark[1]	(1 January 1990)
Estonia	(1 July 2002)
Finland	(1 March 1996)
Former Yugoslav Republic of Macedonia	(1 January 2009)
France[2]	(7 October 1977)
Germany	(7 October 1977)
Greece	(1 October 1986)
Hungary	(1 January 2003)
Iceland	(1 November 2004)
Ireland	(1 August 1992)
Italy	(1 December 1978)
Latvia	(1 July 2005)
Liechtenstein	(1 April 1980)
Lithuania	(1 December 2004)
Luxembourg	(7 October 1977)
Malta	(1 March 2007)
Monaco	(1 December 1991)
Netherlands[3]	(7 October 1977)
Norway	(1 January 2008)
Poland	(1 March 2004)
Portugal	(1 January 1992)
Romania	(1 March 2003)
San Marino	(1 July 2009)
Slovak Republic	(1 July 2002)
Slovenia	(1 December 2002)
Spain	(1 October 1986)
Sweden	(1 May 1978)
Switzerland	(7 October 1977)
Turkey	(1 November 2000)
United Kingdom[4]	(7 October 1977)
(total: 36)	

*: An up-to-date list of the Contracting States to the EPC is published each year in issue No. 4 of the Official Journal of the EPO.

[1]: The EPC does not apply to Greenland and the Faroe Islands.

[2]: The EPC also applies to the French territorial entity of Mayotte and the overseas territories.

[3]: The EPC is not applicable to the territory of the Netherlands Antilles and Aruba.

[4]: The EPC is also applicable to the Isle of Man. For further information on the registration of European patents, designating the United Kingdom, in overseas states and territories, see OJ 4/2004, 79.

7. Extension to states not party to the EPC

The following states are states to which European patent applications (direct or Euro-PCT) and thus patents can be extended (date of effect of the respective agreement with the EPO in brackets):

Albania	(1 February 1996)
Bosnia and Herzegovina	(1 December 2004)
Serbia	(1 November 2004)

The EPO's extension agreements with the **Republic of Slovenia** (entry into force: 1 March 1994), the **Republic of Romania** (15 October 1996), the **Republic of Lithuania** (5 July 1994), the **Republic of Latvia** (1 May 1995), the **Republic of Croatia** (1 April 2004) and the **former Yugoslav Republic of Macedonia** (1 November 1997) terminated when these six countries acceded to the EPC with effect from 1 December 2002, 1 March 2003, 1 December 2004, 1 July 2005, 1 January 2008 and 1 January 2009 respectively. However, the extension system continues to apply to all European and international applications filed prior to those dates, and to all European patents granted in respect of such applications.

Part A

Guidelines for Formalities Examination

Contents

Chapter I – Introduction **I-1**

1.	Overview	I-1
2.	Responsibility for formalities examination	I-1
3.	Purpose of Part A	I-1
4.	Other Parts relating to formalities	I-1

Chapter II – Filing of applications and examination on filing **II-1**

1.	Where and how applications may be filed	II-1
1.1	Filing of applications by delivery by hand or by post	II-1
1.2	Filing of applications by fax	II-1
1.3	Filing of applications in electronic form	II-2
1.4	Filing of applications by other means	II-2
1.5	Subsequent filing of documents	II-3
1.6	Debit orders for deposit accounts held with the EPO	II-3
1.7	Forwarding of applications	II-3
1.8	Application numbering systems	II-3
1.8.1	Applications filed before 1 January 2002	II-3
1.8.2	Applications filed on or after 1 January 2002	II-4
2.	Persons entitled to file an application	II-4
3.	Procedure on filing	II-5
3.1	Receipt; confirmation	II-5
3.2	Filing with a competent national authority	II-5
4.	Examination on filing	II-6
4.1	Minimum requirements for according a date of filing	II-6
4.1.1	Indication that a European patent is sought	II-7
4.1.2	Information concerning the applicant	II-7
4.1.3	Description	II-7
4.1.3.1	Reference to a previously filed application	II-8
4.1.4	Deficiencies	II-9
4.1.5	Date of filing	II-11
5.	Late filing of drawings or parts of the description	II-11
5.1	Late filing of drawings or parts of the description – on invitation	II-11
5.2	Late filing of drawings or parts of the description – without invitation	II-11
5.3	The filing date changes	II-12
5.4	Missing parts based on priority, no change in filing date	II-12
5.4.1	Late-filed missing parts and the priority claim	II-13
5.4.2	The missing parts are completely contained in the claimed priority	II-13
5.4.3	Copy of the claimed priority	II-14
5.4.4	Translation of the priority	II-14
5.5	Withdrawal of late-filed missing drawings/parts of the description	II-15

Chapter III – Examination of formal requirements III-1

1.	General	III-1
1.1	Formal requirements	III-1
1.2	Further checks	III-1
2.	Representation	III-2
2.1	Requirements	III-2
2.2	Non-compliance	III-2
3.	Physical requirements	III-2
3.1	General remarks	III-2
3.2	Documents making up the application, replacement documents, translations	III-2
3.2.1	Physical requirements of applications filed by reference to a previously filed application	III-3
3.2.2	Physical requirements of late-filed application documents	III-3
3.3	Other documents	III-4
3.4	Signature	III-4
4.	Request for grant	III-4
4.1	General remarks	III-4
4.2	Examination of the Request for Grant form	III-4
4.2.1	Information on the applicant	III-4
4.2.2	Signature	III-5
5.	Designation of inventor	III-5
5.1	General remarks	III-5
5.2	Waiver of right to be mentioned as inventor	III-5
5.3	Designation filed in a separate document	III-5
5.4	Notification	III-6
5.5	Deficiencies	III-7
5.6	Incorrect designation	III-7
6.	Claim to priority (see also C-V)	III-7
6.1	General remarks	III-7
6.2	Applications giving rise to a right of priority	III-8
6.3	Multiple priorities	III-9
6.4	Examination of the priority document	III-9
6.5	Declaration of priority	III-9
6.5.1	Filing a new priority claim	III-10
6.5.2	Correcting an existing priority claim	III-10
6.5.3	Deficiencies in the priority claim and loss of the priority right	III-11
6.6	Priority period	III-11
6.7	Copy of the previous application (priority document)	III-12
6.8	Translation of the previous application	III-13
6.9	Non-entitlement to right to priority	III-15
6.10	Loss of right to priority	III-15
6.11	Notification	III-15
7.	Title of the invention	III-16

7.1	Requirements	III-16
7.2	Responsibility	III-16
8.	Prohibited matter	III-16
8.1	Morality or "ordre public"	III-16
8.2	Disparaging statements	III-17
9.	Claims fee	III-17
10.	Abstract	III-18
10.1	General remark	III-18
10.2	Content of the abstract	III-19
10.3	Figure accompanying the abstract	III-19
11.	Designation of Contracting States	III-19
11.1	General remarks	III-19
11.2	European patent applications filed on or after 1 April 2009	III-19
11.2.1	Designation fee; time limits	III-19
11.2.2	Payment of designation fee	III-20
11.2.3	Consequences of non-payment of the designation fee	III-20
11.2.4	Withdrawal of designation	III-20
11.2.5	Euro-PCT applications entering the European phase	III-21
11.3	European patent applications filed before 1 April 2009	III-21
11.3.1	Designation fee; time limits	III-21
11.3.2	Consequences of non-payment of designation fees	III-22
11.3.3	Amount paid insufficient	III-22
11.3.4	Application deemed to be withdrawn	III-22
11.3.5	Request for Grant form	III-23
11.3.6	Indication of the Contracting States	III-23
11.3.7	Amount payable	III-23
11.3.8	Withdrawal of designation	III-24
11.3.9	Euro-PCT applications entering the European phase	III-24
12.	Extension of European patent applications and patents to States not party to the EPC	III-24
12.1	General remarks	III-24
12.2	Time limit for payment of extension fee	III-25
12.3	Withdrawal of extension	III-26
12.4	Extension deemed requested	III-26
12.5	National register	III-26
13.	Filing and search fees	III-27
13.1	Payment of fees	III-27
13.2	Additional fee (if application documents comprise more than thirty-five pages)	III-27
14.	Translation of the application	III-29
15.	Late filing of claims	III-30
16.	Correction of deficiencies	III-30
16.1	Procedure formalities officer	III-30

16.2	Period allowed for remedying deficiencies	III-31

Chapter IV – Special provisions **IV-1**

1.	European divisional applications (see also C-VI, 9.1)	IV-1
1.1	General remarks	IV-1
1.1.1	When may a divisional application be filed?	IV-1
1.1.1.1	The earlier application must be pending	IV-1
1.1.1.2	Voluntary division	IV-2
1.1.1.3	Mandatory division	IV-3
1.1.1.4	Second- and subsequent-generation divisional applications	IV-5
1.1.1.5	Legal remedies for late filing of a divisional application	IV-6
1.1.2	Persons entitled to file a divisional application	IV-7
1.2	Date of filing of a divisional application; claiming priority	IV-7
1.2.1	Date of filing	IV-7
1.2.2	Claiming priority	IV-7
1.3	Filing a divisional application	IV-8
1.3.1	Where and how to file a divisional application?	IV-8
1.3.2	Request for grant	IV-8
1.3.3	Language requirements	IV-9
1.3.4	Designation of Contracting States	IV-9
1.3.5	Extension States	IV-9
1.4	Fees	IV-10
1.4.1	Filing, search and designation fee(s)	IV-10
1.4.2	Claims fees	IV-10
1.4.3	Renewal fees	IV-10
1.5	Designation of the inventor	IV-11
1.6	Authorisations	IV-11
1.7	Other formalities examination	IV-12
1.8	Further procedure	IV-12

2.	Art. 61 applications	IV-12
2.1	General	IV-12
2.2	Staying the proceedings for grant	IV-13
2.3	Resumption of the proceedings for grant	IV-13
2.4	Interruption of time limits	IV-14
2.5	Limitation of the option to withdraw the European patent application	IV-14
2.6	Prosecution of the application by a third party	IV-14
2.7	Filing a new application	IV-14
2.8	Refusal of the earlier application	IV-15
2.9	Partial transfer of right by virtue of a final decision	IV-15

3.	Display at an exhibition	IV-15
3.1	Certificate of exhibition; identification of invention	IV-15
3.2	Defects in the certificate or the identification	IV-16

4.	Applications relating to biological material	IV-16
4.1	Biological material; deposit thereof	IV-16
4.1.1	New deposit of biological material	IV-17
4.1.2	The application was filed by reference to a previous application	IV-18

4.2	Missing information; notification	IV-18
4.3	Availability of deposited biological material to expert only	IV-19
5.	Applications relating to nucleotide and amino acid sequences	IV-19
5.1	Sequence listings filed under Rule 56	IV-20
5.2	Sequence listings of an application filed by reference to a previously filed application	IV-21
6.	Conversion into a national application	IV-22

Chapter V – Communicating the formalities report; amendment of application; correction of errors **V-1**

1.	Communicating the formalities report	V-1
2.	Amendment of application	V-1
2.1	Filing of amendments	V-1
2.2	Examination of amendments as to formalities	V-2
3.	Correction of errors in documents filed with the EPO	V-2

Chapter VI – Publication of application; request for examination and transmission of the dossier to Examining Division **VI-1**

1.	Publication of application	VI-1
1.1	Date of publication	VI-1
1.2	No publication; preventing publication	VI-1
1.3	Content of the publication	VI-2
1.4	Publication in electronic form only	VI-3
1.5	Separate publication of the European search report	VI-3
2.	Request for examination and transmission of the dossier to the Examining Division	VI-3
2.1	Communication	VI-3
2.2	Time limit for filing the request for examination	VI-4
2.3	Legal remedy	VI-4
2.4	Transmission of the dossier to the Examining Division	VI-5
2.5	Refund of examination fee	VI-6
2.6	Reduction in examination fee	VI-6
3.	Response to the search opinion	VI-6

Chapter VII – Applications under the Patent Cooperation Treaty (PCT) before the EPO acting as a designated or elected Office **VII-1**

1.	General	VII-1
1.1	Introduction	VII-1
1.2	Initial processing and formal examination; copy of the international application; translation	VII-1
1.3	Filing fee, designation fee, request for examination, search fee and claims fees	VII-2
1.4	PCT vs. EPC provisions	VII-3

2.	Provisions of Chapter II ("Filing of applications and examination on filing")	VII-3
3.	Provisions of Chapter III ("Examination of formal requirements")	VII-4
3.1	Representation	VII-4
3.2	Physical requirements	VII-5
3.3	Request for grant	VII-5
3.4	Designation of inventor	VII-5
3.5	Claim to priority	VII-5
3.6	Title of the invention	VII-6
3.7	Prohibited matter	VII-6
3.8	Claims fee	VII-6
3.9	Drawings	VII-7
3.10	Abstract	VII-7
3.11	Designation fee	VII-7
4.	Provisions of Chapter IV ("Special provisions")	VII-7
4.1	Divisional applications	VII-7
4.2	Sequence listings	VII-7
5.	Provisions of Chapter VI ("Publication of application; request for examination and transmission of the dossier to Examining Division")	VII-8
5.1	Publication of the international application	VII-8
5.2	Request for examination	VII-8
5.3	Supplementary European search	VII-8
6.	Reduction and refunds of fees in respect of international (PCT) applications	VII-8
7.	The communication according to Rule 161	VII-8

Chapter VIII – Languages **VIII-1**

1.	Provisions concerning the language of the proceedings	VIII-1
1.1	Admissible languages; time limit for filing the translation of the application	VIII-1
1.2	Language of the proceedings	VIII-1
1.3	European divisional applications; Art. 61 applications	VIII-1
2.	Derogations from the language of the proceedings in written proceedings	VIII-2
3.	Documents to be used as evidence	VIII-2
4.	Documents filed in the wrong language	VIII-2
4.1	Documents making up a European patent application	VIII-2
4.2	Other documents	VIII-3
5.	Translation of the priority document	VIII-3
6.	Authentic text	VIII-3
6.1	General remark	VIII-3
6.2	Conformity of translation with the original text	VIII-4
7.	Certificate of translation	VIII-4
8.	Derogations from the language of the proceedings in oral proceedings	VIII-4

Chapter IX – Common provisions **IX-1**

1.	Representation	IX-1
1.1	Representation by a professional representative	IX-1
1.2	Representation by an employee	IX-1
1.3	Common representative	IX-1
1.4	List of professional representatives; legal practitioners	IX-2
1.5	Signed authorisation	IX-2
1.6	General authorisation	IX-3
1.7	Invitation to file authorisation	IX-3
2.	Form of documents	IX-3
2.1	Documents making up the European patent application	IX-3
2.2	Replacement documents and translations	IX-4
2.3	Other documents	IX-4
2.4	Number of copies	IX-4
2.5	Filing of subsequent documents	IX-4
3.	Signature of documents	IX-5
3.1	Documents filed after filing the European patent application	IX-5
3.2	Documents forming part of the European patent application	IX-6
3.3	Form of signature	IX-6
3.4	Joint applicants	IX-6

Chapter X – Drawings **X-1**

1.	Graphic forms of presentation considered as drawings	X-1
1.1	Technical drawings	X-1
1.2	Photographs	X-1
2.	Representation of drawings	X-1
2.1	Grouping of drawings	X-1
2.2	Reproducibility of drawings	X-1
2.3	Figure accompanying the abstract	X-2
3.	Conditions regarding the paper used	X-2
4.	Presentation of the sheets of drawings	X-2
4.1	Usable surface area of sheets	X-2
4.2	Numbering of sheets of drawings	X-2
5.	General layout of drawings	X-3
5.1	Page-setting	X-3
5.2	Numbering of figures	X-3
5.3	Whole figure	X-4
6.	Prohibited matter	X-4
7.	Executing of drawings	X-4
7.1	Drawings of lines and strokes	X-4

7.2	Shading	X-5
7.3	Cross-sections	X-5
7.3.1	Sectional diagrams	X-5
7.3.2	Hatching	X-5
7.4	Scale of drawings	X-5
7.5	Numbers, letters and reference signs	X-6
7.5.1	Leading lines	X-6
7.5.2	Arrows	X-6
7.5.3	Height of the numbers and letters in the drawings	X-6
7.5.4	Consistent use of reference signs as between description, claims and drawings	X-6
7.5.5	Consistent use of reference signs as between drawings	X-7
7.6	Variations in proportions	X-8
8.	Text matter on drawings	X-8
9.	Conventional symbols	X-8
10.	Amendments to drawings	X-8
11.	Graphic forms of presentation not considered as drawings	X-9
11.1	Chemical and mathematical formulae	X-9
11.2	Tables	X-9
11.2.1	Tables in the description	X-9
11.2.2	Tables in the claims	X-10

Chapter XI – Fees **XI-1**

1.	General	XI-1
2.	Methods of payment	XI-1
3.	Currencies	XI-2
4.	Date considered as date on which payment is made	XI-2
4.1	Payment or transfer to a bank account held by the European Patent Organisation	XI-2
4.2	Deposit accounts with the EPO	XI-2
4.2.1	General remarks	XI-2
4.2.2	Inpayments to replenish a deposit account	XI-2
4.2.3	Debiting the deposit account	XI-3
4.2.4	Date of receipt of the debit order; insufficient funds	XI-3
4.3	Automatic debiting procedure	XI-3
5.	Due date for fees	XI-4
5.1	General	XI-4
5.1.1	Due date	XI-4
5.1.2	Amount of the fee	XI-4
5.2	Due date for specific fees	XI-4
5.2.1	Filing fee, search fee, designation fee	XI-4
5.2.2	Examination fee	XI-4
5.2.3	Fee for grant and publishing	XI-5
5.2.4	Renewal fees	XI-5
5.2.5	Claims fees	XI-5
5.2.6	Fees for limitation/revocation, opposition, appeal, petition for review	XI-5

6.	Payment in due time	XI-5
6.1	Basic principle	XI-5
6.2	Ten-day fail-safe arrangement	XI-6
6.2.1	Requirements	XI-6
6.2.2	Application of the ten-day fail-safe arrangement to replenishment of deposit account	XI-6
6.2.3	Debit orders	XI-6
6.2.4	Payment of fee at the normal fee rate	XI-6
6.2.5	Amount of fee payable	XI-7
6.2.6	Noting of loss of rights	XI-7
7.	Purpose of payment	XI-7
7.1	General	XI-7
7.1.1	Condition for valid payment	XI-7
7.1.2	Purpose of payment	XI-7
7.2	Indication of the purpose of the payment in the case of designation fees	XI-8
7.3	Indication of the purpose of payment in the case of claims fees	XI-9
7.3.1	Claims fees payable on filing the European patent application	XI-9
7.3.2	Claims fees payable before the grant of the European patent	XI-9
8.	No deferred payment of fees, no legal aid, no discretion	XI-9
9.	Reduction of fees	XI-9
9.1	General	XI-9
9.2	Reduction under the language arrangements	XI-9
9.2.1	Conditions	XI-9
9.2.2	Reduction of the filing fee	XI-10
9.2.3	Reduction of the examination fee	XI-11
9.2.4	Reduction of the opposition fee	XI-11
9.2.5	Reduction of the appeal fee	XI-11
9.2.6	Reduction of the fee for limitation and revocation	XI-12
9.2.7	Reduction of the fee for the petition for review	XI-12
9.3	Special reductions	XI-12
9.3.1	Reduction of the search fee for a supplementary European search	XI-12
9.3.2	Reduction of the examination fee where the international preliminary examination report is being drawn up by the EPO	XI-12
9.3.3	Reduction of the fees for the international search and international preliminary examination of an international application	XI-13
10.	Refund of fees	XI-13
10.1	General remarks	XI-13
10.1.1	Fee payments lacking a legal basis	XI-13
10.1.2	Fee payments which are not valid	XI-13
10.1.3	Insignificant amounts	XI-13
10.2	Special refunds	XI-14
10.2.1	Refund of the search fee	XI-14
10.2.2	Refund of the further search fee	XI-14
10.2.3	Refund of the international search fee	XI-14
10.2.4	Refund of the examination fee	XI-14
10.2.5	Refund of the international preliminary examination fee	XI-15
10.2.6	Refund pursuant to Rule 37(2)	XI-15

10.2.7	Refund of claims fees and of the fee for grant and publishing	XI-15
10.3	Method of refund	XI-15
10.4	Person to whom refund is payable	XI-15
10.5	Re-allocation instead of refund	XI-15

Chapter XII – Inspection of files; communication of information contained in files; consultation of the Register of European Patents; issuance of certified copies XII-1

1.	General	XII-1
2.	Inspection of files	XII-1
2.1	Extent of file inspection	XII-1
2.2	Procedure for file inspection	XII-2
2.3	Restrictions to file inspection	XII-3
2.4	Confidentiality of the request	XII-3
2.5	File inspection before publication of the application	XII-3
2.6	Publication of bibliographic data before publication of the application	XII-4
3.	Communication of information from the files	XII-4
4.	Consultation of the European Patent Register	XII-4
5.	Certified copies	XII-5
6.	Priority documents issued by the EPO	XII-5

Chapter I

Introduction

1. Overview

This Part A of the Guidelines deals with the following:

(i) the requirements and procedure relevant to the examination as to formalities of European patent applications (Chapters II to VI);

(ii) the modification to the requirements and procedure of (i) when dealing with international applications filed under the PCT and entering the European phase (Chapter VII);

(iii) formalities matters of a more general nature which can arise during the application procedure or the post-grant stage (Chapters VIII and IX),

(iv) the presentation and execution of drawings and figurative representations accompanying a European patent application (Chapter X);

(v) fee questions (Chapter XI);

(vi) inspection of files, communication of information contained in files, consultation of the Register of European Patents and issuance of certified copies (Chapter XII).

2. Responsibility for formalities examination

Rule 10
Rule 11(3)

The matters covered by this Part A are directed to the formalities staff of the EPO whether they be in The Hague, Munich or Berlin. They are directed primarily to the Receiving Section which is specifically responsible under the EPC for ensuring that the formal requirements for European patent applications are adhered to. Once the application is transferred to the Examining Division, the latter accepts responsibility for the formalities of the application, although it should be understood that reference to the Examining Division is intended to cover the formalities officer to which this work is entrusted.

3. Purpose of Part A

The formalities staff should note that this Part A of the Guidelines is intended to provide them with the knowledge and background which it is felt will assist them in carrying out their functions in a uniform and expeditious manner. It does not, however, provide authority for ignoring the provisions of the EPC and in that regard specific attention is directed to paragraph 3.2 of the General Part of the Guidelines.

4. Other Parts relating to formalities

It is not the intention that the formalities staff should concern themselves with only this Part A of the Guidelines. It is expected that

they will have to refer frequently to the other Parts and in particular Part E.

Chapter II

Filing of applications and examination on filing

1. Where and how applications may be filed

1.1 Filing of applications by delivery by hand or by post

European patent applications may be filed in writing, by delivery by hand, by post or by technical means of communication (see II, 1.2 and 1.3) at the EPO's filing offices in Munich, The Hague or Berlin. The EPO's sub-office in Vienna is not a filing office.

Art. 75(1)
Rule 35(1)
Rule 2(1)

The opening hours of the filing offices of the EPO were published in the Notice from the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.2. Dates on which at least one of the filing offices of the EPO is not open to receive documents are likewise announced at regular intervals in the Official Journal of the EPO (see also E-VIII, 1.4).

The EPO filing offices in Berlin and Munich are equipped with automated mail-boxes, which may be used at any time. The automated mail-box facility is not currently available at the filing office at The Hague. Outside office hours documents may be handed in to the porter.

European patent applications (with the exception of divisional applications, see IV, 1.3.1, and applications according to Art. 61(1)(b), see IV, 2.7) may also be filed at the central industrial property office or other competent authority of a Contracting State if the national law of that State so allows (see II, 1.7).

1.2 Filing of applications by fax

Applications may also be filed by fax with the filing offices of the EPO or with the competent national authorities of those Contracting States which so permit, namely – at present – Austria (AT), Belgium (BE), Bulgaria (BG), Czech Republic (CZ), Denmark (DK), Finland (FI), France (FR), Germany (DE), Greece (GR), Iceland (IS), Ireland (IE), Liechtenstein (LI), Luxembourg (LU), Monaco (MC), Poland (PL), Portugal (PT), Slovakia (SK), Slovenia (SI), Spain (ES), Sweden (SE), Switzerland (CH) and United Kingdom (GB). For further details, see the latest version of the brochure "National Law relating to the EPC".

Where a document transmitted using such technical means is illegible or incomplete, the document is to be treated as not having been received to the extent that it is illegible or that the attempted transmission failed and the sender must be notified as soon as possible (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.3).

Art. 90(5)

If a European patent application is filed by fax, a written confirmation is required only where the documents are of inferior quality. In this case, the EPO will invite the applicant to supply such documents within a period of two months (Rule 2(1)). If the applicant fails to comply with this invitation in due time, the European patent application will be refused. To prevent duplication of files, applicants are asked to indicate on the paper version of the application documents the application number or fax date and the name of the authority with which the documents were filed and to make it clear that these documents represent "confirmation of an application filed by fax".

1.3 Filing of applications in electronic form

European patent applications and international (PCT) applications may be filed with the EPO in electronic form either **online** or on **electronic data carriers** (see the Decision of the President of the EPO dated 26 February 2009, OJ EPO 3/2009, 182). At present, the data carriers permitted are CD-R as per ISO 9660 and DVD-R or DVD+R (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.5). Documents making up a European or an international patent application in electronic form must be prepared using either the epoline® Online Filing software or the PaTrAS software, both of which include the Request for Grant Form, unless the use of other software is permitted (see Art. 5 of the Decision of the President dated 26 February 2009, OJ EPO 3/2009, 182, Art. 2 of the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.5, and the Notice from the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.6).

Other documents may also be filed electronically in grant, opposition, limitation, revocation and appeal proceedings (see the Decision of the President of the EPO dated 26 February 2009, OJ EPO 3/2009, 182).

European patent applications may also be filed in electronic form with the competent national authorities of those Contracting States which so permit.

1.4 Filing of applications by other means

As of 1 January 2003 European patent applications may no longer be filed with the EPO on **diskette** accompanied by a paper version prepared by means of the **EP-EASY** software (see the Notice from the EPO dated 1 October 2002, OJ 10/2002, 515). This applies also to the filing of European patent applications with the filing offices of Belgium (BE), Finland (FI), France (FR), Sweden (SE), Switzerland (CH) and the United Kingdom (GB).

The filing of European patent applications by other means such as **e-mail** is at present not allowed (see also the Notice dated 12 September 2000, OJ 10/2000, 458).

1.5 Subsequent filing of documents

For the subsequent filing of documents, see IX, 2.5 and II, 1.3, second paragraph.

1.6 Debit orders for deposit accounts held with the EPO

European patent applications and international (PCT) applications may be accompanied by a debit order for the fees due. To avoid the risk of payment being debited twice where a debit order is sent by fax, the original should not be filed subsequently (see points 6.2, 6.9 and 6.10 of the Arrangements for deposit accounts, Supplement No. 1 to OJ 3/2009). For the abolition of payments by cheque, see A-XI, 2.

Points 6.2, 6.9 and 6.10 ADA

1.7 Forwarding of applications

The central industrial property office of a Contracting State is obliged to forward to the EPO, in the shortest time compatible with national law concerning the secrecy of inventions, applications filed (see II, 3.2) with that office or with other competent authorities in that State (for debit order enclosures, see II, 1.6).

Art. 77(1)
Rule 37(1)

A time limit of six weeks after filing is specified for the onward transmission to the EPO of applications the subject-matter of which is obviously not liable to secrecy, this time limit being extended to four months or, where priority has been claimed, to fourteen months after the date of priority, for applications which require further examination as to their liability to secrecy. It should be noted, however, that an application received outside the specified time limits, either six weeks or four months, must be processed provided the application is received in Munich, The Hague or Berlin before the end of the fourteenth month after filing or, where appropriate, after the date of priority. Applications received outside this last mentioned time limit are deemed to be withdrawn. Re-establishment of rights and further processing in respect of the period under Rule 37(2) are not possible, since the loss of rights does not result from a failure of the applicant to observe a time limit (see J 3/80, OJ 4/1980, 92), but a request for conversion under Art. 135(1)(a) may be filed (see IV, 6).

Art. 77(3)
Rule 37(2)
Art. 135(1)(a)

If the time limit referred to in Rule 37(2) expires on a day on which there is an interruption or subsequent dislocation in the delivery or transmission of mail within the meaning of Rule 134(2), the time limit will extend to the first day following the end of the period of interruption or dislocation.

Rule 134(2)

1.8 Application numbering systems

1.8.1 Applications filed before 1 January 2002

For applications filed **before** 1 January 2002, the following numbering system applies:

The application number consists of nine digits. The first two digits (from left to right) of the application number indicate the filing year. The last

(ninth) digit is a check digit. The third digit or third and fourth digits of the application number indicate(s) the place of filing.

The remaining digits are used for consecutively numbering the applications in the order in which they come in at the place of filing.

International applications filed under the Patent Cooperation Treaty (PCT), and designating "EP" (Euro-PCT applications) receive the digit "9" as the third digit or the digits "27" as the third and fourth digits.

1.8.2 Applications filed on or after 1 January 2002

For applications filed **on or after** 1 January 2002, the following numbering system applies:

The application number consists of nine digits. The first two digits (from left to right) of the application number indicate the filing year. The last digit is a check digit. The remaining six digits in between are used for consecutively numbering the applications in the order in which they arrive at the place of filing, starting from a lowest number within a specific range of six-digit numbers. The specific range reflects the place of filing. Where applicable, the range is subdivided into two ranges in order to distinguish between paper and online filings.

The above also applies to international applications designating "EP" (Euro-PCT applications), albeit that for these applications a dedicated range for the above-mentioned six-digit number within the application number is used, which does not reflect the place of filing.

A list of the number ranges currently in use, along with, where appropriate, the corresponding places of filing, is published in OJ 10/2001, 465.

2. Persons entitled to file an application

Art. 58

A European patent application may be filed by any natural or legal person, or any body equivalent to a legal person by virtue of the law governing it.

Art. 60(3)

For the purposes of proceedings before the EPO, the applicant shall be deemed to be entitled to exercise the right to the European patent.

Art. 59
Art. 118

The application may be in the name of one person or several persons may be named as joint applicants. The application may also be filed by two or more applicants designating different Contracting States. It may arise that a first applicant designates one group of Contracting States and a second designates a different group of Contracting States, while both applicants jointly designate a third group of Contracting States. If the applicants for a patent are not the same for different Contracting States they will be regarded as joint applicants in proceedings before the EPO (see III, 4.2.1 and 11.1 as to when and under what circumstances the matter dealt with in this paragraph need be considered during the formalities examination).

If it is adjudged that a person other than the applicant is entitled to the grant of a European patent that person has the option of prosecuting the application as his own application in place of the applicant (see IV, 2). *Art. 61(1)*

3. Procedure on filing

3.1 Receipt; confirmation

The authority with which the application is filed – either the EPO (Munich, The Hague or Berlin) or the competent national authority – must mark the documents making up the application with the date of receipt and issue a receipt to the applicant (for the date of receipt of applications received by fax see Art. 5 of the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.3). The receipt must be issued without delay and include at least the application number, the nature and number of the documents and the date of their receipt. The receipt should also include the applicant's or representative's file reference number or any other information which would be helpful in identifying the applicant. The receipt of European patent applications filed online will be acknowledged electronically during the submission session. Where it becomes apparent that such acknowledgment was not successfully transmitted, the authority with which the application is filed will promptly transmit the acknowledgment by other means where the necessary indications furnished to it so permit (see Art. 10 of the Decision of the President of the EPO dated 26 February 2009, OJ EPO 3/2009, 182). On request, the EPO also provides confirmation by fax of the receipt of documents filed with it (see Art. 8 of the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.3). To ensure despatch of the receipt immediately after the documents are received: *Rule 35(2)*

– the request for the issue of a receipt by fax must be transmitted at the same time as the documents filed;

– the postal or fax address to which the receipt is to be sent must be stated; and

– evidence of the payment of the prescribed administrative fee or a debit order must be enclosed.

The amount of the administrative fee is regularly indicated in the Official Journal.

3.2 Filing with a competent national authority

If the application is filed with a competent national authority, that authority must without delay inform the EPO of receipt of the documents making up the application and indicate the nature and date of receipt of the documents, the application number and any priority date claimed. It is recommended that the competent national authority should indicate as well the applicant's or representative's reference number where such has been indicated. In practice, the *Rule 35(3)*

above-mentioned information is provided to the EPO by the forwarding of the application itself, unless national security checks by the national office delay the forwarding of the application, in which case a separate notice is sent by that office to the EPO.

Rule 35(4) When the EPO has received an application which has been forwarded by the central industrial property office of a Contracting State, it notifies the applicant, indicating the date of receipt at the EPO (see OJ 7/1990, 306). Once this communication has been received, all further documents relating to the application must be sent directly to the EPO.

Art. 77(3)
Rule 37(2)
Rule 112(1) Where an application is not received at the EPO from the central industrial property office of a Contracting State before the end of the fourteenth month after filing or, if priority has been claimed, after the date of priority and is consequently deemed to be withdrawn (see II, 1.7), the applicant must be notified accordingly; all fees must be refunded, including any surcharges paid and any fees paid in advance of their due date.

4. Examination on filing

4.1 Minimum requirements for according a date of filing

Art. 90(1)
Rule 10(1) The EPO examines applications to determine whether they meet the minimum requirements for according a date of filing (since this occurs before the Examining Division assumes responsibility, this check is carried out by the Receiving Section). These requirements are satisfied where the documents filed contain:

Rule 40(1)(a) (i) an indication that a European patent is sought;

Rule 40(1)(b) (ii) information identifying the applicant or allowing the applicant to be contacted; and

Rule 40(1)(c) (iii) a description or reference to a single previous application.

It is not necessary that the applicant provide any claims in order to obtain a date of filing. If the application is filed without claims, but satisfies all requirements for obtaining a date of filing, the applicant will be requested to provide at least one claim later according to Rules 57(c) and 58 (see III, 15).

Where the description is filed by reference to a previously filed application (see II, 4.1.3.1), the reference must contain the following information in order for the application to qualify for a filing date according to Rule 40(2):

(i) the filing date of the previous application

(ii) its file number

(iii) the office where it was filed

(iv) an indication that this reference replaces the description and any drawings.

To be accorded a date of filing, these documents do not have to meet any particular requirements as to form or presentation. It is essential, however, that the documents be sufficiently legible to enable the information to be discerned.

4.1.1 Indication that a European patent is sought

Use of the prescribed Request for Grant form or the *epoline*® Online Filing software best provides "the indication that a patent is sought" as referred to in II, 4.1(i) (see also III, 4).

4.1.2 Information concerning the applicant

For the purposes of establishing a date of filing, information must be supplied which:

(i) identifies the applicant or

(ii) allows the applicant to be contacted.

If there are multiple applicants, for the purposes of establishing a filing date, the above information only has to be supplied concerning one of them. Any kind of information which allows the applicant to be contacted will be considered to fulfil requirement (ii), in particular:

(a) the name and address of the applicant's representative

(b) a fax number

(c) a PO box number.

If the information supplied is sufficient to establish a date of filing but is not sufficient for the EPO to establish whether or not the applicant requires a representative according to Art. 133(2), the procedure outlined in III, 16 will be followed.

In deciding whether or not the above information concerning the applicant satisfies the above requirements, the EPO will take into account all data contained in the documents filed (cf. J 25/86, OJ 11/1987, 475). Objection should not be raised at this stage with regard to the status of the applicant or his entitlement to apply, or where, in the case of joint applicants, there is doubt as to the Contracting States designated by the individual applicants.

4.1.3 Description

The contents of the description do not require close scrutiny – it is sufficient to identify a document (or documents) which appear(s) to

include a description. If instead of filing a description, the applicant has filed a reference to a previously filed application, see II, 4.1.3.1.

4.1.3.1 Reference to a previously filed application

Instead of filing application documents, the applicant can file a reference to a previously filed application according to Rule 40(1)(c). The previously filed application relied on for the reference does not need to be claimed as priority.

Rule 40(2) *Details required on the date of filing*

According to Rule 40(2), in order to qualify for a date of filing, the applicant must indicate the following details on the filing date:

(i) the filing date of the previous application

(ii) its file number

(iii) the office where it was filed

(iv) an indication that this reference replaces the description and any drawings.

The previous application referred to may also be an application for a utility model.

Rule 40(3) *Copy of the previously filed application*

The applicant must supply a certified copy of the previously filed application within two months of the filing date (Rule 40(3)). However, according to Rule 40(3), last sentence, this requirement is dispensed with where the previously filed application is already available to the EPO under the conditions specified by the President. According to the Decision of the President of the EPO dated 17 March 2009, OJ EPO 4/2009, 236, a certified copy does not need to be filed where the previously filed application is one of the following:

(a) a European application

(b) an international application filed with the EPO as receiving Office

(c) a Japanese patent or utility model application

(d) a Korean patent or utility model application

(e) a US patent application or provisional patent application subject to the document exchange agreement with the USPTO (see III, 6.7).

If the previously filed application is any of the above, then a copy will be automatically included in the file by the EPO.

Translation of the previously filed application *Rule 40(3)*

If the previously filed application is not in an official language of the EPO, the applicant must also file a translation into one of those languages within two months of the filing date (Rule 40(3)). If the translation of the previously filed application is already available to the EPO, a copy of this will be included in the file free of charge and the applicant will not need to file it (Rule 40(3)).

Note that where the previously filed application is in a language according to Art. 14(4) (an official language of a Contracting State to the EPC), the application may qualify for a reduction of the filing fee, provided that the applicant is entitled according to Rule 6(3) (see XI, 9.2.1 and 9.2.2). The reduction applies even in cases where the description is filed by reference to a previously filed application according to Rule 40(1)(c), where the previously filed application is in a language specified in Art 14(4) but the claims are filed after the date of the filing in accordance with Rule 57(c) and Rule 58 and in an official language of the EPO. This is because the essential element for establishing a filing date (the provision of a description, cf. Rule 40(1)(c)) has been provided in a language giving rise to the entitlement to the reduction (see G 6/91, OJ 9/1992, 491 mutatis mutandis).

The claims

The applicant also has the option of indicating that he wishes the claims of the previously filed application to take the place of claims in the application as filed. Such an indication must be made on the date of filing, preferably by crossing the appropriate box in the Request for Grant (Form 1001). If this indication is made, then the claims of the previously filed application will form the basis for the search, and will satisfy the requirement of Rule 57(c), so that an invitation under Rule 58 to file claims later will not be issued.

If the applicant does not refer to the claims of the previously filed application, but refers only to the description and any drawings thereof, he may at the same time as filing the reference (i.e. on the date of filing), file a set of claims. If the applicant does not do so, he will be invited by the EPO to file claims (see III, 15).

4.1.4 Deficiencies

If the EPO (Receiving Section) notes either of the following deficiencies: *Art. 90(1) and (2) Rule 55*

Rule 40(1)(a) - no indication that a European patent is sought, or

Rule 40(1)(c) - no description or reference to an earlier application,

either of which prevents the application being accorded a date of filing, it communicates this to the applicant and invites him to remedy it within a non-extendable period of two months of notification of the communication. If the applicant does not remedy the deficiency in due time he is informed that the application will not be dealt with as a European application. Any fees which have been paid are refunded.

In the event that the information concerning the applicant is missing or does not enable the EPO to contact him (a deficiency according to Rule 40(1)(b)), no such communication is sent. However, if the applicant corrects this deficiency of his own motion within two months of the date of receipt of the original documents, then the date of filing is the date on which all requirements of Rule 40 are met. If the requirements of Rule 40 are not met at the end of this period, the application will not be dealt with as a European application and the applicant will have to re-file all documents relating to the purported European application.

Filing by reference to a previous application

Where the application is filed by reference to a previously filed application and the EPO (Receiving Section) notes that any of the following information is missing:

(i) the filing date of the previous application

(ii) its file number

(iii) the office where it was filed

(iv) an indication that this reference replaces the description and any drawings

then it proceeds as above and invites the applicant to remedy the deficiency within a two-month time limit (Rule 55). If the applicant does not remedy the deficiencies in due time, the application is not treated as a European application.

If the applicant does not provide the certified copy of the previously filed application within two months of the date of filing (Rule 40(3)) and this is not already available to the EPO (see II, 4.1.3.1), then he will also be sent a communication according to Rule 55, requesting him to file it within a non-extendable period of two months. If the applicant does not provide the certified copy in due time, the application is also not treated as a European application. Where a translation of the application is also required and this is not provided within the above time limit, the procedure given in III, 14 is followed. The filing date is unaffected by a missing translation.

4.1.5 Date of filing

The date of filing accorded to the application is the date the application meets the requirements of II, 4.1 and is either:

(i) the date of receipt at the EPO or competent national authority; or

(ii) the date, not later than the two-month period referred to in II, 4.1.4, on which the applicant rectifies any deficiencies. In the latter case, the applicant is informed of the date of filing accorded to his application.

Case (ii) is subject to one exception. Where the application is filed by reference to a previously filed application and the applicant fails to file the certified copy of the previously filed application within two months of the filing date as required by Rule 40(3), he is invited to file it within a period of two months from a communication according to Rule 55. If the applicant files the certified copy within this two-month period, the application maintains its original date of filing, provided that all other requirements for acquiring a date of filing have been met.

The date of filing may also change in cases where the applicant inserts parts of the description or drawings after the date of filing (see II, 5).

5. Late filing of drawings or parts of the description

5.1 Late filing of drawings or parts of the description - on invitation

The application is examined on filing to check that it is entitled to a date of filing. If during this check the EPO notes that parts of the description, or drawings appear to be missing, it shall invite the applicant to file the missing parts within a time limit of two months from the invitation. If the applicant does not reply to this invitation in time, then all references to the missing parts are deemed to be deleted.

Art. 90(1)
Rule 56(1)
Rule 56(4)(a)

5.2 Late filing of drawings or parts of the description - without invitation

The applicant may also file missing parts of the description, or drawings of his own motion (without being invited to do so by the EPO) within two months of the date of filing. If the applicant does not file the missing parts within this period, all references to the missing parts are deemed to be deleted. However, if the applicant is invited by the EPO to file the missing parts, the period under Rule 56(1) takes precedence (see II, 5.1).

Rule 56(2)
Rule 56(4)(a)

If, within two months of the original date of filing, the applicant notices that he has neglected to include drawings and/or parts of the description in the application as originally filed, it is advisable to file these as soon as possible of his own motion according to Rule 56(2), since if the EPO does not invite him to file the missing parts, then any possibility for him to file them later ends two months after the original date of filing.

5.3 The filing date changes

Rule 56(2) If the applicant files missing parts of the description, or drawings, in accordance with the procedures explained in II, 5.1 or 5.2, then the date of filing changes to the date on which the missing parts are received at the EPO. The applicant is informed of the new date of filing. This is subject to the exception explained in II, 5.4.

A "drawing" means a single numbered figure. Only whole figures will be accepted according to Rule 56, even where only a part of the original figure was missing.

5.4 Missing parts based on priority, no change in filing date

Rule 56(3) If the applicant files missing parts of the description, or drawings, after the date of filing in accordance with the procedures explained in II, 5.1 or 5.2, the date of filing does not change, provided that the following criteria are satisfied:

(i) the missing parts are filed within the applicable time limit*

(ii) the application claims priority (see II, 5.4.1)

(iii) the applicant requests that the late-filed parts be based on the claimed priority in order to avoid a change in the date of filing, and does so within the applicable time limit * (see II, 5.4.1)

(iv) the late-filed parts of the description, or drawings, are completely contained in the claimed priority application (see II, 5.4.2)

Rule 56(3)(a) (v) the applicant files a copy of the priority application within the applicable time limit*, unless such copy is already available to the EPO under Rule 53(2) (see II, 5.4.3)

Rule 56(3)(b) (vi) where the priority document is not in an official language of the EPO, the applicant files a translation into one of these languages within the applicable time limit*, unless such a translation is already available to the EPO under Rule 53(3) (see II, 5.4.4)

Rule 56(3)(c) (vii) the applicant indicates where in the priority document and, if applicable, where in its translation, the late-filed missing parts of the description, or drawings, are completely contained, and does so within the applicable time limit * (see II, 5.4.2).

* *For the applicable time limit see whichever of II, 5.1 or 5.2 applies.*

Where criterion (i) is not satisfied, the late-filing of those parts is deemed not to have been made and all references thereto in the application are deemed to be deleted under Rule 56(4)(a) (see II, 5.1

and 5.2). In this case the filing date does not change, but the late filed parts are not introduced into the application either.

If the request according to Rule 56(3) does not comply with one or more of the above requirements (ii)-(iv), then according to Rule 56(2) the date of filing will change to the date on which the EPO received the late-filed missing parts of the application. The EPO will send the applicant a communication informing him of this according to Rule 56(2). *Rule 56(2)*

If the request according to Rule 56(3) does not comply with one or more of the above requirements (v)-(vii), then according to Rule 56(5) the date of filing will change to the date on which the EPO received the late-filed missing parts of the application. The EPO will send the applicant a communication informing him of this according to Rule 56(5). *Rule 56(5)*

5.4.1 Late-filed missing parts and the priority claim

In the context of a request under Rule 56(3) the EPO will check that the requirements for the priority claim are met (see III, 6).

Where the applicant files a request under Rule 56(3) (see II, 5.4), the priority claim in question must have been in existence no later than the filing of this request. To this end, the applicant can file a simultaneous request, contained in one single submission:

(i) to insert a new priority claim not present when the application was filed according to Rule 52(2), and

(ii) to base late-filed missing parts of the description, or drawings, on that priority claim according to Rule 56(3)

This is subject to the proviso that the above simultaneous request respects both the time limit according to Rule 52(2) for insertion of a new priority claim (see III, 6.5.1) and the applicable time limit for making the request according to Rule 56(3) (see whichever of II, 5.1 or 5.2. applies). If this is the case, then the requirement under Rule 56(3) that priority be claimed is met (see II, 5.4(ii)).

Alternatively, the applicant may file submission (i) earlier (again, provided that it is filed within the time limit according to Rule 52(2)) and then subsequently file submission (ii) (again, provided that it complies with the applicable time limit). However, it is not possible to file request (ii) before request (i), because in this case request (ii) would be filed at a time when there is no priority claim, and it would not meet the requirements of Rule 56(3).

5.4.2 The missing parts are completely contained in the claimed priority

In cases where no translation of the priority is required and the application and priority are in the same official language, the

requirement that the late-filed parts of the application are "completely contained" in the claimed priority is met only if the parts of the claimed priority identified by the applicant according to Rule 56(3)(c) contain the same drawings, with the same annotations or for late-filed parts of the description, contain the same text.

If a translation of the claimed priority is required, then the requirement that the late-filed parts of the application are "completely contained" in the claimed priority is met only if the parts of the translation of the claimed priority identified by the applicant according to Rule 56(3)(c) contain the same drawings, with the same annotations or, for late-filed-parts of the description, contain the same text.

5.4.3 Copy of the claimed priority

The copy of the priority application which is required for the request according to Rule 56(3) does not need to be certified. However, if the applicant does provide a certified copy in the context of his request according to Rule 56(3), he will not need to provide it again in the context of his priority claim according to Rule 53(1).

Where a copy of the claimed priority is already available to the EPO under Rule 53(2) in accordance with the conditions laid down by the President, the applicant does not need to file it at all. Currently, this applies where the claimed priority is one of the following (see the Decision of the President of the EPO dated 17 March 2009, OJ EPO 4/2009, 236):

(a) a European application

(b) an International application filed with the EPO as receiving Office

(c) a Japanese patent or utility model application

(d) a Korean patent or utility model application

(e) a US patent application or provisional patent application subject to the document exchange agreement with the USPTO (see III, 6.7).

5.4.4 Translation of the priority

Where a translation of the claimed priority is already available to the EPO under Rule 53(2), the applicant does not need to file it.

In cases where the claimed priority is in an official language of the EPO and the European application is in a different official language of the EPO, there is no requirement for the applicant to file a translation of the priority according to Rule 56(3)(b). However, since the language of the priority and of the European application differ, the requirement that the newly introduced drawings (if they contain annotations) or parts of the description are "completely contained" in the priority (Rule 56(3)) is not

met. This can be overcome by the applicant's supplying within the applicable time limit (see whichever of II, 5.1 or 5.2 applies), either:

(i) a translation from the official language of the priority into the official language of the European application of those parts of the priority identified by the applicant as completely containing the missing parts of the description, or drawings (Rule 56(3)(c)), or

(ii) a declaration indicating that the late-filed missing parts of the description, or drawings, are an exact translation of the parts of the priority identified by him according to Rule 56(3)(c).

The entire priority document does not need to be translated, since this translation is required to satisfy the "completely contained" requirement of Rule 56(3), not the translation requirement of Rule 56(3)(b).

5.5 Withdrawal of late-filed missing drawings/parts of the description

Rule 56(2) and (4)

Where the applicant files missing parts of the description, or drawings, and makes no request to base these late-filed parts on a claimed priority, he is informed of the new date of filing in a communication from the EPO (see II, 5.3). Within one month of this communication, the applicant may withdraw the late-filed parts of the application and if he does so, the re-dating of the application is deemed not to have been made and all references to the missing parts of the description, or drawings, are deemed to be deleted. The EPO will inform the applicant of this.

Rule 56(2), (4) and (5)

Where the applicant files missing parts of the description, or drawings, and requests that these late-filed parts be based on a claimed priority, but the requirements of Rule 56(3) are not met within the applicable time limit, the date of filing changes to the date on which the late-filed parts of the application are received at the EPO (Rule 56(2) or (5)). The applicant is informed of the new date of filing in a communication from the EPO. Within one month of this communication, the applicant may withdraw the late-filed parts of the application (Rule 56(6)); if he does so, the re-dating of the application is deemed not to have been made and all references to the missing parts of the description, or drawings, are deemed to be deleted (Rule 56(4)). The EPO will inform the applicant of this.

Where references to a missing figure, e.g. "see Fig. 4", are deemed to be deleted, then reference signs cited in the context of that reference are also deemed to be deleted, although any technical information in the reference which is still technically meaningful without the reference may be retained: e.g. "see Fig, 4, a distillation column (1), provided with a condenser (2)" becomes "a distillation column provided with a condenser".

If the late-filed missing parts of the application do not satisfy the physical requirements of Rule 49, the EPO will not request the applicant to correct this deficiency according to Rule 58, until the one-month period for withdrawing them has expired without the applicant having withdrawn them (see III 3.2.2).

Chapter III

Examination of formal requirements

1. General

1.1 Formal requirements

The formal requirements that an application has to meet and which are the subject of an examination by the Receiving Section are those specified in Art. 90(3). These requirements relate to the following: *Art. 90(3)*

(i) representation;

(ii) physical requirements of the application;

(iii) abstract;

(iv) request for grant;

(v) claim to priority;

(vi) designation of inventor;

(vii) translations, where required;

(viii) the presence of at least one claim;

(ix) filing and search fees

1.2 Further checks

In addition to the above, it is necessary for the Receiving Section to:

(i) carry out a preliminary check of the description and claims in order to ensure that the title of the invention, which will appear in the published application, is in general accord with the requirements of Rule 41(2)(b) *Rule 45(1) and (2)* *Rule 25* *Art. 55(1)(b)* *Rule 31* *Rule 30*

(ii) check whether any claims fees due have been paid (see also III, 9)

(iii) check whether the certificate of exhibition under Rule 25 has been filed where the invention has been displayed under Art. 55(1)(b) (see also IV, 3)

(iv) check whether in the case of European patent applications relating to biological material the information pursuant to Rule 31(1)(c) and 31(d) is complete (see also IV, 4)

(v) check whether in the case of an application with nucleotide and/or amino acid sequences a prescribed sequence listing has

also been filed (see also IV, 5, and the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, C.1 and the Notice from the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, C.2).

The requirements of the above paragraphs and the procedure to be followed when the requirements are not met are considered in subsequent sections of this Chapter.

2. Representation

2.1 Requirements

The formalities officer must ensure that the requirements with regard to representation as set out in IX, 1 are met. The main points to be considered are:

(i) the necessity for applicants who have neither a residence nor principal place of business in a Contracting State to be represented by an authorised professional representative or by an authorised legal practitioner fulfilling the requirements of Art. 134(8);

(ii) that, where an applicant who is resident in or has his principal place of business in a Contracting State is represented by an employee, the employee is authorised; and

(iii) that the authorisation, if any is required (see IX, 1.5 and the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, L.1), is in order, duly signed (see IX, 3.2 and 3.4) and is filed in due time.

2.2 Non-compliance

The effect of non-compliance with the provisions with regard to representation and the action to be taken by the formalities officer in dealing with any deficiency are considered in III, 16.

3. Physical requirements

3.1 General remarks

Art. 90(3) Every application that is subject to formal examination is examined for compliance with the requirements as to form set out below. Non-compliance with the requirements is considered in III, 16.

3.2 Documents making up the application, replacement documents, translations

It is the responsibility of the Receiving Section to ensure that the documents making up the application, i.e. request, description, claims, drawings and abstract, meet the requirements of Rule 49(2) to (9) and (12) and, with regard to drawings, the requirements of Rule 46, to the extent necessary for the purpose of a reasonably uniform publication of the application under Rule 68(1). The Receiving Section should

therefore not draw the attention of the applicant to any deficiencies under Rule 46(2)(i) or (j) or question whether tables included in the claims meet the requirements of Rule 49(9). In the event of deficiencies under Rule 30, the Receiving Section must invite the applicant to remedy them (Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, C.1 and the Notice from the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, C.2; see also IV, 5).

Rule 10
Art. 94(1)
Rule 70(2)
Rule 49(1)
Rule 50(1)

Once the application is transferred to it, the Examining Division assumes responsibility for formal matters, and should pay particular attention to the more technical requirements of Rule 46 and Rule 49 including particularly the above-mentioned requirements under Rule 46(2)(i) and (j) and Rule 49(9) and those laid down in Rule 49(10) and (11). The particular requirements for drawings are dealt with in Chapter X. With regard to the more technical requirements, such as those of Rule 46(2)(f) and (h), the Receiving Section should, in case of doubt, consult and take the advice of the Search Division. The Receiving Section should also consider taking action when the Search Division draws its attention to a deficiency which it had overlooked. It should be noted that, in accordance with Rule 46(3), flow sheets and diagrams are to be considered as drawings. As indicated in IX, 2.2, replacement documents and translations in an official language of documents filed under the provisions of Art. 14(2) or (4) are subject to the same requirements as the documents making up the application.

3.2.1 Physical requirements of applications filed by reference to a previously filed application

If the application is filed by reference to a previously filed application according to Rule 40(1)(c) (see II, 4.1.3.1), where no translation is required, the certified copy of the previously filed application required under Rule 40(3) must satisfy the physical requirements. If the previously filed application is not in an official language of the EPO, only the translation required under Rule 40(3) must satisfy the physical requirements, provided that the authenticity of the contents of the original is not impugned and that the original is of sufficient quality to allow good reproduction (Rule 49(12)).

3.2.2 Physical requirements of late-filed application documents

Where claims are filed after the date of filing (see III, 15) or where missing parts of the description, or drawings are inserted after the date of filing (see II, 5), all of these late-filed application documents must also satisfy the physical requirements. Consequently, the EPO will carry out two separate checks first on the physical requirements of the original application documents and second on any late-filed claims or missing parts of the description, or drawings.

In the event that late-filed missing parts of the description, or drawings result in a change of the date of filing, the applicant can withdraw the late-filed parts of the description, or drawings up to one month after

being notified of the change in filing date (Rule 56(6)). Consequently, if the late-filed missing parts of the description, or drawings:

(i) contain deficiencies with regard to the physical requirements, and

(ii) result in a change of the date of filing

then the EPO will wait until the one-month period for their withdrawal has expired and will then send a communication according to Rule 58 in respect of these deficiencies, if the applicant has not withdrawn them in due time.

3.3 Other documents

The formalities officer should also ensure that documents other than those referred to in III, 3.2 meet the requirements set out in IX, 2.3, i.e. be typewritten or printed with a margin of about 2.5 cm on the left-hand side of each page.

3.4 Signature

Documents, with the exception of annexed documents, filed after filing the application must be signed by the applicant or his representative (see IX, 3).

4. Request for grant

4.1 General remarks

Rule 41(1)

The request for grant must be made on the appropriate EPO form (Form 1001), even though the request (the indication that a patent is sought, referred to in II, 4.1(i)) need initially be in no particular form. Paper versions of Form 1001 are available to applicants free of charge from the EPO or competent national authorities with which applications may be filed. The form is furthermore available via the EPO website on the Internet and is also included in the *epoline*® Online Filing software, which is obtainable free of charge from the EPO (see: www.epo.org).

Whenever a new version of the Request for Grant form is issued, it is published in the Official Journal of the EPO. It is recommended always to use the latest version.

4.2 Examination of the Request for Grant form

The Receiving Section examines the request to ensure that it contains the information listed in Rule 41(2). The request form provides for the entry of that information. The petition for the grant (Rule 41(2)(a)) is an integral part of the form. The applicant must be allowed to correct deficiencies in the request to the extent indicated in III, 16.

4.2.1 Information on the applicant

The request must contain, in the manner specified in Rule 41(2)(c), the name, address and nationality of the applicant and the State in which his residence or principal place of business is located. Where the

application is in the name of more than one applicant, the requirement must be satisfied for each applicant. At this stage in the proceedings, the formalities officer should have regard to the provisions of II, 2 governing the entitlement of the person named as applicant to apply for a patent.

4.2.2 Signature

The request must be signed by the applicant or his representative. If there is more than one applicant, each applicant or his representative must sign the request. For further details as to the signature of the request, see IX, 3.2 to 3.4. *Rule 41(2)(h)*

(The provisions of Rule 41(2)(b), (e), (f) and (g), dealing respectively with the title of the invention, divisional applications, Art. 61 applications and claim to priority are considered under these headings in subsequent sections of this Chapter and in Chapter IV).

5. Designation of inventor

5.1 General remarks

Every application must designate the inventor. The designation is incorporated in the *epoline*® Online Filing software. When filing on paper, the designation is filed in a separate document where the applicant is not the inventor or the sole inventor; otherwise the designation must be effected in the Request for Grant form by placing a cross in the appropriate box in Section 22. Where the designation is effected in a separate document, a trilingual form available free of charge from the EPO or the central industrial property offices of the Contracting States should preferably be used. *Art. 81* *Rule 41(2)(j)*

5.2 Waiver of right to be mentioned as inventor

The inventor designated by the applicant may address to the EPO a written waiver of his right to be mentioned as inventor in the published European patent application and the European patent specification, in which case his name is not mentioned in the published European patent application, the European patent specification, the Register of European Patents (Rule 143(1)(g)) and, consequently, the European Patent Bulletin, always provided that the waiver is received in time. Moreover, in accordance with Rule 144(c), the designation of the inventor as well as the waiver is then excluded from file inspection pursuant to Art. 128(4). *Rule 20(1)* *Rule 143(1)(g)* *Rule 144(c)* *Art. 129(a)*

5.3 Designation filed in a separate document

Where the designation is filed in a separate document it must contain the surname, given names and full address (to meet the customary requirements for postal delivery) of the inventor, the statement, referred to in Art. 81, indicating the origin of the right to the patent and the signature of the applicant or his representative. *Rule 19(1)*

In the case of assignment, the words "by agreement dated ..." suffice, in the case of inventions by employees a mention that the inventor(s)

is/are employee(s) of the applicant(s) and in the case of succession a mention that the applicant(s) is/are heir(s) of the inventor(s).

The designation of inventor must be signed by the applicant or his representative. With regard to the signature, the provisions set out in IX, 3.2 to 3.4, apply.

Rule 19(2) The EPO does not verify the accuracy of the information given in the designation of the inventor.

If the designation of inventor is filed subsequently, the requirements set out in IX, 3.1 apply.

5.4 Notification

Rule 19(3) and (4) If the applicant is not the inventor or is not the sole inventor, the Receiving Section must notify the inventor of the data contained in the document designating the inventor together with the data mentioned in Rule 19(3) relating to the application. It should be noted, however, that neither the applicant nor the inventor may invoke either the omission of this notification or any errors contained in it.

The inventor is notified at his address as indicated by the applicant. If the notification is returned to the EPO because the inventor is not known at the address indicated or has moved to an unknown new address, the applicant is asked whether he knows the inventor's new address. If the applicant gives a new address, the inventor is notified at that address. Otherwise no further attempt at notification is made.

No notification is made where the inventor addresses to the EPO a written waiver of the notification under Rule 19(3) (cf. Notice of the EPO, OJ 5/1991, 266). The waiver must be filed with the designation of inventor and contain the information to be supplied to the inventor by the EPO under Rule 19(3), i.e.:

(i) the number and date of filing of the European patent application, if known;

(ii) where the priority of an earlier application is claimed, the date and State of the earlier application, and its number, if known;

(iii) the name of the applicant;

(iv) the title of the invention;

(v) the Contracting States designated in Section 32.1 of the Request for Grant form; and

(vi) the name(s) of any co-inventor(s).

5.5 Deficiencies

Where a designation is not filed, or where the designation filed is deficient (e.g. inventor's name or address or the signature of the applicant is missing) so that it cannot be considered as validly filed, the applicant is informed that the European patent application will be refused if the deficiency is not remedied within the period prescribed under Rule 60(1), which is within 16 months of the date of filing or, if priority is claimed, of the date of priority. This time limit is deemed to have been met if the information is communicated before completion of the technical preparations for publication (see VI, 1.2). If the deficiencies are not rectified in due time, the application is refused and the applicant is notified accordingly (as regards divisional applications, see IV, 1.5). Further processing is possible according to Art. 121 and Rule 135.

Art. 90(3) to (5)
Rule 60(1)
Art. 121

5.6 Incorrect designation

An incorrect designation may be rectified provided a request is received accompanied by the consent of the wrongly designated person and by the consent of the applicant for or the proprietor of the patent where the request is not filed by that party. If a further inventor is to be designated, the consent of the inventor(s) previously designated is not necessary (see J 8/82, OJ 4/1984, 155). The provisions of III, 5.3 and 5.4 apply to the corrected designation mutatis mutandis. Rectification may also be requested after the proceedings before the EPO are terminated.

Rule 21(1)

Where an incorrect designation has been rectified and where the incorrect designation was entered in the European Patent Register or published in the European Patent Bulletin, its rectification or cancellation shall also be published therein.

Rule 21(2)

6. Claim to priority (see also C-V)

6.1 General remarks

The applicant for a European patent is entitled to and may claim the priority of an earlier first application where:

(i) the previous application was filed in or for a State or WTO member recognised as giving rise to a priority right in accordance with the provisions of the EPC;

Art. 87(1), (2) and (5)

(ii) the applicant for the European patent was the applicant, or is the successor in title to the applicant, who made the previous application;

(iii) the European application is made during a period of twelve months from the date of filing of the first application (see, however, III, 6.6); and

(iv) the European application is in respect of the same invention as the invention disclosed in the previous application (see also C-V, 1).

As concerns (i) above, the previous application may be an application for a patent or for the registration of a utility model or for a utility certificate. However, a priority right based on the deposit of an industrial design is not recognised (see J 15/80, OJ 7/1981, 213).

Art. 87(3) So long as the contents of the previous application were sufficient to establish a date of filing, it can be used to determine a priority date, irrespective of the outcome (e.g. subsequent withdrawal or refusal) of the application.

As concerns (ii) above, the transfer of the application (or of the priority right as such) must have taken place before the filing date of the later European application and must be a transfer valid under the relevant national provisions. Proof of this transfer can be filed later.

However, in the case of joint applicants filing the later European patent application, it is sufficient if one of the applicants is the applicant or successor in title to the applicant of the previous application. There is no need for a special transfer of the priority right to the other applicant(s), since the later European application has been filed jointly. The same applies to the case where the previous application itself was filed by joint applicants, provided that all these applicants, or their successor(s) in title, are amongst the joint applicants of the later European patent application.

6.2 Applications giving rise to a right of priority

Applications giving rise to a right of priority referred to in A-III, 6.1(i) are those filed at industrial property offices:

Art. 87(1) (a) of or acting for States party to the Paris Convention for the Protection of Industrial Property,

Art. 87(1) (b) of or acting for any member of the World Trade Organisation (WTO), or

Art. 87(5) (c) not subject to either the Paris Convention or the Agreement establishing the WTO, but where:

(i) that authority recognises that a first filing made at the EPO gives rise to a right of priority under conditions and with effects equivalent to those laid down in the Paris Convention, and

(ii) the President of the EPO issues a communication indicating this.

To date, no such communication referred to in (c)(ii) has been issued and so this does not as yet apply. Furthermore, the members of the WTO do not necessarily have to be States as such, but may also be intergovernmental bodies or regions with special status such as the Separate Customs Territory of Taiwan, Penghu, Kinmen and Matsu.

In view of the wording of Art. 87(1) which refers to filings "in or for" any State party to the Paris Convention or member of the WTO, priority may be claimed of an earlier first filed national application, European application or international application. A list of the countries party to the Paris Convention is published on WIPO's website and is regularly published in the Official Journal of the EPO. Likewise a list of the members of the WTO is published on the website of the WTO, and this list is also regularly updated.

The decisions G 2/02 and G 3/02 (OJ 10/2004, 483) previously excluded the possibility of claiming priority from an application filed at the industrial property authority of members of the WTO which were not also signatory states to the Paris Convention (Art. 87(1) EPC 1973). This exclusion no longer applies under the revised Art. 87(1).

6.3 Multiple priorities

The applicant may claim more than one priority based on previous applications in the same or different States and/or WTO members. Where multiple priorities are claimed, time limits which are calculated from the priority date run from the earliest date of priority and, as a result, the European application must be made within twelve months from the earliest priority (see, however III, 6.6); this applies if earlier applications have been filed in any of the industrial property offices mentioned in III, 6.2.

Art. 88(2)

6.4 Examination of the priority document

The Receiving Section need not examine the content of the priority document. However, where it is obvious, e.g. from the title of the document, that the document relates to subject-matter quite different from that of the application, the applicant should be informed that it appears that the document filed is not the relevant document.

6.5 Declaration of priority

An applicant wishing to claim priority must file a declaration of priority indicating:

Art. 88(1)
Rule 52(1)
Rule 41(2)(g)
Art. 90(4)

(i) the date of the previous application,

(ii) the State or WTO member in or for which it was filed and

(iii) its file number.

The declaration of priority shall preferably be made on filing the European patent application (Rule 52(2)). In such a case the

declaration of priority, indicating at least the date on which and the country for which the earlier application was filed, should be present in the Request for grant form (Rule 41(2)(g)). However, if a priority claim is added or corrected after the Request for grant form has been filed (see III, 6.5.1 and 6.5.2), the applicant will not be invited by the EPO to file a corrected Request for grant under Rule 58.

The time limit for filing the certified copy of the priority document is the same as the time limit for making the priority claim (see III, 6.5.1 and 6.7). Consequently, where:

(a) the applicant supplies the certified copy on time

(b) it is in an official language of the EPO

(c) the date and file number are indicated on the certified copy

then the requirements of Rule 52(1) with regard to providing the date and file number of the priority are met.

6.5.1 Filing a new priority claim

Rule 52(2)

The declaration of priority should preferably be made on filing, but can be made up to 16 months from the earliest priority date claimed. That is to say, items (i)-(iii) mentioned in III, 6.5 can be supplied up to 16 months after the earliest claimed priority. Where the priority claim is inserted after the filing date and causes a change in the earliest priority date, this 16 month period is calculated from that new earliest priority date in accordance with Art. 88(2).

The applicant cannot request further processing in respect of the time limit for introducing a new priority claim under Rule 52(2), since it is excluded by Rule 135(2).

6.5.2 Correcting an existing priority claim

Rule 52(3)

The applicant may correct the declaration of priority within 16 months from the earliest priority date. Where the correction causes a change in the earliest claimed priority date, this time limit is the earlier to expire of:

(i) 16 months from the earliest priority date as originally claimed.

(ii) 16 months from the earliest priority date as corrected.

However, this time limit cannot expire earlier than four months after the date of filing. Thus, if the originally claimed priority date is incorrect and precedes the date of filing by more than twelve months, the applicant will always have at least four months to correct this date, i.e. the same period as if he had claimed the correct priority date (and for example got the file number wrong) and claimed a full twelve-month priority period.

If the applicant files a request for correction later it may, exceptionally, be allowed if it is apparent on the face of the published application that a mistake has been made (see V, 3 and other sources therein).

6.5.3 Deficiencies in the priority claim and loss of the priority right

Three potential deficiencies exist with regard to the priority claim, namely: *Art. 90(4) and (5)*

(i) failure to indicate a date of the previous application or to indicate the correct date

(ii) failure to indicate a state or WTO member in or for which it was filed or to indicate the correct state or WTO member

(iii) failure to supply a file number or to indicate the correct file number.

Deficiencies (i) and (ii) can only be corrected in accordance with the procedures and within the time limit indicated in III, 6.5.2. Failure to correct either of these deficiencies in time results in the loss of the priority right in question according to Art. 90(5). Further processing does not apply to the time limit under Rule 52(3), since it is excluded by Rule 135(2).

However, where the applicant has failed to indicate the file number of the previous application, as required by Rule 52(1), before expiry of the time limit under Rule 52(2), he is invited by the EPO to provide it within a period to be specified according to Rule 59. Failure to reply in time to this communication results in the loss of the priority right in question according to Art. 90(5). Further processing does not apply to the time limit under Rule 59 either, since it is also excluded by Rule 135(2).

6.6 Priority period

Where the date of a priority claim precedes the date of filing of the European patent application by more than twelve months, the applicant may be informed by the Receiving Section that there shall be no priority for the application unless he: *Art. 122* *Rule 136* *Rule 133* *Rule 134*

(i) indicates a corrected date lying within the twelve-month period preceding the date of filing and does so within the time limit according to Rule 52(3) (see III, 6.5.2), or

(ii) requests re-establishment of rights in respect of the priority period and does so within two months of the expiry of the priority period, and this request is subsequently granted (see paragraph below). This only applies where the applicant also filed the European application within the same two-month period.

Rules 133 and 134 apply to the priority period under Art. 87(1). In the event that the date indicated for the previous application is subsequent

to or the same as the date of filing, the procedure set out in III, 6.5.2 also applies (with regard to the possibility of effecting correction of clerical or similar errors, see V, 3).

According to Art. 122 and Rule 136(1) it is possible to obtain re-establishment of rights in respect of the priority period (twelve months according to Art. 87(1)). The request for re-establishment must be filed within two months of expiry of the priority period (Rule 136(1)) and the omitted act, i.e. the establishment of a date of filing for the European application, must also be completed in this period (Rule 136(2)). For more details on requesting re-establishment of rights see E-VIII, 2.2.

6.7 Copy of the previous application (priority document)

Rule 53(1)
Art. 88(2)
Art. 90(4)

A paper copy of the previous application for which priority is claimed (priority document) must be filed before the end of the sixteenth month after the date of priority. Where multiple priorities are claimed, the above-mentioned time limit runs from the earliest date of priority.

The copy must be certified as an exact copy of the previous application by the authority which received the previous application and must also be certified by that authority as to its date of filing. This certification of the date may take the form of a separate certificate issued by that authority stating the date of filing of the previous application (Rule 53(1), second sentence) or may be an integral part of the priority document itself. The certification of the authenticity of the copy may also be a separate document or an integral part of the priority document.

It is also possible to file a copy of the previous application (priority document) on physical media other than paper, e.g. CD-R, provided that:

(i) the physical medium containing the priority document is prepared by the authority which received the previous application, such as to guarantee that its content cannot undetectably be altered subsequently;

(ii) the content of the physical medium is certified by that authority as an exact copy of the previous application or the part contained therein; and

(iii) the filing date of the previous application is also certified by that authority.

The certificate(s) may be filed separately in paper form. The submitted medium must be readable and free of computer viruses and other forms of malicious logic.

Rule 53(2) together with the Decision of the President of the EPO dated 17 March 2009, OJ EPO 4/2009, 236 provide for the following exceptions to the requirement that a priority document be filed: *Rule 53(2)*

If the previous application is:

(i) a European patent application;

(ii) an international application filed with the EPO as receiving Office under the PCT;

(iii) a Japanese patent or utility model application;

(iv) a Korean patent or utility model application, or

(v) a US patent application or provisional patent application subject to the document exchange agreement with the USPTO,

then the EPO will include free of charge a copy of the previous application in the file of the European patent application. No request is necessary to this end. However, if the language of the previous application was not one of the official languages of the EPO, it may still be necessary to file the translation or declaration under Rule 53(3) (see III, 6.8).

Where the applicant has already supplied a copy of the priority in the context of a request to base late-filed parts of the description or drawings on the claimed priority under Rule 56 (see II, 5.4(v)). the applicant does not need to file it again. However, if the copy already provided was not certified as to its content and/or filing date, the applicant will need to provide the missing certification within the above time limit.

If the applicant fails to provide a certified copy of the priority document within the above-mentioned period (Rule 53(1)), the EPO will invite him to provide it within a period to be specified according to Rule 59. If the applicant fails to provide it within this period, the priority right in question is lost (Art. 90(5)). Further processing does not apply to the time limit according to Rule 59, since this is excluded according to Rule 135(2). *Art. 90(4) and (5)* *Rule 59*

6.8 Translation of the previous application

Where the previous application claimed as priority is not in an official language of the EPO and the validity of the priority claimed is relevant to the assessment of the patentability of the invention concerned, the EPO shall invite the applicant for or proprietor of the European patent to file a translation into an official language of the EPO within a period to be specified. *Art. 88(1)* *Rule 53(3)*

Since the applicant for a European patent might not have to file a translation in the examination procedure, in cases where the validity of

the claimed priority becomes relevant in the assessment of patentability in opposition proceedings, the EPO may make the above invitation during the opposition procedure.

In practice, the Search, Examining or Opposition Division dealing with the patent application or patent will inform the Formalities Officer that a translation of the priority is required and the Formalities Officer will then despatch the above communication.

If the applicant for or proprietor of the European patent does not provide the translation in time, then the intermediate document(s) which resulted in the validity of the priority claimed becoming relevant for the assessment of patentability will be considered to belong to the prior art under Art. 54(2) or Art. 54(3) as applicable. There is no further invitation to the applicant or proprietor to file the translation. However, if the applicant fails to observe this time limit, he can request further processing according to Art. 121 and Rule 135.

Where the applicant has already supplied a translation of the priority in the context of a request to base late-filed parts of the description or drawings on the claimed priority under Rule 56 (see II, 5.4(vi)). The applicant does not need to file it again.

The applicant for or proprietor of the European patent can file a translation of his priority of his own motion at any time during examination or opposition proceedings before the EPO.

Alternatively, a declaration that the European patent application is a complete translation of the previous application may be submitted within those same time limits (see also C-V, 3.4 and D-VII, 2). The declaration may already be made by crossing the appropriate box in the Request for Grant form (Form 1001). This declaration is only valid if the text of the European application as filed is an exact translation of the text of the earlier application of which priority is claimed. If the European application did not contain claims on the date of filing (see II, 4.1), the applicant can file these later (see III, 15). In such cases, for the declaration to be valid, the description of the European application must be an exact translation of the description of the claimed priority, regardless of whether the priority application contained claims on its filing date. However, where the European application contains claims on its date of filing and the priority application did not contain claims on its filing date or contained fewer claims on its filing date, the declaration is not valid. Furthermore, if the European application contains more or less text than is contained in the earlier application as filed, such a declaration cannot be accepted. Where the declaration cannot be accepted for any of the above reasons, in order to comply with the requirement for filing a translation, a complete translation must be filed within the above-mentioned time limit. A merely different arrangement of the various elements (i.e. the claims vs. the description) of the application does not affect the validity of such a declaration (see Legal Advice No. 19/1999, OJ 5/1999, 296).

6.9 Non-entitlement to right to priority

A European patent application has no right to priority if:

(i) the application was not filed within the twelve-month period referred to in III, 6.1(iii) and the applicant has neither: *Art. 87(1)*

(a) corrected the priority date on time (see III, 6.5.2), such that the date of filing of the European application no longer exceeds the twelve-month priority period under Art. 87(1), nor

(b) successfully requested re-establishment of rights in respect of the priority claim (see III, 6.6)

(ii) the previous application did not seek an industrial property right giving rise to a priority right (see III, 6.1); or *Art. 87(1)*

(iii) the previous application does not give rise to a priority right in respect of the State, WTO member or industrial property authority in or for which it was filed (see III, 6.1(i) and 6.2). *Art. 87(1) and (4)*

6.10 Loss of right to priority

The right to priority for a European patent application is lost where: *Art. 90(4) and (5)*

(i) the declaration of priority is not filed in due time (see III, 6.5.1);

(ii) the declaration of priority is not corrected in due time (see III, 6.5.2 and 6.5.3); or

(iii) the copy of the previous application is not filed in due time (see III, 6.7).

6.11 Notification

The applicant is notified of any non-entitlement to, or loss of, a priority right. The computation of time limits that depend on the priority will take this new situation into account. This also applies where entitlement to a priority right is surrendered. The termination of a priority right has no effect on a time limit which has already expired (see also C-V, 3.4 and E-VIII, 1.5). If the search has not yet been carried out, the Receiving Section notifies the Search Division of a loss of, or non-entitlement to, a priority date. *Rule 112(1)*

7. Title of the invention

7.1 Requirements

Rule 41(2)(b)

The request for grant must contain the title of the invention. A requirement of Rule 41(2)(b) is that the title must clearly and concisely state the technical designation of the invention and must exclude all fancy names. In this regard, the Receiving Section should take the following into account:

(i) personal names, fancy names, the word "patent" or similar terms of a non-technical nature which do not serve to identify the invention should not be used;

(ii) the abbreviation "etc.", being vague, should not be used and should be replaced by an indication of what it is intended to cover;

(iii) titles such as "Method", "Apparatus", "Chemical Compounds" alone or similar vague titles do not meet the requirement that the title must clearly state the technical designation of the invention;

(iv) trade names and trade marks should also not be used; the Receiving Section, however, need only intervene when names are used which, according to common general knowledge, are trade names or trade marks.

7.2 Responsibility

Rule 41(2)(b)

The ultimate responsibility for ensuring that the title accords with the provisions of the Implementing Regulations rests with the Examining Division. The Receiving Section should nevertheless take action to avoid, if possible, the publication of applications having titles which are clearly non-informative or misleading. It is necessary therefore that the Receiving Section takes cognisance of the provisions of Rule 41(2)(b) as set out in III, 7.1. In the event of obvious non-compliance with the provisions, the EPO will of its own motion change the title, if this appears necessary, without informing the applicant there and then. Only when the application is about to be published will the applicant be notified whether the title proposed by him has been changed (see OJ 4/1991, 224).

8. Prohibited matter

8.1 Morality or "ordre public"

Art. 53(a)
Rule 48(1)(a) and (2)

The application must not contain statements or other matter contrary to "ordre public" or morality. Such matter may be omitted when the application is published, the published application indicating the place and number of words or drawings omitted. (Where drawings are omitted regard should be had to the physical requirements of III, 3.2). The Receiving Section may check the description, claims and drawings to ascertain whether they contain offending matter. In order not to delay unduly the formalities examination, if carried out, this will

entail a cursory examination to ensure that the application does not contain the following prohibited matter: statements constituting an incitement to riot or to acts contrary to "ordre public", racial, religious or similar discriminatory propaganda, or criminal acts and grossly obscene matter. The Receiving Section may also take action to prevent the publication of such matter where the Search Division draws its attention to such matter which it had overlooked. The applicant is notified of the material omitted. In practice, it will usually be the Search Division which brings the existence of such material in the application to the attention of the Receiving Section.

8.2 Disparaging statements

Rule 48(1)(b) and (3)

According to Rule 48(1)(b), the application must not contain statements disparaging the products or processes of any particular person other than the applicant, or the merit or validity of applications or patents of any such person. However, mere comparisons with the prior art are not to be considered disparaging per se. Statements clearly coming within this category that become evident from the cursory examination referred to in III, 8.1, or to which attention is drawn by the Search Division, may be omitted by the Receiving Section when publishing the application. In cases of doubt the matter should be left for consideration to the Examining Division. The published application must indicate the place and number of any words omitted and the EPO must furnish, upon request, a copy of the passage omitted. The applicant is again notified of the material omitted. (See also treatment of prohibited matter in proceedings before the Examining Division, C-II, 7).

9. Claims fee

Rule 45(1) to (3)
Rule 112(1)
Rule 37(2)
Art. 2, No. 15, RFees

A European application which contains more than fifteen claims at the time of filing the claims (see the paragraph below) incurs payment of a claims fee in respect of each claim over and above that number. For applications filed and international applications entering the regional phase on or after 1 April 2009, a higher amount is payable for each claim in excess of 50. The claims' order is their sequence at their time of filing. If an application contains more than one set of claims, Rule 45 is only applicable for the set of claims containing the highest number of claims (see Legal Advice No. 3/85 rev., OJ 11/1985, 347). The claims fees must be paid within one month after the claims are filed.

The claims may be filed at the following stages:

(i) on the European filing date (see II, 4.1.5)

(ii) after the European filing date, in a timely response to a communication from the EPO indicating their absence under Rule 58 (see III, 15)

(iii) after the European filing date, by the applicant of his own motion before the EPO sends a communication according to Rule 58 (see III, 15)

Consequently, the claims fees must be paid within one month of whichever of the above dates of receipt applies.

If the claims fees have not been paid in due time, they may still be validly paid within a non-extendable period of grace of one month of notification of a communication pointing out the failure to observe the time limit. If a claims fee is not paid within the period of grace, the claim concerned is deemed to be abandoned and the applicant is notified to that effect. If the claims fees paid are insufficient to cover all the claims incurring fees (i.e. claim no. 16 onwards), and if when payment was made no indication was given as to which claims were covered by the fees paid, then the applicant is requested to specify which claims incurring fees are covered by the claims fees paid. The Receiving Section notifies the Search Division of claims that are deemed abandoned. Any claims fee duly paid is refunded only in the case referred to in Rule 37(2) (see II, 3.2, last paragraph).

In cases where:

(i) the application was filed by reference to a previously filed application (see II, 4.1.3.1), and

(ii) the applicant indicates on filing that the claims of this previously filed application take the place of claims in the application as filed,

the claims fees are due within one month of the filing date (since the claims of the previous application are effectively present on the European filing date). However, the EPO will not send the applicant a communication under Rule 45(2) inviting him to pay any claims fees due, until the applicant has filed the copy of the previous application, within two months of the filing date (Rule 40(3)), since it is only at this point that the EPO will know how many claims there are and consequently, how many claims fees, if any, are due.

Features of a claim deemed to have been abandoned pursuant to Rule 45(3) and which are not otherwise to be found in the description or drawings cannot subsequently be reintroduced into the application and, in particular, into the claims (J 15/88, OJ 11/1990, 445).

Regarding Euro-PCT applications entering the European phase, see VII, 1.3 and 3.8.

10. Abstract

10.1 General remark

Art. 78(1)(e)
Art. 90(3)
Rule 57(d)

Every application for a patent must contain an abstract. The effect of non-compliance with this requirement is dealt with in III, 16.

10.2 Content of the abstract

The definitive content of the abstract is the responsibility of the EPO. Since the definitive content of the abstract must be determined and transmitted to the applicant along with the search report, in practice this means in particular the Search Division. However, where it is obvious that the abstract filed does not belong to the application, and this should normally be confirmed by the Search Division, the applicant is informed that the document filed does not constitute an abstract and that unless he corrects the deficiency the sanction referred to in III, 16 will apply.

Rule 66

10.3 Figure accompanying the abstract

If the application contains drawings, the applicant should indicate the figure (or exceptionally figures) of the drawings which he suggests should accompany the abstract. Where this requirement is not met, the Search Division decides which figure(s) to publish. For the further procedure see B-XI, 4.

Rule 47(4)

11. Designation of Contracting States

11.1 General remarks

All Contracting States party to the EPC at the filing date of the application shall be deemed to be designated in the request for grant of a European patent (for a list of the EPC Contracting States, see the General Part of the Guidelines, section 6). Any other State entered on the request for grant must be disregarded (see for the designation of Contracting States on the Request for Grant form, III, 11.2.2, 11.3.5 and 11.3.6). As indicated in II, 2, when the application is in the name of joint applicants, each may designate different Contracting States; objection should be raised during the course of the examination for formal requirements if there is any ambiguity as to the States designated by the individual applicants.

Art. 79(1)

11.2 European patent applications filed on or after 1 April 2009

11.2.1 Designation fee; time limits

The designation of Contracting States is subject to payment of a designation fee.

Art. 79(2)
Rule 39
Art. 149(1)

For applications filed on or after 1 April 2009 this is a flat designation fee covering all EPC Contracting States. Therefore, for these applications, the system of charging designation fees for individual designated states (see A-III, 11.3) no longer applies. For European divisional applications see also A-IV, 1.3.4 and A-IV, 1.4.1.

Art. 2, No. 3 RFees

For European patent applications, the designation fee must be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report.

Rule 39

For divisional applications and new applications under Art. 61(1)(b), the designation fee must be paid within six months of the date on which

Rule 17(3)
Rule 36(4)

the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the European divisional application or the new European patent application (see A-IV, 1.4.1).

For Euro-PCT applications entering the European phase on or after 1 April 2009, see A-III, 11.2.5.

11.2.2 Payment of designation fee

Rule 39(2)

The automatic designation of all the Contracting States party to the EPC at the time of filing of the European patent application is effected by the filing of the application, whereas the designation fee may be paid later (see A-III, 11.2.1).

Art. 2, No. 3 RFees
Art. 6(1) RFees

Payment of the designation fee covers all the Contracting States, except those States the designation of which has been expressly withdrawn.

Such payment simply needs to be marked "designation fee" in order for the purpose of the payment to be established.

11.2.3 Consequences of non-payment of the designation fee

Rule 39(2)

Where the designation fee has not been paid by expiry of the period specified in Rule 39(1), the application is deemed to be withdrawn.

In this case, the EPO sends the applicant a communication under Rule 112(1) notifying him of this loss of rights. In response to this communication, the applicant can request further processing according to Art. 121 and Rule 135 (see E-VIII, 2.1).

The loss of rights ensues on expiry of the normal period under Rule 39(1) and not upon expiry of the period for further processing (see G 4/98, OJ 3/2001, 131, mutatis mutandis).

For Euro-PCT applications entering the European phase on or after 1 April 2009, see A-III, 11.2.5.

11.2.4 Withdrawal of designation

Art. 79(3)
Rule 39(2) and
Rule 39(3)
Rule 15

Subject to the final sentence of this paragraph, the designation of one or more Contracting States may be withdrawn by the applicant at any time up to the grant of the patent. Withdrawal of the designation of all the Contracting States results in the application being deemed to be withdrawn and the applicant is notified accordingly.

In neither case is the designation fee refunded. The designation of a Contracting State may not be withdrawn as from the time when a third party proves to the EPO that he has initiated proceedings concerning entitlement and up to the date on which the EPO resumes proceedings for grant.

The applicant may withdraw designations when filing the European application, for example to avoid overlapping prior national rights with

the priority application according to Art. 139(3). Timely payment of the designation fee will not cause those designations which have been withdrawn to be re-activated.

For European divisional applications see A-IV, 1.3.4.

11.2.5 Euro-PCT applications entering the European phase

For Euro-PCT applications entering the European phase, the designation fee must be paid within 31 months of the filing or priority date, if the time limit specified in Rule 39(1) has expired earlier.

Rule 159(1)(d)

According to Rule 160(1), if the designation fee for the Euro-PCT application entering the European phase is not paid within the basic period under Rule 159(1)(d), the European patent application (see Art. 153(2)) is deemed to be withdrawn. If the EPO finds that such deemed withdrawal of the European patent application has occurred, it notifies the applicant of this loss of rights according to Rule 112(1). In response to this communication, the applicant can request further processing according to Art. 121 and Rule 135 (see E-VIII, 2.1).

Rule 160
Art. 153(2)

For the designation fee in relation to Euro-PCT applications entering the European phase, see also A-VII, 1.3 and A-VII, 3.11.

11.3 European patent applications filed before 1 April 2009

In this section reference is made to the old version of the relevant provisions, which remain applicable to European patent applications filed and Euro-PCT applications entering the European phase before 1 April 2009.

11.3.1 Designation fee; time limits

The designation of a Contracting State is subject to payment of a designation fee. A single joint designation fee is payable for Switzerland and Liechtenstein. The designation fees are deemed paid for all Contracting States upon payment of seven times the amount of one designation fee.

Art. 79(2)
Rule 39, old version
Art. 149(1)
Art. 2, Nos. 3 and 3a RFees, old versions

For European patent applications, the designation fees must be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report.

For divisional applications and new applications under Art. 61(1)(b) filed before 1 April 2009, the designation fees must be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the European divisional application or the new European patent application (see IV, 1.4.1).

Rule 17(3), old version
Rule 36(4), old version

For Euro-PCT applications entering the European phase before 1 April 2009, see III, 11.3.9.

11.3.2 Consequences of non-payment of designation fees

Rule 39(2), old version

Where the designation fee has not been paid in due time in respect of any designated State, the designation of that State shall be deemed to be withdrawn (see also III, 11.3.4).

If the designation fee for a particular Contracting State is not paid in time, the EPO sends the applicant a communication under Rule 112(1) notifying him of the deemed withdrawal of the designation in question according to Rule 39(2). In response to this communication, the applicant can request further processing according to Art. 121 and Rule 135 in respect of this partial loss of rights (see E-VIII, 2.1). This communication is not sent if the applicant waives the right to receive it in respect of the state in question, by crossing the appropriate box in the Request for grant form. By crossing this box, the applicant waived his right to further processing in respect of the designation or designations in question.

For Euro-PCT applications entering the European phase before 1 April 2009, see III, 11.3.9.

11.3.3 Amount paid insufficient

Art. 6(2), 1st sentence, RFees

If, during the period for requesting further processing, designation fees are paid without an additional sum sufficient to cover the amount of the further processing fee, it is first necessary to establish how many designation fees including the further processing fee are covered by the total sum paid for that purpose. The applicant must then be invited, pursuant to Art. 6(2), first sentence, RFees, to inform the EPO for which Contracting States the designation fees plus further processing fee are to be used (see J 23/82, OJ 4/1983, 127, mutatis mutandis). For the subsequent procedure, see III, 11.3.7.

11.3.4 Application deemed to be withdrawn

Rule 39(3), old version

Where no designation fee is validly paid by expiry of the period specified in Rule 39(1), the application is deemed to be withdrawn.

If no designation fees are paid on time leading to a deemed withdrawal of the application under Rule 39(3), old version, the EPO sends the applicant a communication according to Rule 112(1) notifying him of this loss of rights. In response to this communication, the applicant can request further processing according to Art. 121 and Rule 135 in respect of this total loss of rights (see E-VIII, 2.1).

Where the application is deemed to have been withdrawn because of failure to pay the designation fees, the loss of rights ensues on expiry of the normal period under Rule 39(1). Similarly, the deemed withdrawal of a designation of a Contracting State takes effect upon expiry of the normal period under Rule 39(1), and not upon expiry of the period for further processing (see G 4/98, OJ 3/2001, 131, mutatis mutandis). The applicant is notified of the loss of rights and can remedy it by requesting further processing according to the procedures explained in III, 11.3.2.

11.3.5 Request for Grant form

Art. 79(1) and (2)

The automatic designation of all of the Contracting States party to the EPC at the time of filing of a European patent application is effected by the filing of the application, whereas the designation fees payable for an application filed before 1 April 2009 may be paid later.

The applicant has time – until expiry of the period for paying the designation fees (Rule 39(1) and Rules 17(3) and 36(4)) – to decide which Contracting States he actually wants his patent to cover. This he does by paying the designation fees for those States, which may include an additional sum required to validate a request for further processing.

11.3.6 Indication of the Contracting States

Art. 2, No. 3, RFees
Art. 6(1) RFees

For European patent applications filed before 1 April 2009, the designation fees are deemed paid for all Contracting States upon payment of seven times the amount of one designation fee. Such payment simply need be marked "Designation fees" in order for the purpose of the payment to be established.

If, on the other hand, the applicant intended to pay fewer than seven designation fees when filing the application, he should have indicated the relevant Contracting States in the appropriate Section of the Request for Grant form (Form 1001, versions prior to April 2009). This helped to ensure that the designation fees paid were properly entered in the books. If designation fees are not paid within the basic time limit, a communication under Rule 112(1) is issued.

In response to the communication under Rule 112(1), the applicant may request further processing in respect of the lost designation(s). However, no Rule 112(1) communication will be sent and no further processing can be requested with regard to designations in respect of which the applicant waived these rights by crossing the appropriate box on the Request for grant form or where the designation in question has been withdrawn.

For applicants taking part in the automatic debiting procedure, see also XI, 7.2.

11.3.7 Amount payable

Art. 6(2), 1st sentence, RFees
Art. 8(2), 2nd sentence, RFees, old version
Rule 39(2), old version
Rule 112(1)

If, given the amount payable under the time limit in question, the sum paid for designation fees during the periods under Rule 39(1) or Rule 135(1) does not cover all the Contracting States indicated in the Request for Grant form (Form 1001), and the payer failed to indicate for which Contracting States the fees are intended, then he is requested to indicate which States he wishes to designate, within a period stipulated by the EPO (see also III, 11.3.3). If he fails to comply in due time, then Art. 8(2) RFees applies: the fees are deemed to have been paid only for as many designations as are covered by the amount paid, in the order in which the Contracting States have been designated (see J 23/82, OJ 4/1983, 127, mutatis mutandis). The

designation of Contracting States not covered by the fees are deemed withdrawn, and the applicant is notified of the loss of rights (see III, 11.3.4 paragraph 3, regarding the time at which loss of rights ensues).

11.3.8 Withdrawal of designation

Art. 79(3)
Rule 39(3) and (4), old versions
Rule 15

Subject to the final sentence of this paragraph, the designation of a Contracting State may be withdrawn by the applicant at any time up to the grant of the patent. The designation fee is not refunded when a designation is withdrawn. Withdrawal of the designation of all the Contracting States results in the application being deemed to be withdrawn and the applicant is notified accordingly. The designation of a Contracting State may not be withdrawn as from the time when a third party proves to the EPO that he has initiated proceedings concerning entitlement and up to the date on which the EPO resumes proceedings for grant.

The applicant may withdraw designations when filing the European application, for example to avoid overlapping prior national rights with the priority application according to Art. 139(3). Timely payment of designation fees for designations which have been withdrawn, will not cause those designations to be re-activated. Furthermore, no Rule 112(1) communication will be sent in respect of a failure to pay designation fees for any designation which has been withdrawn.

11.3.9 Euro-PCT applications entering the European phase

Rule 159(1)(d)

For Euro-PCT applications entering the European phase, the designation fees must be paid within 31 months of the filing or priority date, if the time limit specified in Rule 39(1) has expired earlier.

Rule 160, old version
Art. 153(2)

Pursuant to Rule 160(2), the designation of any Contracting State for which no designation fee has been paid in time is deemed to be withdrawn. According to Rule 160(1), if no designation fee for the Euro-PCT application entering the European phase is paid at all within the basic period under Rule 159(1)(d), the European patent application (see Art. 153(2)) is deemed to be withdrawn. If the EPO finds that such deemed withdrawal of the European patent application or the designation of a Contracting State has occurred, it notifies the applicant of this loss of rights according to Rule 112(1). In response to this communication, the applicant can request further processing according to Art. 121 and Rule 135 (see E-VIII, 2.1).

For designation fees in relation to Euro-PCT applications entering the European phase, see also VII, 1.3 and 3.11.

12. Extension of European patent applications and patents to States not party to the EPC

12.1 General remarks

At the applicant's request and on payment of the prescribed fee European patent applications (direct or Euro-PCT) and thus patents

can be extended to States for which an Extension Agreement with the EPO has become effective (Extension States).

Extension may be requested for the following States:

Albania (AL)	since 1 February 1996;
Serbia (RS)	since 1 November 2004; and
Bosnia and Herzegovina (BA)	since 1 December 2004

The EPO's extension agreements with the **Republic of Slovenia** (entry into force: 1 March 1994), the **Republic of Romania** (15 October 1996), the **Republic of Lithuania** (5 July 1994), the **Republic of Latvia** (1 May 1995), the **Republic of Croatia** (1 April 2004) and the **former Yugoslav Republic of Macedonia** (1 November 1997) terminated when these countries acceded to the EPC with effect from 1 December 2002, 1 March 2003, 1 December 2004, 1 July 2005, 1 January 2008 and 1 January 2009 respectively. However, the extension system continues to apply to all European and international applications filed prior to those dates, and to all European patents granted in respect of such applications.

A request for extension to the above-mentioned States is deemed to be made with any European application filed after entry into force and before the termination of respective Extension Agreements. This applies also to Euro-PCT applications provided that the EPO has been designated for a European patent **and** the Extension State has been designated for a national patent in the international application. The request is deemed withdrawn if the extension fee is not paid within the prescribed time limit (see III, 12.2). It is by paying the extension fee that the applicant decides to extend his application to a certain Extension State. The declaration in the appropriate section of the Request for Grant form (Form 1001) or of Form 1200 for entry into the European phase before the EPO, where the applicant is asked to state whether he intends to pay the extension fee, is merely for information purposes and intended to assist in recording fee payments.

A request for extension in respect of a divisional application (see IV, 1) is deemed to be made only if the respective request is still effective in the parent application when the divisional application is filed.

12.2 Time limit for payment of extension fee

Under the applicable national provisions of the Extension States, the extension fee must be paid within the periods prescribed by the EPC for the payment of designation fees (see III, 11.2.1, A-III, 11.2.5, and VII, 1.3). If the extension fee is not paid within the applicable period, the request for extension is deemed withdrawn. If no designations of EPC Contracting States are deemed withdrawn under Rule 39(2) and the extension fee has not been paid within the applicable basic time

limit (Rules 39(1), 17(3), 36(4) and 159(1)(d)), a communication under Rule 112(1) is not issued, and further processing will not be possible in respect of the extensions which are deemed to be withdrawn. However, if:

(i) one or more extensions are deemed withdrawn due to the applicant's failure to pay extension fees on time, and

(ii) one or more designations of EPC Contracting States are deemed to be withdrawn because the designation fee(s) in respect of such state(s) is/are not paid on time (see III, 11.2.3 and A-III, 11.3.2) and:

(a) the applicant has not actively withdrawn these designations and

(b) the applicant has not waived the right to receive a Rule 112(1) communication in respect of these designations

then the EPO will notify the applicant of the loss of rights with regard to both the designations *and extensions* in question according to Rule 112(1). In this case, the applicant may then request further processing according to Art. 121 and Rule 135 in respect of both the designations *and extensions* which were deemed to be withdrawn. As regards the amount of the fee for further processing in respect of the extension fees , Art. 2, No. 12 RFees applies mutatis mutandis.

Furthermore, re-establishment of rights according to Art. 122 and Rule 136 is not possible in respect of payment of the extension fee.

12.3 Withdrawal of extension

The request for extension may be withdrawn at any time. It will be deemed withdrawn if the European patent application or the Euro-PCT application is finally refused, withdrawn or deemed withdrawn. A separate communication is not issued to the applicant. Validly paid extension fees are not refunded.

12.4 Extension deemed requested

All Extension States are deemed requested (see, however, III, 12.1, 4th paragraph, regarding Euro-PCT applications) and are therefore indicated in the published application. These States, and those for which the extension fee has been paid, are indicated in the Register of European Patents and in the European Patent Bulletin.

12.5 National register

Extension States publish in their national register the relevant data relating to European patent applications and patents extending to their territory.

13. Filing and search fees

13.1 Payment of fees

The applicant is required to pay a filing fee and, subject to the exception mentioned below (see the note to point (iii) below), a search fee. The filing and search fees must be paid within the following periods: *Art. 78(2)*

(i) where neither (ii) nor (iii) applies, within one month of the filing date of the European application *Rule 38*

(ii) for European divisional applications or European applications filed according to Art. 61(1)(b), within one month from the date of filing of the divisional or Art. 61(1)(b) application *Rule 36(3)* *Rule 17(2)*

(iii) for Euro-PCT applications, within 31 months of the filing date or, where applicable, from the earliest claimed priority date* *Rule 159(1)*

* Note that when a supplementary European search report is not prepared by the EPO (see B-II, 4.3), no search fee is required for the Euro-PCT application (Rule 159(1)(e)).

With regard to applications of types (i) and (ii), the EPO will check that these fees have been paid. If either fee is not paid on time, the application is deemed to be withdrawn. The EPO will notify the applicant of the loss of rights according to Rule 112(1); the applicant can respond by requesting further processing according to Art. 121 and Rule 135. *Art. 90(3)* *Rule 57(e)* *Art. 78(2)* *Rule 36(3)* *Rule 17(2)*

With regard to Euro-PCT applications (type (iii)), see VII, 1.3.

13.2 Additional fee (if application documents comprise more than thirty-five pages)

This section relates only to applications filed and international applications entering the European phase on or after 1 April 2009 (See also Notice from the EPO dated 26 January 2009, OJ 2/2009, 118). *Rule 38(2) and Rule 38(3)* *Art. 2, No. 1a RFees*

An additional fee is payable as part of the filing fee for European patent applications which are filed on or after 1 April 2009 and comprise more than thirty-five pages. The amount of the fee is calculated according to the number of pages over thirty-five. The language reduction under Rule 6(3) applies. The additional fee is payable within one month of the filing date of the application or of the date of filing a European divisional application or a European application according to Article 61(1)(b). If the application is filed without claims or by reference to a previously filed application, the additional fee is payable within one month of filing the first set of claims or one month of filing the certified copy of the application referred to in Rule 40(3), whichever expires later. The additional fee is calculated on the basis of the pages of the description, claims, any drawings and one page for the abstract, in the language of filing. The pages of the request for grant (EPO Form 1001) and those

forming part of a sequence listing within the meaning of Rule 30(1) are not counted, provided the sequence listing contained in the description complies with WIPO Standard St. 25. If the application is filed by reference to a previously filed application, the pages of the certified copy, excluding those for the certification and for bibliographic data, are taken as the basis for the calculation. If the application is filed without claims, the additional fee takes account of the pages of the first set of claims filed.

For international (Euro-PCT) applications entering the European phase on or after 1 April 2009, the additional fee is payable as part of the filing fee within the 31-month period of Rule 159(1). It is calculated on the basis of the international application as published, any amendments under Article 19 PCT and one page for the abstract. If there is more than one page of bibliographic data, the further pages are not counted. The pages of the latest set of any amended documents (Article 34 PCT, amendments filed upon entry) on which European phase processing is to be based (Rule 159(1)(b)) will also be taken into account where available to the EPO by the date of payment of the additional fee within the thirty-one months. If the applicant intends pages of the international publication or of amendments to be replaced by pages of the latest set of amendments, and therefore to be excluded from the calculation, he must also, at the latest by the date of payment, identify these replacement pages and clearly indicate the pages which they are to replace. This information should preferably be given in the relevant section of the form for entry into the European phase (EPO Form 1200). Otherwise any new pages filed at this stage will be taken to be additional pages. Form 1200 is disregarded in the calculation of the additional fee.

Example:

International application, published in English, containing 100 pages:

abstract	1
description	50
claims	20
drawings	20
claims, Art. 19 PCT	9

On entry into European phase, within the 31-month period, 10 pages of amended claims are filed to replace previous pages of claims, as indicated by the applicant in EPO Form 1200.

-> number of pages on which calculation is based: 100 - 20 (original claims) - 9 (Art. 19 PCT) + 10 (EP entry) - 35 (fee-exempt)

-> number of pages to be paid for: 46

Pages of amendments filed after the date of payment of the additional fee, in particular during the Rule 161(1) or (2) period (see A-VII, 7), are not taken into account. Consequently, if amendments are filed at this stage which reduce the number of pages already paid for, no refund will be made.

If the additional fee is not paid on time, the application is deemed to be withdrawn. The EPO will notify the applicant of the loss of rights according to Rule 112(1); the applicant can request further processing according to Art. 121 and Rule 135. The amount of the fee for further processing is computed according to the number of pages on file at expiry of the relevant period for which the additional fee, calculated as set out above, has not been paid. *Art. 2, No. 12 RFees*

14. Translation of the application

There are three situations in which a translation of the European application will be required:

(i) the European application was filed according to Art. 14(2) in a language which is not an official language of the EPO

(ii) the European application was filed by reference to a previously filed application which is not in an official language of the EPO (Rule 40(3))

(iii) the European divisional application was filed in the same language as the earlier (parent) application on which it is based, where this was not an official language of the EPO (Rule 36(2) - see IV, 1.3.3),

In all cases, a translation of the application must be filed at the EPO: in cases (i) and (ii) this must be done within two months of the date of filing according to Rule 6(1) (for type (i)) or Rule 40(3) (for type (ii)); in case (iii) it must be done within two months of the filing of the divisional application according to Rule 36(2).

The EPO will check that this requirement has been complied with. If the applicant has not filed the translation, the EPO will invite him to rectify this deficiency under Rule 58 within a period of two months in accordance with the procedure explained in III, 16. *Art. 90(3)* *Rule 57(a)*

Failure to file the translation on time in response to the invitation under Rule 58 results in the application being deemed to be withdrawn according to Art. 14(2). The EPO will then notify the applicant of this loss of rights according to Rule 112(1). The above time limits for supplying the translation under Rule 40(3), Rule 6(1) and Rule 36(2) are all excluded from further processing by Rule 135(2), as is the time limit for rectification of the failure to file the translation under Rule 58. Consequently, further processing is not possible in this case. However,

the applicant may request re-establishment according to Art. 122 and Rule 136 for failure to comply with the time limit under Rule 58.

15. Late filing of claims

Art. 80
Rule 40(1)

For the purposes of obtaining a date of filing it is not necessary for the European application to contain any claims. The presence of at least one claim is nonetheless a requirement for a European application according to Art. 78(1)(c), but a set of claims can be provided after the date of filing according to the procedure described below.

Art. 90(3) and (5)
Rule 57(c)
Rule 58

The EPO will check whether at least one claim is present in the application. If this is not the case, the EPO will issue an invitation under Rule 58 inviting the applicant to file one or more claims within a period of two months. If the applicant fails to do so within this period, the application is refused according to Art. 90(5). The applicant is notified of this decision according to Rule 111. Further processing for failure to observe the time limit under Rule 58 is excluded by virtue of Rule 135(2). The applicant may, however request re-establishment according to Art. 122 and Rule 136 or may appeal.

Where the application documents as originally filed did not include at least one claim, the applicant may also file claims of his own motion after the date of filing, but before the EPO invites him to do so under Rule 58. In this case, no communication under Rule 58 will then be issued.

If the applicant does supply a set of claims in response to the invitation under Rule 58, the claims so filed must have a basis in the application documents (description and any drawings) provided on the date of filing (Art. 123(2)). This requirement will first be checked at the search stage (see B-XII, 2.2).

If the application was filed by means of a reference to a previously filed application in accordance with Rule 40(3) and the applicant indicated on the date of filing that the claims of the previously filed application were to take the place of claims in the application as filed (see II, 4.1.3.1), then, provided the previously filed application also contained claims on its date of filing, claims were present on the European date of filing and no communication under Rule 58 will be sent.

The above procedure also applies to divisional applications and applications filed in accordance with Art. 61(1)(b).

16. Correction of deficiencies

16.1 Procedure formalities officer

Art. 90(3)

Where, during the examination for compliance with the requirements set out in earlier sections of this Chapter, it is noted that there are deficiencies which may be corrected, the formalities officer must give the applicant the opportunity to rectify each such deficiency within a

specified period. A summary of the most common potential deficiencies at this stage of the procedure and the provisions governing their rectification is given below:

III, 2	Representation	Rule 58
III, 3	Physical Requirements	Rule 58
III, 4	Request for grant	Rule 58
III, 5	Designation of inventor	Rule 60
III, 6	Claim to priority	Rule 52(3), Rule 59
III, 9	Payment of claims fees	Rule 45
III, 10	Abstract	Rule 58
III, 13	Filing fee, including any additional fee, search fee	Rule 112(1), Rule 135
III, 14	Translation of the application	Rule 58
III, 15	Late filing of claims	Rule 58

The formalities officer should in his first report to the applicant raise all the formal objections that become evident from a first examination of the application, except that, as noted in III, 3.2, the Receiving Section should not draw the attention of the applicant to deficiencies under Rule 46(2)(i) and (j) or question the inclusion of tables in the claims. It is likely that certain matters cannot be finally disposed of at this stage, e.g. filing of priority documents for which the period for filing has not expired, and further reports may be necessary. If the applicant is required to appoint a representative but has not done so, the formalities officer should in his first report not only cover this deficiency but any other obvious deficiencies as it should be assumed that the applicant on receipt of the report will appoint a representative within the period allowed.

16.2 Period allowed for remedying deficiencies

The period for remedying the following deficiencies is two months from a communication pointing them out according to Rule 58: *Rule 58*

(i) non-appointment of a representative where the applicant has neither his residence nor principal place of business in a Contracting State - see III, 2 (regarding failure to file an authorisation where this is necessary, see IX, 1.5 and the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, L.1);

(ii) documents making up the application not complying with physical requirements (see III, 3);

(iii) request for grant (with the exception of the priority criteria) not satisfactory (see III, 4);

(iv) abstract not filed (see III, 10);

(v) where required, translation of the application not filed (III, 14)

(vi) no claims (III, 15).

Art. 90(5)
Art. 14(2)

If the above deficiencies under (i)-(iv) or (vi) are not rectified in time, the application is refused under Art. 90(5). If the deficiency under (v) is not rectified in time, the application is deemed to be withdrawn under Art. 14(2). According to Rule 135(2), further processing is excluded for all of the above losses of rights, which all arise from the failure to observe the time limit of Rule 58.

The following deficiencies are rectified under provisions other than Rule 58:

(vii) non-payment of the claims fees (Rule 45 - see III, 9);

(viii) priority document or file number of the previous application is missing (Rule 59 - see III, 6); and

(ix) non-payment of filing fee, including any additional fee, and search fee (III, 13).

Rule 45

According to Rule 45(2), the period for remedying deficiencies with regard to the payment of claims fees under (vii) is one month from a communication pointing out their non-payment. Failure to correct this deficiency in time leads to the claims in question being deemed to be abandoned under Rule 45(3). Further processing applies to this loss of rights.

Art. 90(5)
Rule 59

Deficiencies under (viii) are to be corrected within a period to be specified by the EPO from a communication according to Rule 59 pointing out the failure to supply the certified copy and/or the file number of the priority document. This period under Rule 59 cannot be less than two months or more than four months (Rule 132(2)). Failure to correct this deficiency in time leads to the loss of the priority right. Further processing is excluded for this loss of rights according to Rule 135(2).

Art. 78(2)

Failure to pay the filing, additional or search fee on time results in the deemed withdrawal of the application according to Art. 78(2). This loss of rights ensues directly on expiry of the applicable time limit (see III, 13). A deficiency under (ix) can be corrected by requesting further processing.

Where appropriate, the Search Division is informed of any loss of rights.

Chapter IV

Special provisions

1. European divisional applications (see also C-VI, 9.1)

1.1 General remarks

1.1.1 When may a divisional application be filed?

With regard to when a divisional application may be filed, there are two requirements which must be met:

(i) the application to be divided (the "parent" application on which the divisional is based) must be pending (see IV, 1.1.1.1), and

(ii) at least one of the following two periods must not yet have expired:

(a) the period for voluntary division under Rule 36(1)(a) (see IV, 1.1.1.2)

(b) the period for mandatory division under Rule 36(1)(b), where applicable (see IV, 1.1.1.3)

The term "earlier application" in Rule 36(1) refers to the immediate parent application on which the divisional application is based. This term is distinct from the term "earliest application" also appearing in Rule 36(1), although in the case of a first-generation divisional application (where the immediate parent is not itself a divisional) they both refer to the same application.

1.1.1.1 The earlier application must be pending

Art. 76
Rule 36(1)

A European patent application may be divided only when it is pending. In order to divide a European application, the applicant files one or more European divisional applications. It is irrelevant what kind of application the European patent application which is divided, i.e. the parent application, is. The parent application could thus itself be an earlier divisional application. In the case of the parent application being a Euro-PCT application, a divisional application can only be filed once the Euro-PCT application is pending before the EPO acting as a designated or elected Office, i.e. the Euro-PCT application must have entered the European phase.

As noted above, the parent application must be pending when a divisional application is filed. In the case of an application being filed as a divisional application from an application which is itself a divisional application, it is sufficient that the latter is still pending at the filing date of the second divisional application. An application is pending up to (but **not** including) the date that the European Patent Bulletin mentions the grant of the patent (OJ 2/2002, 112). It is not possible to validly file

a divisional application when the parent application has been refused, withdrawn or is deemed to be withdrawn (see also the next two paragraphs).

If an application is deemed to be withdrawn due to the non-observance of a time limit (e.g. following failure to pay the filing fee (Art. 78(2)), to pay the fee for grant and publishing or the claims fees, or to file the translation of the claims (Rule 71(7)) in due time), the application is no longer pending when the non-observed time limit has expired, unless the loss of rights, as communicated pursuant to Rule 112(1), is remedied. This may be effected either by means of an allowable request for further processing or, where further processing does not apply to the time limit in question, or the time limit for further processing has been missed, re-establishment of rights (which in the latter case is a request for re-establishment in respect of the period for further processing - see E-VIII, 2) or, if the applicant considers that the finding of the EPO was inaccurate, by applying for a decision pursuant to Rule 112(2), whereupon either the competent EPO department shares his opinion and rectifies its decision or that department gives an unfavourable decision which is subsequently overturned on appeal.

Once an application has been refused, a divisional application can no longer be validly filed, unless the applicant files a notice of appeal, in which case the decision to refuse cannot take effect until the appeal proceedings are over. As the provisions relating to the filing of divisional applications also apply in appeal proceedings (Rule 100(1)), a divisional application may be filed while such appeal proceedings are under way (provided that at least one of the periods under Rule 36(1)(a) and Rule 36(1)(b) has not yet expired - see IV, 1.1.1.2 and 1.1.1.3).

1.1.1.2 Voluntary division

Rule 36(1)(a)

A divisional application may be filed on the basis of a pending earlier (parent) application before the expiry of a time limit of twenty-four months from the Examining Division's first communication in respect of the earliest application for which a communication has been issued (see, however, IV, 1.1.1.3). The events from which the period for voluntary division is calculated are:

(i) notification of a first communication according to Art. 94(3) and Rule 71(1), (2), where this is not preceded by a communication according to Rule 71(3), or

(ii) notification of a communication according to Rule 71(3), where this is not preceded by a communication according to Art. 94(3) and Rule 71(1), (2).

Notification of the search opinion (see B-XII, 1.1) does not cause this twenty-four-month period to start because the Examining Division is not yet responsible for the application (see C-VI, 1.1). However, in

cases where the applicant has waived his right to receive the communication according to Rule 70(2) (see C-VI, 1.1.2), no search opinion is issued, but rather a communication according to Art. 94(3) and Rule 71(1), (2) (see B-XII, 8), and notification of this communication *does* cause the twenty-four-month period to start. When calculating the twenty-four-month period for voluntary division, the ten-day rule applies in calculating the date of notification of the above communications (Rule 126(2) - see E-I, 2.3 and E-VIII, 1.4).

The earlier (parent) application on which the divisional is to be based has to be pending at the time the divisional application is filed. If it lapses or is withdrawn before the first communication is sent in respect thereof in examination proceedings, a divisional application may no longer be filed (see IV, 1.1.1.1). The same applies if the earlier (parent) application ceases to be pending after notification of the first communication referred to above but before expiry of the twenty-four-month period.

1.1.1.3 Mandatory division

Rule 36(1)(b)

A divisional application may be filed on the basis of a pending earlier (parent) application before the expiry of a time limit of twenty-four months from any communication in which the Examining Division has objected that the earlier application does not meet the requirements of Art. 82, provided it was raising that specific objection for the first time. Where the period for mandatory division according to Rule 36(1)(b) expires later than the period for voluntary division according to Rule 36(1)(a), a divisional application may be filed within this later period on the basis of a pending earlier (parent) application. The events from which the period for mandatory division is calculated are:

(i) notification of a communication according to Art. 94(3) and Rule 71(1), (2) which is either:

  (a) the first communication in the examination procedure, where this raises a specific objection of lack of unity for the first time or confirms a previous finding of lack of unity already raised during the international, European or supplementary European search, or

  (b) a subsequent communication in the examination procedure, where this raises a specific objection of lack of unity for the first time.

(ii) notification of a summons to oral proceedings, where a specific objection of lack of unity is raised for the first time therein;

(iii) the date of oral proceedings, where a specific objection of lack of unity is raised for the first time during those oral proceedings, provided that the minutes of those oral proceedings reflect this newly raised objection of lack of unity (see E-III, 10.2);

(iv) notification of the minutes of a telephone call or a personal interview, where a specific objection of lack of unity is raised for the first time during that telephone call or personal interview and, in the case of a personal interview, the minutes are notified to the applicant or his representative at a later date, provided that the minutes reflect this newly raised objection of lack of unity (see C-VI, 6.2);

(v) the date of a personal interview, where a specific objection of lack of unity is raised for the first time during that personal interview and the minutes are notified to the applicant or his representative in person on termination of said interview, provided that the minutes reflect this newly raised objection of lack of unity (see C-VI, 6.2);

(vi) notification of a communication according to Rule 71(3), where the text proposed for grant by the Examining Division is an auxiliary request and where the accompanying reasoning indicating why the higher requests were not allowable (see C-VI, 14.1) raises for the first time a specific objection of lack of unity to at least one of those non-allowed higher requests.

In cases (i)(a), (i)(b), (ii), (iv) and (vi), when calculating the twenty-four-month period for mandatory division, the ten-day rule applies to calculation of the date of notification of these communications (Rule 126(2) - see E-I, 2.3 and E-VIII, 1.4).

Note that notification of a search opinion raising an objection of lack of unity of invention does not cause the period for mandatory division to start according to Rule 36(1)(b) (see point (i)(a) above), because the Examining Division is not yet responsible for the application (see C-VI, 1.1). However, in cases where the applicant has waived his right to receive the communication according to Rule 70(2) (see C-VI, 1.1.2), no search opinion is issued, but rather a communication according to Art. 94(3) and Rule 71(1), (2) (see B-XII, 8), and notification of this communication, where it raises an objection of lack of unity, *does* cause the twenty-four-month period for mandatory division to start.

For first-generation divisional applications (where the earlier application on which the divisional is based is not itself a divisional), it is not possible for the period for mandatory division to expire earlier than the period for voluntary division. In most cases the two periods will expire at the same time, because the unity objection is typically raised in a first communication from the Examining Division or, if already raised at the search stage, is maintained therein. A confirmation in a later communication in examination of a lack of unity objection previously raised in examination proceedings does not cause the period for mandatory division to start again. In particular, where the Examining Division raises an objection of lack of unity in the first communication and in response the applicant deletes some of the

additional inventions, but more than one invention remains in the claims and the Examining Division then issues a second communication (or a summons to oral proceedings) which maintains the previous objection of lack of unity in part (adapted to the deletion of some of the claimed inventions), this does not cause the period for mandatory division to start again, since the objection is not a new one.

However, where a *different* objection of lack of unity is subsequently raised, this *does* cause the twenty-four-month period for mandatory division to start again. This applies in cases where, for example, an invention identified in a previous non-unity objection is further sub-divided in a subsequent objection raised in the examination procedure.

Furthermore, an objection according to Rule 137(5) does not qualify as an objection according to Art. 82, in particular for the purposes of calculating the period for mandatory division (see C-VI, 5.2). However, the period for mandatory division does start if a communication raising an objection under Rule 137(5) also contains a further objection according to Art. 82.

1.1.1.4 Second- and subsequent-generation divisional applications

Voluntary division (Rule 36(1)(a))

For the filing of second-generation divisional applications (i.e. divisional applications based on an earlier application which is itself also a divisional), the event which starts the period for voluntary division is the first communication in respect of the *earliest* application for which a communication has been issued. This is determined as illustrated by the following example:

Example 1

- EP1 is the original European application,
- EP2 is a divisional application based on EP1 and
- EP3 is a divisional application based on EP2.

Where a first communication (see IV, 1.1.1.2) has already been issued for EP1 when EP3 is filed (this is the usual situation), the period for voluntary division of EP2 (by the filing of EP3) is calculated from the date of notification of this first communication in respect of EP1. However, all that is required is that EP2 is still pending when EP3 is filed; EP1 does not need to be pending. This is because EP1 is the *earliest* application in respect of which a first communication has been issued (used to calculate the period for voluntary division), but it is not the *earlier* application which has been divided (this is EP2), and it is the *earlier* application (EP2) which must be pending according to Rule 36(1).

If no first communication has been issued for either EP1 or EP2 when EP3 is filed, the divisional is filed in time according to Rule 36(1), provided that EP2 is still pending.

Voluntary division in branched families of divisional applications

In cases where there are two divisional applications each derived from the same earlier (parent) application, the periods for voluntary division of the two divisional applications are calculated independently:

Example 2

- EP1 is the original European application,
- EP2a is a divisional application based on EP1 and
- EP2b is a divisional application based on EP1.

In example 2, the period for voluntary division of EP2a is calculated with reference to the appropriate communication issued in respect of EP1 or EP2a (as indicated under example 1 above) but not EP2b. Likewise, the period for voluntary division of EP2b is calculated with reference to the appropriate communication issued in respect of EP1 or EP2b but not EP2a. These cases are treated in the same way as example 1 above, but ignoring any divisional applications which are not in a direct line from the divisional being filed to the earliest application.

Mandatory division (Rule 36(1)(b))

In example 1, the period for mandatory division of EP2 (by filing EP3) is calculated from the first communication in examination raising a specific objection of lack of unity for the first time (see IV, 1.1.1.3).

1.1.1.5 Legal remedies for late filing of a divisional application

Failure to file within the applicable twenty-four-month period

Art. 121
Art. 122

The periods specified in Rule 36(1)(a) and Rule 36(1)(b) are excluded from further processing (Rule 135(2)). If a divisional application is not filed within the later-expiring of the periods specified in Rule 36(1)(a) and Rule 36(1)(b) (see IV, 1.1.1.2 and 1.1.1.3), the applicant may request re-establishment of rights in respect of this failure (see E-VIII, 2.2). The applicant must (i) request re-establishment (Rule 136(1)) and (ii) complete the omitted act (i.e. file the divisional application - Rule 136(2)) within a period of two months from the removal of the cause of non-compliance with the above-mentioned period (but at the latest within one year of expiry of the unobserved period).

Re-establishment of rights pursuant to Art. 122 is excluded in respect of the requirement for a divisional application to be filed while the

earlier application is pending (J 10/01, not published in OJ). This is because, unlike the twenty-four-month periods for voluntary and mandatory division under Rule 36(1)(a) and (b), this requirement of Rule 36(1) does not constitute a time limit for the filing of a divisional application, but rather a point in time by which a divisional must be filed. Consequently, further processing is also not available.

1.1.2 Persons entitled to file a divisional application

Only the applicant on record may file a divisional application. This means that, in the case of a transfer of an application, a divisional application may only be filed by or on behalf of the new applicant if the transfer was duly registered and therefore effective (Rule 22) at the filing date of the divisional application.

1.2 Date of filing of a divisional application; claiming priority

1.2.1 Date of filing

A European divisional application may be filed in respect of subject-matter which does not extend beyond the content of the parent application as filed. Provided this requirement is met, the divisional application is deemed to have been filed on the date of filing of the parent application and enjoys that application's priority (see IV, 1.2.2).

Art. 76(1), 2nd sentence

A divisional application filed in due form, i.e. meeting the requirements of Art. 80 and Rule 40(1) (see II, 4.1 et seq.), is accorded the same date of filing as the parent application. The question of whether it is confined to subject-matter contained in the parent application is not decided until the examination procedure (see C-VI, 9.1.4 et seq.).

Art. 80
Rule 40(1)

Since Rule 40(1) does not require that a European application contain any claims on its date of filing, the same applies to a European divisional application. The applicant can file the claims after the filing of the divisional application according to the procedures detailed in III, 15. This may be done after the parent application is no longer pending and after expiry of the periods for voluntary and mandatory division, provided that the requirements of Rule 40(1) were satisfied with regard to the divisional (i) while the parent application was still pending and (ii) before expiry of the relevant period (see IV, 1.1.1, 1.1.1.1, 1.1.1.2 and 1.1.1.3).

1.2.2 Claiming priority

A priority claimed in the parent application may apply also to the divisional application. Provided that the parent application's priority claim has not lapsed, the divisional application retains that priority; it is not necessary to claim it formally a second time. A parent application’s priority claim will, however, not be retained, if that priority claim is withdrawn in the divisional application. For the withdrawal of a priority claim see C-V, 3.5 and E-VIII, 6.2 and 6.3. If a copy and any translation of the priority application have been filed in respect of the parent application before the divisional application is filed, it is not necessary to file the priority documents again in respect of the divisional

Rule 53(2) and (3)

application. The EPO makes a copy of these documents and places them in the file of the divisional application (see Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, B.2).

If, when the divisional application is filed, the priority document has not been filed in respect of the parent application, it must be filed in respect of the divisional application and, if the priority of the parent application's remaining subject-matter is to be retained, in respect of the parent application also. The applicant can also inform the EPO, within the time limit set for filing priority documents in the divisional application proceedings, that he has in the meantime submitted these documents in respect of the parent application. If the subject-matter of the divisional application relates only to some of the priorities claimed in the parent application, priority documents in respect of the divisional application need be filed for those priorities only.

Rule 52(2) This applies also as regards indicating the file number of the priority application. For the time limits for indicating the file number and for filing the priority documents, see III, 6.5, III, 6.5.3 and 6.7 et seq.

1.3 Filing a divisional application

1.3.1 Where and how to file a divisional application?

Rule 36(2) A divisional application must be filed by delivery by hand or by post
Rule 35(1) with the EPO in Munich, The Hague or Berlin. It may also be filed using the *epoline*® Online Filing software (Art. 5 of the Decision of the President dated 26 February 2009, OJ EPO 3/2009, 182). The filing of a European divisional application with a national authority has no effect in law; the authority may however, as a service, forward the European divisional application to the EPO. If a competent national authority chooses to forward the application, it is not deemed received until the documents are filed at the EPO.

The divisional application may be filed by reference to the earlier application from which it derives (the parent application). The procedures are as provided for in Rule 40(1)(c), (2) and (3) (see II, 4.1.3.1). It will not be necessary for the applicant to file a copy or translation of the previous (parent) application according to Rule 40(3), since these will already be available to the EPO in the file of the previous (parent) application.

1.3.2 Request for grant

Rule 41(2)(e) The request for grant of a patent must contain a statement that a divisional application is sought and state the number of the parent application. If the request is deficient, as can arise if there is no indication that the application constitutes a divisional application, although some of the accompanying documents contain an indication to that effect, or if the number is missing, the deficiency may be corrected in the manner indicated in III, 16. The applicant is also advised to include in the request for grant information relating to

communications issued in respect of the earlier and earliest application on which the divisional application is based. This information makes it easier to calculate the periods for voluntary and mandatory division (see IV, 1.1.1.2 and 1.1.1.3 respectively).

1.3.3 Language requirements

As indicated in VIII, 1.3, a divisional application must be filed in the language of the proceedings of the parent application. Alternatively, if the earlier (parent) application was filed in a language other than an official language of the European Patent Office, the divisional application may be filed in that language. In this case a translation into the language of the proceedings for the earlier application shall then be filed within two months of the filing of the divisional application (see III, 14). *Rule 36(2)*

1.3.4 Designation of Contracting States

All Contracting States designated in the earlier application at the time of filing a European divisional application, are deemed to be designated in the divisional application (see also G 4/98, OJ 3/2001, 131). If no designations have been withdrawn in respect of the parent application, then all Contracting States adhering to the EPC at the date of filing of the parent are automatically designated in the divisional application when it is filed. Conversely, Contracting States, the designations of which have been withdrawn in respect of the parent application at the time of filing the divisional application, cannot be designated in respect of the divisional application. *Art. 76(2)* *Rule 36(4)*

If the parent application was filed before 1 April 2009, and the time limit for payment of the designation fees has not yet expired for the parent application when the divisional application is filed, and no designations have been withdrawn in respect of the parent application, then all Contracting States adhering to the EPC at the date of filing of the parent are automatically designated in the divisional application when it is filed. Conversely, Contracting States, the designations of which have been withdrawn or deemed to be withdrawn in respect of the parent application at the time of filing the divisional application, cannot be designated in respect of the divisional application.

The flat designation fee payable for divisional applications filed on or after 1 April 2009 does not cover Contracting States the designations of which have been withdrawn or deemed to be withdrawn at the time of filing the divisional application.

1.3.5 Extension States

For the extension to specific states not party to the EPC of European patents arising from divisional applications, see III, 12.1.

1.4 Fees

1.4.1 Filing, search and designation fee(s)

Rule 36(3) and (4)
Art. 79(2)

The filing fee and search fee for the divisional application must be paid within one month after it is filed (basic time limit). For the additional fee due for any pages in excess of thirty-five, see A-III, 13.2. The designation fee(s) must be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the divisional application.

The search fee must be paid even if a further search fee has already been paid under Rule 64(1) in respect of the search report on the parent application for the part of the application which was lacking in unity and which is now the subject of the divisional application (for reimbursement of the search fee see IV, 1.8).

Rule 36(3) and (4)

If, within the applicable time limit the filing, search or designation fees have not been paid, the application is deemed to be withdrawn. The EPO informs the applicant of these losses of rights by issuing a communication under Rule 112(1). The applicant can request further processing according to Art. 121 and Rule 135.

For divisional applications filed before 1 April 2009, see for the deemed withdrawal of single designations or of the application and applicable remedies A-III, 11.3.2 and A-III, 11.3.4

1.4.2 Claims fees

Rule 45(1)

If, at the time of filing the first set of claims, the divisional application comprises more than fifteen claims, a claims fee is payable in respect of each claim over and above that number (see A-III, 9). Claims fees are payable even if in the parent application they were paid in respect of claims relating to the subject-matter now the subject of the divisional application (see III, 9).

1.4.3 Renewal fees

Art. 86(1)
Art. 76(1)
Rule 51(3)
Art. 2, No. 5, RFees

For the divisional application, as for any other European patent application, renewal fees are payable to the EPO. They are due in respect of the third year and each subsequent year, calculated from the date of filing of the parent application. Pursuant to Art. 76(1), the date of filing the parent application is also the date from which the time limits for payment of the renewal fees for the divisional application (Art. 86(1)) are calculated. If, when the divisional application is filed, renewal fees for the parent application have already fallen due, these renewal fees must also be paid for the divisional application and fall due when the latter is filed. The period for payment of these fees is four months after the filing of the divisional application. If not paid in due time, they may still be validly paid within six months of the date on which the divisional application was filed, provided that at the same time the additional fee of 50% of the renewal fees paid late is paid. The same applies if on the date of filing of the divisional application a further

renewal fee in addition to those to be made good falls due, or a renewal fee falls due for the first time.

If, within the four-month period referred to above, a further renewal fee falls due or a renewal fee falls due for the first time, it may be paid without an additional fee within that period. It may otherwise still be validly paid within six months of the due date, provided that at the same time the additional fee of 50% of the renewal fee paid late is paid. When calculating the additional period the principles developed by the Legal Board of Appeal should be applied (see J 4/91, OJ 8/1992, 402).

Rule 51(3)
Art. 2, No. 5, RFees

Further processing for failure to pay renewal fees on time is excluded by virtue of Rule 135(2). However, re-establishment is possible. In the case of applications for re-establishment of rights in respect of renewal fees falling due on filing of the divisional or within the four-month period laid down in Rule 51(3), second sentence, the one-year period prescribed by Rule 136(1) starts to run only after the six months under Rule 51(2) have expired.

Example:

25.03.2008:	date of filing of parent application;
11.01.2011:	filing of divisional application and due date of renewal fee for the third year;
31.03.2011:	due date of renewal fee for the fourth year; expiry of four-month period under
11.05.2011:	Rule 51(3);
11.07.2011:	expiry of six-month period under Rule 51(2) in respect of the renewal fee for the third year;
30.09.2011:	expiry of six-month period under Rule 51(2) in respect of the renewal fee for the fourth year;
11.07.2012:	expiry of one-year period under Rule 136(1) in respect of the renewal fee for the third year;
01.10.2012:	expiry of one-year period under Rule 136(1) in respect of the renewal fee for the fourth year (extended under Rule 134(1)).

1.5 Designation of the inventor

The provisions of III, 5.5 apply with regard to the designation of the inventor, except that, where the designation of the inventor has not been provided or is deficient (i.e. it does not comply with Rule 19), the applicant will be invited to provide or correct it within a period to be specified by the EPO, which must be a minimum of two months (Rule 132(2)). The divisional application requires a separate designation, independent of the parent application on which it is based.

Rule 60(2)

1.6 Authorisations

The provisions of IX, 1.5 and 1.6 apply with regard to authorisations in respect of the divisional application. If, according to these provisions,

the representative has to file an authorisation, he may act on the basis of an individual authorisation filed in respect of the parent application only if it expressly empowers him to file divisional applications.

1.7 Other formalities examination

Other than for matters referred to in IV, 1.1 to 1.6, the formal examination of divisional applications is carried out as for other applications. The provisions of Rule 30 apply with regard to divisional applications relating to nucleotide or amino acid sequences filed after 1 January 1993 (see IV, 5).

1.8 Further procedure

Divisional applications are searched, published and examined in the same way as other European patent applications. The search fee is refunded if the conditions of Art. 9(2) of the Rules relating to Fees are met (see the Notice from the President of the EPO dated 13 December 2001, OJ 1/2002, 56, for divisional applications filed before 1 July 2005, the Decision of the President of the EPO dated 14 July 2007, Special edition No. 3, OJ EPO 2007, M.2 for divisional applications filed on or after 1 July 2005 for which the search is completed before 1 April 2009, and the Decision of the President of the EPO dated 22 December 2008, OJ 2/2009, 96 for divisional applications for which the search is completed on or after 1 April 2009). Here, the term "filed" refers to the date on which the divisional application is received at the EPO, not the filing date, which is the same as the filing date for the parent application (Art. 76(1)). The time limit for filing the request for examination begins to run with the date of mention of the publication of the search report concerning the divisional application.

2. Art. 61 applications

2.1 General

Art. 61(1)
Rule 16

It may be adjudged by decision of a court or competent authority (hereinafter "court") that a person referred to in Art. 61(1), other than the applicant, is entitled to the grant of a European patent. This third party may, within three months after the decision has become final, provided that the European patent has not yet been granted, in respect of those Contracting States designated in the European patent application in which the decision has been taken or recognised or has to be recognised on the basis of the Protocol on Recognition annexed to the European Patent Convention:

Art. 61(1)(a)

(i) prosecute the application as his own application in place of the applicant (see IV, 2.6 and 2.9);

Art. 61(1)(b)

(ii) file a new European patent application in respect of the same invention (see IV, 2.7 and 2.9); or

Art. 61(1)(c)

(iii) request that the application be refused (see IV, 2.8 and 2.9).

In a case where the application is no longer pending due to its having been withdrawn, refused or being deemed to be withdrawn, the third party can still file a new European patent application in respect of the same invention, in accordance with Art. 61(1)(b) (see G 3/92, OJ 9/1994, 607).

2.2 Staying the proceedings for grant

Rule 14(1)

If a third party provides proof to the EPO that he has opened proceedings against the applicant for the purpose of seeking a judgement that he is entitled to the grant of the European patent – which proof may take the form of confirmation by the court – the EPO will stay the proceedings for grant unless the third party consents to the continuation of such proceedings. Such consent must be communicated in writing to the EPO; it is irrevocable. However, proceedings for grant may not be stayed before the publication of the European patent application. Staying must be ordered by decision. This is an interim decision, which under Art. 106(2) may only be appealed together with the final decision. These matters are dealt with by the Legal Division (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, G.1).

Under Art. 164(1), the Protocol on Recognition is an integral part of the European Patent Convention. It governs the jurisdiction and recognition of decisions for EPC Contracting States.

2.3 Resumption of the proceedings for grant

Rule 14(3)

When giving the decision on the staying of proceedings or thereafter the EPO may set a date on which it intends to continue the proceedings pending before it regardless of the stage reached in the proceedings against the applicant. The date is to be communicated to the third party, the applicant, and any other party. If no proof has been provided by that date that a decision which has become final has been given, the EPO may continue proceedings.

If a date is set for the resumption of the proceedings for grant, it should be chosen with due consideration for the interests of the third party who only becomes a party to the proceedings after a judgement has been given in his favour, on the basis of the probable duration of the court proceedings so as to enable them to be concluded within that period of time. If, by the date set, the court has not given a judgement, the proceedings for grant must at all events be further stayed if the judgement is expected in the near future. However, the proceedings for grant should be resumed if it is evident that delaying tactics are being employed by the third party or if the proceedings in the court of first instance have concluded with a judgement in favour of the applicant and the legal procedure is extended by the filing of an appeal.

Rule 14(2)

Where proof is provided to the EPO that a decision which has become final has been given in the proceedings concerning entitlement to the grant of a European patent, the EPO must communicate to the applicant and any other parties that the proceedings for grant will be

resumed as from the date stated in the communication unless a new European patent application pursuant to Art. 61(1)(b) has been filed for all designated Contracting States. If the decision is in favour of the third party, the proceedings may only be resumed after a period of three months of that decision becoming final unless the third party requests the resumption of the proceedings for grant.

2.4 Interruption of time limits

Rule 14(4)

The time limits in force at the date of staying other than time limits for payment of renewal fees are interrupted by such staying. The time which has not yet elapsed begins to run as from the date on which proceedings are resumed. However, the time still to run after the resumption of the proceedings may not be less than two months.

Example: The six-month time limit under Art. 94(1) and Rule 70(1) begins on 1 July 2008. Proceedings are stayed on 23 September 2008 and resumed on 4 August 2009. The last day of the period already elapsed is 22 September 2008. The time which has not elapsed is therefore 8 days and 3 months, begins on 4 August 2009 and ends on 11 November 2009.

2.5 Limitation of the option to withdraw the European patent application

Rule 15

As from the time when a third party proves to the EPO that he has initiated proceedings concerning entitlement (see IV, 2.2) and up to the date on which the EPO resumes the proceedings for grant (see IV, 2.3), neither the European patent application nor the designation of any Contracting State may be withdrawn.

2.6 Prosecution of the application by a third party

Art. 61(1)(a)

If a third party wishes to avail himself of the possibility open to him under Art. 61(1)(a) (see IV, 2.1(i)), he must declare his intention in writing to the EPO in due time. He then takes the place of the erstwhile applicant. The proceedings for grant are continued from the point reached when the third party filed his declaration, or when they were stayed (see IV, 2.2).

2.7 Filing a new application

Art. 61(1)(b)
Art. 76(1)

A new European patent application under Art. 61(1)(b) must be filed in paper or electronic form at The Hague, Munich or Berlin offices of the EPO. It is not possible to file an application according to Art. 61(1)(b) with the competent authorities of a Contracting State.

The new application is in many other respects treated as a European divisional application and corresponding provisions apply. In particular, the following provisions relating to divisional applications apply mutatis mutandis:

Art. 61(2)

(i) accordance of the date of filing of the earlier application and entitlement to priority date – see IV, 1.2;

(ii) information in the request for grant – see IV, 1.3.2;

(iii) filing, search, designation and claims fees – see IV, 1.4.1 and 1.4.2; *Rule 17(2) and (3)* *Rule 45(1)*

(iv) designation of inventor – see IV, 1.5.

(v) language requirements - see IV, 1.3.3.

However, arrangements for renewal fees are different. For the year in which the new application is filed and for the years beforehand, no renewal fees are payable. *Rule 51(6)*

In other respects the formal examination is carried out as for other applications.

If it is adjudged that a third party is entitled to the grant of a European patent for only some of the Contracting States designated in the earlier application, and the third party files a new application for these States, for the remaining States the earlier application continues to be in the name of the earlier applicant.

The earlier application is deemed to be withdrawn on the date of filing of the new application for the Contracting States designated therein in which the decision has been taken or recognised. *Rule 17(1)*

2.8 Refusal of the earlier application

If the third party requests under Art. 61(1)(c) that the earlier application be refused, the EPO must accede to this request. The decision is open to appeal (Art. 106(1)). *Art. 61(1)(c)*

2.9 Partial transfer of right by virtue of a final decision

If by a final decision it is adjudged that a third party is entitled to the grant of a European patent in respect of only part of the matter disclosed in the European patent application, Art. 61 and Rules 16 and 17 apply to such part. *Rule 18(1)*

3. Display at an exhibition

3.1 Certificate of exhibition; identification of invention

Where an applicant states when filing his application that the invention which is the subject of the application has been displayed at an official or officially recognised international exhibition falling within the terms of the Convention on international exhibitions, he must file a certificate of exhibition within four months of the filing of the European patent application. The exhibitions recognised are published in the Official Journal. The certificate, must: *Art. 55(1)(b) and (2)* *Rule 25*

(a) have been issued during the exhibition by the authority responsible for the protection of industrial property at that exhibition;

(b) state that the invention was exhibited at the exhibition;

(c) state the opening date of the exhibition and the date of the first disclosure, if different from the opening date of the exhibition;

(d) be accompanied by an identification of the invention, duly authenticated by the above-mentioned authority.

3.2 Defects in the certificate or the identification

The Receiving Section acknowledges receipt of the certificate and identification of the invention. The Receiving Section draws the applicant's attention to any manifest defects in the certificate or the identification in case it is possible to rectify the deficiencies within the four-month period allowed. The applicant is notified according to Rule 112(1) if the certificate or identification is not furnished within the time allowed. The applicant may request further processing in respect of this loss of rights according to Art. 121 and Rule 135.

4. Applications relating to biological material

4.1 Biological material; deposit thereof

Rule 26(3)

In accordance with Rule 26(3), "biological material" means any material containing genetic information capable of reproducing itself or being reproduced in a biological system.

Rule 31(1)(c) and (d)
Rule 31(2)

Where in relation to an application concerning biological material an applicant states that he has deposited in accordance with Rule 31(1)(a) the biological material with a depositary institution recognised for the purposes of Rules 31 and 34, he must, if such information is not contained in the application as filed, submit the name of the depositary institution and the accession number of the culture deposit and, where the biological material has been deposited by a person other than the applicant, the name and address of the depositor, within whichever of the following periods is the first to expire:

Rule 31(2)(a)

(i) within a period of sixteen months of the date of filing of the European patent application or the date of priority, this time limit being deemed to have been met if the information is submitted before completion of the technical preparations for publication of the European patent application;

Rule 31(2)(b)

(ii) if a request for early publication of the application according to Art. 93(1)(b) is submitted, up to the date of such submission; or

Rule 31(2)(c)

(iii) if it is communicated that a right to inspection of the files pursuant to Art. 128(2) exists, within one month of such communication.

The above time limit according to Rule 31(2) is excluded from further processing by Rule 135(2).

Moreover, when the depositor and applicant are not identical, the same time limit applies for submitting a document satisfying the EPO that the depositor has authorised the applicant to refer to the deposited biological material in the application and has given his unreserved and irrevocable consent to the deposited material being made available to the public in accordance with Rule 33(1) and (2) or Rule 32(1). *Rule 31(1)(d)*

The depositary institution must be one appearing on the list of depositary institutions recognised for the purposes of Rules 31 to 34, as published in the Official Journal of the EPO. This list includes the depositary institutions, especially the International Depositary Authorities under the Budapest Treaty. An up-to-date list is regularly published in the Official Journal. *Rule 33(6)*

4.1.1 New deposit of biological material

If biological material deposited according to Rule 31 ceases to be available from the recognised depositary institution, an interruption in availability shall be deemed not to have occurred if: *Rule 34*

(i) a new deposit of that material is made in accordance with the Budapest Treaty

(ii) a copy of the receipt of that new deposit issued by the depositary institution is forwarded to the EPO within four months of the date of the new deposit, stating the number of the European patent application or patent.

The non-availability may occur because, for example:

(a) the material has degraded such that it is no longer viable, or

(b) the authority with which the original deposit was made no longer qualifies for that kind of material, either under the Budapest Treaty or under bilateral agreements with the EPO.

In either case (a) or (b) above, a new deposit must be made within three months of the depositor's being notified of the non-availability of the organism by the depositary institution (Art. 4(1)(d) Budapest Treaty). This is subject to the exception, where:

the non-availability of the deposit is for the above reason (b), and

the depositor does not receive the above notification from the depository institution within six months after the date on which it is published by the International Bureau that the depositary institution is no longer qualified in respect of the biological material in question.

In this exceptional case, the new deposit must be made within three months from the date of the said publication by the International Bureau (Art. 4(1)(e) Budapest Treaty).

If, however, the original deposit was not made under the Budapest Treaty, but rather at a depositary institution recognised by the EPO by virtue of a bilateral agreement, the above-mentioned six-month period is calculated from the date when the EPO publishes the fact that the depositary institution in question is no longer qualified to accept deposits of the biological material in question under that bilateral agreement.

4.1.2 The application was filed by reference to a previous application

Where the application was filed by reference to a previously filed application in accordance with the procedures described in II, 4.1.3.1, and the previously filed application referred to already satisfied the requirements of Rule 31(1)(b) and (c) on its date of filing, these requirements will also be satisfied in respect of the European application.

If the information on the deposited biological material present in the previously filed application as filed does not satisfy Rule 31(1)(c), the EPO will not know this until the applicant files the certified copy and any required translation of the previously filed application (at the latest within two months of the date of filing - Rule 40(3)). Even where the certified copy and any translation required are filed up to two months from the date of filing, if the requirements of Rule 31(1)(c) are not satisfied, the time limit for rectification of this deficiency according to Rule 31(2) is unaffected (see IV, 4.2).

4.2 Missing information; notification

Art. 97(2)
Rule 31
Art. 83

When the Receiving Section notices that the information required under Rule 31(1)(c) (indication of the depositary institution and the accession number of the culture deposit) or the information and the document referred to in Rule 31(1)(d) (authorisation to refer to the deposit and the consent to it being made available) is not contained in or has not yet been submitted with the application, it should notify the applicant of this fact as this information can only be validly submitted within the time limits specified in Rule 31(2). In the case of missing information pursuant to Rule 31(1)(c), the deposit must be identified in the patent application as filed in such a way that the later submitted accession number can be traced back without ambiguity. This can normally be done by indicating the identification reference given by the depositor within the meaning of Rule 6.1(a)(iv) of the Budapest Treaty (see G 2/93, OJ 5/1995, 275). The applicant is also informed when a deposit with a recognised depositary institution is referred to but no receipt from the depositary institution has been filed. Any further action is a matter for the Examining Division. See also C-II, 6, in particular 6.3(ii), as regards the Examining Division's treatment of applications relating to biological material. The time limit according to Rule 31(2) for

supplying the information required by Rule 31(1)(c) and (d) is excluded from further processing by Rule 135(2).

4.3 Availability of deposited biological material to expert only

Under Rule 32(1)(a) and (b), until the date on which the technical preparations for publication of the application are deemed to have been completed, the applicant may inform the EPO that, until the publication of the mention of the grant of the European patent or, where applicable, for twenty years from the date of filing if the application has been refused or withdrawn or is deemed to be withdrawn, the availability referred to in Rule 33 is to be effected only by the issue of a sample to an expert. *Rule 32(1)*

The above communication must take the form of a written declaration addressed to the EPO. This declaration may not be contained in the description and the claims of the European patent application, but may be given in the appropriate section of the Request for Grant form (Form 1001).

If the declaration is admissible, it is mentioned on the front page when the European patent application is published (see also VI, 1.3).

If the applicant duly informs the EPO under Rule 32(1), the biological material is issued only to an expert recognised by the President of the EPO or approved by the applicant. *Rule 32(2)*

The list of recognised microbiological experts, giving their particulars and their fields of activity, is published in the Official Journal (see OJ 8/1992, 470). *Rule 33(6)*

5. Applications relating to nucleotide and amino acid sequences

If nucleotide and amino acid sequences within the meaning of Rule 30(1) are disclosed in the European patent application, they are to be represented in a sequence listing which conforms to WIPO Standard ST. 25. The sequence listing should, where it is filed together with the application, be placed at the end of the application (see WIPO Standard ST. 25, point 3). The sequence listing may be filed on paper. In that case, a copy of the sequence listing must also be submitted in computer-readable form. Where the European patent application is filed online, the computer-readable form is to be attached. Data in computer-readable form must comply with WIPO Standard ST. 25, paragraph 39ff. Where the application is filed on paper, the information recorded on the electronic data carrier must be identical to the sequence listing on paper which constitutes the legally determinative version. The applicant or his representative must submit a statement to that effect accompanying the data carrier in accordance with Rule 30(1) and WIPO Standard ST. 25. See the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, C.1 and the accompanying Notice from the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, C.2. Where a *Rule 57(j)* *Rule 30(1) and (2)*

sequence listing is filed or corrected after the filing date, the applicant is required to submit a statement that the sequence listing so filed or corrected does not include matter which goes beyond the content of the application as filed.

Art. 90(3)
Rule 30(3)

The Receiving Section will inform the applicant of any deficiencies as to the sequence listing or as to the necessary statements and invite him to remedy the deficiencies and pay a late furnishing fee within a non-extendable period of two months. If the requirements of Rule 30 in conjunction with the Decision of the President of the EPO dated 2 October 1998 are not complied with in due time, where appropriate following the invitation to do so from the Receiving Section, which includes the payment of the late furnishing fee, the application will be refused according to Rule 30(3).

Art. 121
Rule 135

The applicant may request further processing of the application.

5.1 Sequence listings filed under Rule 56

If the application as originally filed does not disclose any sequences, such that the EPO cannot be aware of any deficiency, then no communication according to Rule 30(3) or Rule 56(1) will be sent to the applicant. In such cases, the applicant may, under Rule 56(2), file the missing parts of the description relating to sequences of his own motion within two months of the date of filing (see II, 5.2). According to Rule 57(j), any sequence information thus filed will be checked for compliance with Rule 30(1) in conjunction with the rules laid down by the President of the EPO, including the requirement to furnish the listing on a prescribed data carrier and to furnish the statement of identity of the listing on the data carrier with the written listing.

If the sequence information thus filed does not conform to the requirements of Rule 30(1) in conjunction with the rules laid down by the President of the EPO, then a communication under Rule 30(3) is sent to the applicant requesting correction (see IV, 5).

If, on the other hand, the sequence information thus filed already conforms to the requirements of Rule 30(1), no Rule 30(3) communication will be sent.

The above applies regardless of whether or not the late-filed parts of the description result in a change of the date of filing (see II, 5.3) or if the late-filed missing parts can be based on the claimed priority, allowing the original date of filing to be maintained (see II, 5.4). If, however, the late-filed parts of the description result in a change of the filing date, any communication according to Rule 30(3) which might be required will only be sent after the one-month period for the withdrawal of the late-filed parts has expired without the applicant having withdrawn them (see II, 5.5).

Where the application as filed contains a sequence listing which does not contain all the sequences disclosed in the application documents,

the sequence listing, due to this incompleteness, cannot be considered as complying with WIPO Standard ST. 25. Hence, the applicant will be invited under Rule 30 to file a standard compliant sequence listing and to pay the late furnishing fee.

In the case where the applicant inserts a sequence listing which conforms to the requirements of Rule 30(1) into the description as a late-filed part of the description according to Rule 56, the sequence listing so added is considered part of the description on the date of filing (regardless of whether or not this has changed). That is to say, in this case Rule 30(2) does not apply.

5.2 Sequence listings of an application filed by reference to a previously filed application

Where the application is filed by reference to a previously filed application (see II, 4.1.3.1), and that previously filed application contained sequence listings on its date of filing, then those sequence listings form part of the application as originally filed. This is subject to the exception that, where the sequences only appear in the claims and not in the description or drawings of the previously filed application, and the applicant did not include the claims of the previously filed application in the reference, then those sequences are not included in the European application as originally filed, even if the applicant subsequently filed a sequence listing complying with WIPO Standard ST. 25 later on in the prosecution of that previously filed application (later filed sequence listings are not part of the description according to Rule 30(2)).

Where the previously filed application is not available to the EPO, it will not be possible to carry out the check according to Rule 57(j) on the compliance of the listing with Rule 30(1) until the applicant files the certified copy and any translation required, which must be done within two months of the date of filing (Rule 40(3)). After the certified copy and translation, where applicable, are received, if it transpires that the listing contained therein does not comply with Rule 30(1) in conjunction with the rules laid down by the President of the EPO, the European Patent Office will send a communication according to Rule 30(3) inviting the applicant to correct any deficiencies (including the lack of a statement of identity of the listing on the data carrier with the written listing and/or the lack of the listing on the prescribed data carrier) and pay the late furnishing fee (see IV, 5).

If the previous application referred to is a European application or an International application filed with the EPO as receiving Office, and this application satisfied the requirements of Rule 30 or Rule 5(2) PCT in combination with WIPO Standard ST. 25 *on its date of filing* then all the requirements of Rule 30(1) are satisfied automatically on the date of filing of the European application filed by reference to this application.

In all other cases, however, the applicant will have to ensure that all the requirements of Rule 30(1), in conjunction with the rules laid down by

the President of the EPO, are met. This means that if the previously filed application referred to is not one of the above types of application, even where it contains a written sequence listing conforming to WIPO Standard ST. 25, the applicant will still have to provide a computer-readable form of the sequence listings complying with WIPO Standard ST. 25 and a statement that the information recorded on the data carrier is identical to the written sequence listing, in order to satisfy the requirements of Rule 30(1) in conjunction with the rules laid down by the President of the EPO. This includes the case where the previously filed application was a European application or International application filed with the EPO as receiving Office, but where one or more of the elements required to satisfy the requirements of Rule 30(1) or Rule 5(2) PCT in conjunction with WIPO Standard ST. 25 were not present on the date of filing. If this is not the case, the procedure in IV, 5 will be followed (a communication under Rule 30(3) will be sent).

6. Conversion into a national application

Art. 135

The central industrial property office of a Contracting State must apply the procedure for the grant of a national patent or another protective right provided for by the legislation of this State at the request of the applicant for or the proprietor of the European patent under the circumstances specified in Art. 135(1). If the request for conversion is not filed within the three-month period specified in Rule 155(1), the effect referred to in Art. 66 will lapse (i.e. the European application will cease to be equivalent to a regular national filing in the designated Contracting States).

Art. 135(2)
Rule 155(2) and (3)

The request for conversion is to be made to the EPO, except where the application is deemed withdrawn pursuant to Art. 77(3); in this case the request is filed with the central industrial property office with which the application was filed. That office shall, subject to the provisions of national security, transmit the request directly to the central industrial property offices of the Contracting States specified therein, together with a copy of the file relating to the European patent application. If the central industrial property office with which the application was filed does not transmit the request before the expiry of twenty months from the filing date, or if claimed, from the priority date, then Art. 135(4) applies (i.e. the effect of Art. 66 lapses).

Art. 135(3)
Rule 155(2)

If a request for conversion is filed with the EPO, it must specify the Contracting States in which the application of national procedures is desired and be accompanied by a conversion fee. In the absence of the fee the applicant or proprietor is notified that the request will not be deemed to be filed until the fee is paid. The EPO transmits the request to the central industrial property offices of the specified Contracting States accompanied by a copy of the files relating to the European application or patent.

Chapter V

Communicating the formalities report; amendment of application; correction of errors

1. Communicating the formalities report

After a formalities examination, the Receiving Section or, where appropriate, the Examining Division, issues a report to the applicant if the application is found to be formally defective. The report will identify all the particular requirements of the EPC which the application does not satisfy and, in the case of deficiencies which can be corrected, will invite the applicant to correct such deficiencies within specified periods (see III, 16). The applicant will be notified of the consequences, e.g. application deemed withdrawn, priority right lost, which result from the deficiencies or failure to take appropriate action within due time.

In general, depending on the deficiency in question, either:

(i) a time limit will be specified by the EPO, subject to Rule 132, for meeting the objection, e.g. an invitation to supply the priority document or priority file number under Rule 59, or

(ii) a fixed time limit will apply, e.g. two months for correcting deficiencies under Rule 58.

For further details see E-VIII, 1. If a deficiency is not rectified within due time, then the legal effects that are envisaged will apply.

2. Amendment of application

2.1 Filing of amendments

Rule 58
Rule 137(1) and (2)
Art. 123(1) and (2)
Rule 68(4)

Prior to the receipt of the European search report the applicant may amend his application only if the Receiving Section has invited him to remedy particular deficiencies, including the case where no claims are present in the application as originally filed, wherein the applicant must rectify this deficiency by filing a set of claims in response to a communication according to Rule 58 (see III, 15). After receipt of the European search report and before receipt of a first communication from the Examining Division, i.e. also during the period in which the application may still be with the Receiving Section, the applicant may of his own volition amend the description, claims and drawings (Rule 137(2)). Furthermore, where a search opinion accompanies the search report under Rule 62(1), the applicant must respond to it by filing observations and/or amendments (see B-XII, 9 for details and exceptions to this requirement). However, the European patent application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as

filed (regarding the publication of claims thus amended in response to the European search report under Rule 137(2), see also VI, 1.3).

2.2 Examination of amendments as to formalities

Rule 58
Rule 137(1)

The Receiving Section examines amendments, filed before the receipt of the search report, for formal requirements. Such amendments must remedy the deficiencies notified by the Receiving Section. The description, claims and drawings may be amended only to an extent sufficient to remedy the disclosed deficiencies and this requirement makes it necessary for the Receiving Section to compare any amended description, claims and drawings with those originally filed. Where, for example, a fresh description is filed to replace an earlier description that was objected to on account of non-compliance with the physical requirements, the Receiving Section must compare both descriptions and the objection is not met until there is identity of wording. However, identity of wording with the application documents as originally filed is not a requirement for amendments rectifying the following deficiencies:

(i) filing at least one claim according to Rule 58, where no claims existed on filing (see III, 15) (these claims must still satisfy the requirements of Art. 123(2), but this check is carried out by the Search and Examining Divisions)

(ii) the filing of missing parts of the description, or drawings according to Rule 56 (see II, 5).

Amendments which extend beyond the remedying of deficiencies and which are filed prior to receipt of the search report may be taken into consideration in the subsequent procedure provided that, on receipt of the search report, the applicant declares that he wishes them to be maintained.

Examination as to formalities of amendments filed after the receipt of the search report and before the application is transferred to the Examining Division is the responsibility of the Receiving Section.

The procedure for effecting amendments is dealt with in E-II.

3. Correction of errors in documents filed with the EPO

Rule 139

Linguistic errors, errors of transcription and mistakes in any document filed with the EPO may be corrected on request. Requests for such amendments may be made at any time. However, if the error to be corrected concerns items which third parties might expect to be able to take at face value, so that their rights would be jeopardised by correction, the request for correction must be filed as soon as possible, and at least in time that it could be incorporated in the publication of the European patent application. With regard to correction of priority claims, specific provisions apply, with a view to protecting the interests of third parties, which allow the applicant to correct priority claims and lay down a time limit for doing so (see Rule 52(3) and III, 6.5.2). This

ensures that corrected priority information is available when the application is published. The applicant can only correct the priority claim later than this date, in particular after publication of the application, under certain limited circumstances, where it is apparent on the face of the published application that a mistake has been made. See J 2/92, J 3/91 and J 6/91, OJ 6/1994, 375, 365 and 349, respectively, as well as J 11/92, OJ 1-2/1995, 25, and J 7/94, OJ 12/1995, 817. Each of these decisions indicated situations under EPC 1973 in which the correction of priority data too late for a warning to be published with the application could be allowed. These same situations apply mutatis mutandis under EPC 2000 to the acceptance of requests to correct priority claims after the end of the time limit according to Rule 52(3). Regarding correction of the date indicated for the previous filing, see also III, 6.6.

Rule 139, 2nd sentence

If the error is in the description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else could have been intended than what is offered as the correction. Such a correction may be effected only within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed (see G 3/89 and G 11/91, OJ 3/1993, 117 and 125; see also C-VI, 5.4). The documents to be considered in assessing whether or not the correction is allowable are those of the application as originally filed, including any late-filed missing parts of the description, or drawings filed according to Rule 56, regardless of whether this resulted in a change of the date of filing (see II, 5 *et seq*). However, claims filed after the filing date in response to an invitation according to Rule 58 (see III, 15) cannot be used in assessing the allowability of the request.

In the case of electronic filing of European patent applications, the technical documents (description, claims, abstract and drawings) may be attached in their original format, provided this format is one listed in the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.5. Pursuant to this Decision, these technical documents may also be attached in a format other than those listed, provided that the applicant informs the EPO, when filing the application, where the EPO can reasonably acquire the corresponding software. If, on the date of filing, the documents making up the European patent application are available both in the format provided by the *epoline*® Online Filing software and in another admissible format in accordance with the above-mentioned Notice, the documents in the latter format can also be used in order to determine whether a request for correction of the description, claims, or drawings is allowable.

It is in particular not allowable to replace the complete application documents (i.e. description, claims and drawings) by other documents which the applicant had intended to file with his request for grant (see G 2/95, OJ 10/1996, 555). The Examining Division decides on the request for correction. If a request for correction is pending before

termination of the technical preparations for publication, a reference to the request is published on the front page.

Chapter VI

Publication of application; request for examination and transmission of the dossier to Examining Division

1. Publication of application

1.1 Date of publication

The application is published as soon as possible after the expiry of a period of eighteen months from the date of filing or, where priority is claimed, from the earliest priority date. The application may, however, be published before that date if requested by the applicant and provided the filing and search fees have been validly paid. If the decision granting the patent becomes effective before expiry of the period referred to above, the application and the patent specification will both be published early. *Art. 93(1)*

If the applicant abandons his priority date, then the publication is deferred provided that the notification of the abandonment is received by the EPO before the termination of the technical preparations for publication. These preparations are considered terminated at the end of the day five weeks before the end of the eighteenth month from the date of priority, if priority is claimed, or from the date of filing, if the priority is abandoned or if no priority is claimed (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, D.1). The applicant is informed when they are actually completed, and also of the publication number and intended publication date. Where the notification of abandonment of the priority is received after that time, publication, if it has not already taken place, takes place as if the priority date applied, although a notice as to the abandonment of the priority will appear in the European Patent Bulletin (see C-V, 3.5). The same procedure is followed when the priority right is lost under Art. 90(5).

1.2 No publication; preventing publication

The application is not published if it has been finally refused or deemed withdrawn or withdrawn before the termination of the technical preparations for publication. These preparations are considered terminated at the end of the day five weeks before the end of the eighteenth month from the date of filing or priority (see the Notice from the EPO, OJ 6/2006, 406). The application is, however, published if, upon termination of the technical preparations for publication, a request for a decision under Rule 112(2) has been received but no final decision has yet been taken (see OJ 11/1990, 455). *Rule 67(2)*

If after termination of the technical preparations the application is withdrawn to avoid publication, non-publication cannot be guaranteed.

The EPO will however try (in accordance with the principles of J 5/81, OJ 4/1982, 155) to prevent publication on a case-by-case basis if the stage reached in the publication procedure permits this reasonably easily.

Rule 15

The application may be withdrawn by means of a signed declaration, which should be unqualified and unambiguous (see J 11/80, OJ 5/1981, 141). The applicant is bound by an effective declaration of withdrawal (see Legal Advice No. 8/80, OJ 1/1981, 6), but may make it subject to the proviso that the content of the application is not made known to the public. This takes into account the procedural peculiarity that the applicant who makes his declaration of withdrawal later than five weeks before the date of publication cannot know whether publication can still be prevented. However, neither the application nor the designation of a Contracting State may be withdrawn as from the time a third party proves that he has initiated proceedings concerning entitlement and up to the date on which the EPO resumes the proceedings for grant.

1.3 Content of the publication

Rule 68(1), (3) and (4)
Rule 20
Rule 32(1)

The publication must contain the description, the claims and any drawings as filed, including any late-filed missing parts of the description, or drawings filed according to Rule 56 (see II, 5), provided that these were not subsequently withdrawn (see II, 5.5), and specify, where possible, the person(s) designated as the inventor(s). If the claims were filed after the date of filing according to the procedures explained in III, 15, this will be indicated when the application is published (Rule 68(4)).

The publication also indicates as designated Contracting States all States party to the EPC on the date the application was filed, unless individual states have been withdrawn by the applicant before the termination of the technical preparations for publication. When a European application filed before 1 April 2009 is published, the States for which protection is actually sought may not yet be known, because the time limit under Rule 39(1) for paying the designation fees is still running. Those definitively designated – through actual payment of designation fees – are announced later in the Register of European Patents and the European Patent Bulletin (see Information from the EPO, OJ 10/1997, 479). For European divisional applications, see A-IV, 1.3.4.

Rule 68(2) and (4)
Rule 66
Rule 139

The publication also contains any new or amended claims filed by the applicant under Rule 137(2), together with the European search report and the abstract determined by the Search Division if the latter are available before termination of the technical preparations for publication. Otherwise the abstract filed by the applicant is published. The search opinion is not published with the European search report (Rule 62(2)). It is however open to file inspection (see XII, 2.1). If a request for correction under Rule 139 of errors in the documents filed with the EPO is allowed, it must be incorporated in the publication. If

upon termination of the technical preparations for publication a decision is still pending on a request for correction of items which third parties might expect to be able to take at face value, so that their rights would be jeopardised by correction, this must be mentioned on the front page of the publication (see the case law in V, 3), as must a request for correction of errors in the description, claims or drawings (see V, 3). If the EPO has received a communication from the applicant under Rule 32(1), ("expert solution"), this too must be mentioned. Further data may be included at the discretion of the President of the EPO.

With the exception of documents which must be translated, originals of documents filed are used for publication purposes where these documents meet the physical requirements referred to in IX, 2, otherwise the amended or replacement documents meeting these requirements are used. Prohibited material may be omitted from the documents before publication, the place and number of words or drawings omitted being indicated (see III, 8.1 and 8.2). Documents incorporated in an electronic file are deemed to be originals (Rule 147(3)).

1.4 Publication in electronic form only

All European patent applications, European search reports and European patent specifications are now published in electronic form only, on a publication server (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, D.3 and OJ 2/2005, 126). These documents are not published on paper.

1.5 Separate publication of the European search report

If not published with the application, the European search report is published separately (also electronically).

2. Request for examination and transmission of the dossier to the Examining Division

2.1 Communication

Rule 69(1) and (2)

The Receiving Section communicates to the applicant the date on which the European Patent Bulletin mentioned the publication of the European search report and draws his attention to the provisions with regard to the request for examination as set out in Art. 94(1) and (2) and Rule 70(1). The applicant may not invoke the omission of the communication. If the communication wrongly specifies a later date than the date of the mention of the publication, the later date is decisive as regards the time limit for filing the request for examination (see VI, 2.2) and also for responding to the search opinion (see B-XII, 9 and VI, 3) unless the error is apparent. In the communication, the applicant is also informed that the designation fee(s) must be paid within six months of the date on which the European Patent Bulletin mentioned the publication of the search report (see III, 11.2 and 11.3).

2.2 Time limit for filing the request for examination

Art. 94(1) and (2)
Rule 70(1)

The request for examination may be filed by the applicant up to the end of six months after the date on which the European Patent Bulletin mentions the publication of the European search report. The request for examination is not deemed to have been filed until the examination fee has been paid. If the applicant does not file the request for examination, including the payment of the examination fee, within the above time limit, then the procedure explained in VI, 2.3 applies.

Art. 78(1)(a)
Rule 41(1)

The mandatory Request for Grant form (Form 1001), contains a written request for examination. The applicant has only one procedural act – payment in due time of the examination fee (Art. 94(1) and Rule 70(1)) – to worry about.

Art. 11(a) RFees

On the other hand, there is nothing to stop him paying the examination fee at the same time as he files the application. If, after receipt of the European search report, he decides not to pursue the application further and does not react to the invitation pursuant to Rule 70(2), the application will be deemed withdrawn pursuant to Rule 70(3), and the examination fee will be refunded in its entirety (see VI, 2.5).

Point 12 AAD
Point 6.1(b) AAD

If the applicant has filed an automatic debit order, the examination fee will normally be debited at the end of the six-month period. For cases in which he wishes the application to be transmitted earlier to the Examining Division, see the AAD in Annex A.1 of Supplement No. 1 to OJ 3/2009).

Rule 70(1)

The request for examination may not be withdrawn.

Regarding Euro-PCT applications entering the European phase, see VII, 1.3 and 5.2.

2.3 Legal remedy

Art. 94(2)
Rule 112(1)

If the request for examination is not validly filed before expiry of the period under Rule 70(1), the application is deemed to be withdrawn and the applicant is notified accordingly. In response to this communication concerning loss of rights, the applicant can request further processing in accordance with Art. 121 and Rule 135.

Rule 70(2) and (3)
Rule 112(1)
Art. 121

If the applicant has validly filed a request for examination before the European search report has been transmitted to him, the Receiving Section invites him according to Rule 70(2) to indicate within six months from the date of the mention of the publication of the search report in the European Patent Bulletin whether he desires to proceed further with his application. If he fails to respond to this request in time, the application is deemed to be withdrawn and the applicant is notified accordingly. In this case, the applicant may also avail himself of the legal remedy under Art. 121 and Rule 135 (further processing of the application). Regarding reimbursement of the examination fee, cf. VI, 2.2 and XI, 10.2.4. C-VI, 1.1.2 describes the procedure in respect of a categorical request for examination, as provided for in

Rule 10(4), where the applicant waives the right to the communication according to Rule 70(2).

Regarding Euro-PCT applications entering the regional phase, see VII, 1.3 and 5.2.

2.4 Transmission of the dossier to the Examining Division

Art. 16
Art. 18(1)
Rule 10

If the Receiving Section finds that the request for examination was filed in due time, or the desire to proceed further with the application was indicated in due time (Rule 70(2)), it transmits the application to the Examining Division. Otherwise, it notes the loss of rights which has occurred (see Rule 112(1)).

The dossier as transmitted to the Examining Division contains the following, some of which are present in a paper dossier, while others are present in a corresponding computer dossier:

(i) all documents filed in relation to the application, including priority documents, translations and any amendments;

(ii) any certificate filed in relation to display at an exhibition (see IV, 3) and any information furnished under Rule 31 when the application relates to biological material (see IV, 4);

(iii) the European search report, if applicable the search opinion, the content of the abstract as drawn up by the Search Division, and the internal search note, if any;

(iv) copies of documents cited in the search report, and two copies of the publication document(s);

(v) the applicant's response to the search opinion (see B-XII, 9) or to the WO-ISA/IPER prepared by the EPO (see C-VI, 3.5.1); and

(vi) all relevant correspondence. Copies of certain EPO communications to applicants or inventors – currently EPO Forms 1048, 1081, 1082 and 1133 – are kept only in the corresponding computer dossier: their most important elements can at all times be printed out (as EPO Form 1190) and placed in the paper dossier.

The Receiving Section will direct attention to any aspects of the application which require urgent attention by the Examining Division, e.g. any letters which have to be answered before the application is examined in its proper turn.

2.5 Refund of examination fee

Art. 11 RFees

The examination fee is refunded:

(i) in full if the European patent application is withdrawn, refused or deemed to be withdrawn before the Examining Divisions have assumed responsibility; or

(ii) at a rate of 75% if the European patent application is withdrawn, refused or deemed to be withdrawn after the Examining Divisions have assumed responsibility but before substantive examination has begun. This applies in particular where the applicant does not respond to the search opinion on time (leading to the application being deemed to be withdrawn under Rule 70a(3) - see B-XII, 9), but does file on time either the request for examination according to Rule 70(1) (see C-VI, 1.1) or confirmation that he wishes to proceed with the application according to Rule 70(2) (see C-VI, 1.1.1). An applicant unsure whether substantive examination has begun and wanting to withdraw the application only if he will receive the 75% refund may make withdrawal contingent upon the refund ("conditional" withdrawal).

2.6 Reduction in examination fee

Art. 14(4)
Rule 6(3)
Art. 14(1) RFees

Where applicants having their residence or principal place of business within the territory of a Contracting State having a language other than English, French or German as an official language, and nationals of that State who are resident abroad avail themselves of the options provided for under Art. 14(4), the examination fee is reduced (Rule 6(3) in conjunction with Art. 14(1) RFees) (see XI, 9.2.1 and 9.2.3).

3. Response to the search opinion

Rule 70a

The applicant is required to respond to the search opinion within the time limit under Rule 70(1) or, if a communication under Rule 70(2) is sent (see C-VI, 1.1.1), within the time limit under Rule 70(2). If the applicant fails to respond to the search opinion on time, the application is deemed to be withdrawn (Rule 70a(3)). For more details see B-XII, 9.

Chapter VII

Applications under the Patent Cooperation Treaty (PCT) before the EPO acting as a designated or elected Office

1. General

1.1 Introduction

The general considerations relating to applications under the PCT for which the EPO acts are set out in E-IX.

Pursuant to Art. 153(2), an international application for which the EPO acts as a designated or elected Office is deemed to be a European patent application. For information about time limits and procedural steps before the EPO as a designated or an elected Office under the PCT, see the Guide for applicants "How to get a European patent, Part 2: PCT procedure before the EPO – Euro-PCT". *Art. 153(2)*

In order to initiate the European phase, the requirements for entry into the European phase according to Rule 159 must be complied with (see VII, 1.2 and 1.3). For entry into the European phase, applicants are strongly recommended to use the most recent edition of Form 1200 obtainable from the EPO free of charge in printed form, as editable electronic document from the EPO website or as part of the epoline® Online Filing software.

This Chapter deals with the **differences** from the practice set out in earlier Chapters of this Part A of the Guidelines when dealing with such international applications as a designated or elected Office. However, it is necessary to consider briefly some of the provisions applicable to international applications as set out in VII, 1.2, 1.3 and 1.4 below.

1.2 Initial processing and formal examination; copy of the international application; translation

The initial processing and formal examination of international applications in the international phase are carried out by PCT authorities and under provisions of the PCT. Unless there is a specific request from the applicant, the EPO acting as a designated or elected Office may not process or examine an international application prior to the expiry of 31 months from the date of filing of the application or, if priority has been claimed, from the earliest priority date (see E-IX, 5.5 and 6.2). Since the EPO has not exercised the waiver referred to in Art. 20(1)(a) PCT, a copy of the international application will be furnished by the International Bureau. The EPO does not require the applicant to furnish a copy of the international application under Art. 22 PCT, even if the International Bureau has not communicated a copy under Art. 20 PCT (see PCT Gazette 14/1986, 2367).

Art. 23 PCT
Art. 40 PCT
Rule 49.1(a-bis) PCT
Art. 24(1)(iii) PCT
Rule 159(1)
Rule 160
Art. 121
Art. 2, No. 12, RFees

Where the language of the international application is not an official language of the EPO, the applicant is required, in accordance with Art. 22 or 39 PCT and Rule 159(1)(a), to furnish a translation within a period of 31 months from the date of filing or, if priority has been claimed, from the earliest priority date. The application is deemed to be withdrawn if the translation is not furnished within that period (Rule 160(1)). If the EPO finds that the application is deemed to be withdrawn for this reason, it communicates this to the applicant (Rule 160(3)). Rule 112(2) applies mutatis mutandis. The loss of rights is deemed not to have occurred if, within two months as from notification of the communication, the translation and a valid request for further processing (including the payment of the requisite fee) are filed (Art. 121 and Rule 135(1)).

1.3 Filing fee, designation fee, request for examination, search fee and claims fees

Rule 159(1)
Rule 160
Art. 2, No. 12, RFees

Under Rule 159(1)(c), the applicant must pay the filing fee, including any additional fee for pages in excess of thirty-five (see A-III, 13.2), within a period of 31 months from the date of filing or, if priority has been claimed, from the earliest priority date. Further, under Rule 159(1)(d), he must pay the designation fee(s) within this period, if the time limit specified in Rule 39(1) has expired earlier. Under Rule 159(1)(f), the request for examination must also be filed within this period, if the time limit specified in Rule 70(1) has expired earlier. Where a supplementary European search report needs to be drawn up, a search fee must also be paid to the EPO within this period. Failure to pay in due time the filing fee, the additional fee, the search fee or the designation fee, or to file the request for examination, means that the application is deemed to be withdrawn.

For applications entering the European phase before 1 April 2009 (see A-III, 11.3.2), payment of no designation fee at all in due time similarly means that the application is deemed to be withdrawn, and any designation of a Contracting State for which the designation fee has not been paid in due time is also deemed to be withdrawn. If the EPO finds that the application or the designation of a Contracting State is deemed to be withdrawn for this reason, it communicates this to the applicant (Rule 160(3)). However, for these applications, if the applicant used Form 1200 for Entry into the European phase and waived the right to receive a communication according to Rule 160(3) in respect of designations other than those indicated specifically on Form 1200 by crossing the appropriate box in the appropriate section of the Form, a communication pursuant to Rule 160(3) is issued only where, contrary to his originally declared intention in Form 1200, he has failed to pay designation fees for States for which he had indicated his intention to pay.

The communication under Rule 160(3) and the communication according to Rule 112(1) are sent together in one and the same communication. In response to this notification of a loss of rights, the

applicant can request further processing. Any loss of rights ensues on expiry of the normal period (G 4/98, OJ 3/2001, 131).

If applicable, the claims fees under Rule 162 must also be paid within the normal period referred to above. If they are not, they may still be validly paid within a non-extendable period of grace of one month of notification of a communication pointing out the failure to pay. If amended claims are filed during this grace period, they form the basis for calculating the number of claims fees due. Where a claims fee has not been paid in time, the claim concerned is deemed to be abandoned. Features of a claim deemed to have been abandoned pursuant to Rule 162(4) and which are not otherwise to be found in the description or drawings cannot subsequently be reintroduced into the application and, in particular, into the claims. *Rule 162*

1.4 PCT vs. EPC provisions

In proceedings before the EPO relating to international applications, the provisions of the PCT are applied, supplemented by the provisions of the EPC. In case of conflict, the provisions of the PCT prevail. The EPO cannot require compliance with requirements relating to form or contents of the international application different from or additional to those which are provided for in the PCT. As a result of the overriding PCT provisions and the requirements of Part X of the EPC, i.e. Art. 150 to 153, relating to international applications pursuant to the PCT, the practice set out in the earlier Chapters of this Part A of the Guidelines does not necessarily hold good for international applications. In particular, where the PCT international publication was in an official EPO language, it is not necessary for the Receiving Section to subject the copy of the application furnished to the EPO to a formalities examination except to the extent indicated later. On the other hand, where it is necessary to furnish a translation of the international application, the Receiving Section must carry out for that translation a more extensive formalities examination. *Art. 150(2)*

The formalities examination of an international application, **insofar as it differs** from that applicable to European direct applications, is considered in what follows by reference to the provisions of appropriate sections of the earlier Chapters of this Part A. Unless otherwise specified, the comments relate to the translation of the international application.

2. Provisions of Chapter II ("Filing of applications and examination on filing")

The provisions of II, 1 ("Where and how applications may be filed") do not apply to international applications, except where explicit reference is made to international applications, including Euro-PCT applications.

The PCT requirements corresponding to those of II, 2 ("Persons entitled to file an application") are more restrictive, as in general the applicant must be a resident or national of a PCT Contracting State and therefore no supplementary examination should be necessary.

The provisions of II, 3 ("Procedure on filing") do not apply.

The provisions for late filing of missing parts completely contained in the priority document (Rule 56) exist also under the PCT (Rule 20.5 - 20.8 PCT).

The date of filing (see II, 4 ("Examination on filing")) of a Euro-PCT application is that accorded under the PCT by the PCT authority which acted as the receiving Office. Nevertheless, the payment of the filing fee and the search fee and, where applicable, the supply of a translation pursuant to Art. 153(4) and Rule 159(1) should be checked. The period for supplying the translation and for payment of the above-mentioned fees is as specified in VII, 1.2 and 1.3.

If the application is not deemed to be withdrawn, a copy of the application is referred to the Search Division for drawing up any supplementary European search report, if necessary (see E-IX, 5.4).

3. Provisions of Chapter III ("Examination of formal requirements")

3.1 Representation

The provisions of III, 2 ("Representation") apply to international applications whether furnished in an official language or in translation. A professional representative having a right to practice before the PCT International Authorities is not necessarily authorised to act before the EPO (see Art. 27(7) PCT). For the representation of applicants before the EPO as designated or elected Office see the latest version of the Guide for Applicants "How to get a European patent, Part 2: PCT procedure before the EPO – Euro-PCT".

Rule 163(4) to (6)

If there is more than one applicant and the following information was not provided for one or more of those applicants in the International phase and is still missing at the expiry of the 31-month period under Rule 159(1):

(i) address

(ii) nationality

(iii) State of residence or principal place of business

the EPO will invite the applicant to furnish these indications within two months. Failure to do so will lead to refusal of the application. The same applies if the requirements for representation are not met at the end of the 31-month period, with the same consequence for failure to correct the deficiency in time. If the applicant fails to reply in time to the above-mentioned invitation, he may request further processing.

3.2 Physical requirements

The application must be examined for compliance with the physical requirements as set out in III, 3 ("Physical requirements"). The requirements are in general identical with the corresponding requirements of the PCT and no supplementary examination should be necessary when the application is furnished in an official language.

3.3 Request for grant

The request for grant (see III, 4 ("Request for grant")) for international applications will appear on the PCT Request form (Form PCT/RO/101). This form corresponds in general to the EPO Request for Grant form (Form 1001) and provides for the entry of the information listed in Rule 41(2), with the exception of the items referred to in sub-paragraphs (e) and (f) thereof.

3.4 Designation of inventor

Rule 163(1)

The requirement, as set out in III, 5 ("Designation of inventor"), that the designation of inventor is filed in a separate document where the applicant is not the inventor or the sole inventor has to be complied with irrespective of the language of the international application, unless the inventor has already been named in the PCT request. Where the inventor has been named in the PCT request, he cannot waive his right to be mentioned in the published application. If the inventor has not been named in the international application at the expiry of the period of 31 months from the date of filing, or, in the case of priority, from the earliest date of priority claimed, the EPO invites the applicant to file the designation of inventor within a period of two months. Failure to rectify this deficiency in time, leads to refusal of the application according to Rule 163(6). The applicant will be notified of this decision according to Rule 111. He may request further processing.

3.5 Claim to priority

Rule 17.1 and 17.2 PCT

The claim to priority (see III, 6 ("Claim to priority")) for an international application refers to the date, or dates, claimed under the PCT. Normally, the copy of the previous application, referred to in III, 6.7, i.e. the priority document, is furnished to the EPO as designated Office by the International Bureau and not by the applicant. In accordance with Rule 17.2 PCT, the International Bureau will be requested by the EPO to furnish it with a copy as standard practice promptly, but not earlier than international publication, or, where the applicant has requested early examination (in accordance with Art. 23(2) PCT), not earlier than the date of the request. Where the applicant has complied with Rule 17.1(a) and (b) PCT, the EPO may not ask the applicant himself to furnish it with a copy.

Rule 163(2)

Where the file number or the copy of the previous application has not yet been submitted at the expiry of the period of 31 months, the EPO invites the applicant to furnish the number or the copy within a specified period. However, Rule 53(2) and the Decision of the President of the EPO dated 17 March 2009, OJ EPO 4/2009, 236, providing an exception to the requirement that a copy of the previous

application be furnished (see III, 6.7), also apply to international applications entering the European phase. Furthermore, as just mentioned, where the applicant has complied with Rule 17.1(a) or (b) PCT the EPO as a designated Office may not ask the applicant himself to furnish it with a copy of the priority document (Rule 17.2(a) PCT, second sentence).

If the priority document is not on file, substantive examination may nevertheless be started. However, no European patent may be granted until such time as the priority document is on file. In such a case, the applicant is informed that the decision to grant will not be taken as long as the priority document is missing.

Art. 88(1)
Rule 53(3)

Where a translation of the previous application into one of the official languages of the EPO is required, it must be filed on request from the EPO in accordance with Rule 53(3) (see III, 6.8 and 6.10).

The provisions for restoration of priority rights (see III, 6.6) exist also under the PCT (Rules 26bis.3 and 49ter PCT). Under the PCT, restoration of right of priority can be made either in the international phase before the receiving Office (Rule 26bis.3 PCT) or in the regional phase before the EPO as designated Office (Rule 49ter.2 PCT).

It should be noted that the EPO both as a Receiving Office and as a designated Office will only accept the restoration of priority rights if it is made under the "due care" criterion (Rules 26bis.3(a)(i) and 49ter.2(a)(i) PCT). As a consequence, any restoration of priority rights made by a receiving Office under the "unintentional" criterion does not have an effect with the EPO as designated Office (Rule 49ter.1(b) PCT).

3.6 Title of the invention

In relation to III, 7 ("Title of the invention"), the title need only meet the less demanding requirements of Rule 4.3 PCT rather than those set out in III, 7.1 and 7.2.

3.7 Prohibited matter

As prohibited statements or matter may not necessarily be omitted under Art. 21(6) PCT, the application must be examined to ensure that the provisions of III, 8 ("Prohibited matter") are complied with. Where the EPO is informed by the International Bureau that statements or matter were omitted from the published PCT application, the Receiving Section should ensure that the corresponding material is excluded from the translation as furnished by the applicant.

3.8 Claims fee

The time limit for paying the claims fee referred to in III, 9 is, as indicated in VII, 1.3, 31 months from the date of filing or, if priority has been claimed, from the earliest priority date (Rule 162(1)).

3.9 Drawings

The provisions of II, 5 with regard to the filing of drawings are identical with the corresponding provisions of the PCT and therefore no supplementary examination should be necessary.

3.10 Abstract

The abstract (see III, 10 ("Abstract")) is included in the copy of the international application supplied to the EPO.

3.11 Designation fee

The time limit for paying the designation fee is 31 months from the date of filing or, if priority has been claimed, from the earliest priority date, if the time limit specified in Rule 39(1) has expired earlier (Rule 159(1)(d)) (see III, 11.2.5 and A III, 11.3.9 for further details). If, subsequent to the receipt of the international application by the EPO and prior to the date on which processing or examination may start, the regional designation of all Contracting States of the EPC is withdrawn, the Euro-PCT application, insofar as it is deemed to be a European application pursuant to Art. 153(2), is deemed to be withdrawn.

For information on the requirements for extension of a Euro-PCT application to States for which an Extension Agreement with the EPO has become effective, see III, 12.

4. Provisions of Chapter IV ("Special provisions")

4.1 Divisional applications

In relation to IV, 1 ("European divisional applications") there is no provision in the PCT for filing divisional applications. One or more European divisional applications may be filed in respect of subject-matter contained in an earlier Euro-PCT application, but not before the latter application is pending before the EPO acting as designated or elected Office, i.e. has entered the European phase (see IV, 1.1.1). The divisional application must be filed in the language of the proceedings of the earlier application (see IV, 1.3.3).

4.2 Sequence listings

Rules 5.2 and 13ter PCT apply to the filing of sequence listings (see IV, 5 ("Applications relating to nucleotide and amino acid sequences")). The EPO as International Searching Authority (see E-IX, 3) makes use of the opportunity under Rule 13ter.1 PCT to invite the applicant where appropriate to furnish it with the prescribed sequence listing in electronic form according to WIPO Standard ST. 25, paragraph 39 ff (see Art. 4 of the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, C.1 with the accompanying Notice from the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, C.2 (point II)). The furnishing of sequence listings in response to an invitation under Rule 13ter.1 PCT is subject to a late furnishing fee (see Rule 13ter.1(c) PCT).

Rule 163(3)

For Euro-PCT applications entering the regional phase before the EPO, the applicant will be invited to furnish a sequence listing in accordance with WIPO Standard ST. 25 and pay a late furnishing fee within a period of two months, if such a sequence listing is not available to the EPO at the expiry of the period for entry into the regional phase (see Rule 163(3) and Rule 30(3)).

5. Provisions of Chapter VI ("Publication of application; request for examination and transmission of the dossier to Examining Division")

5.1 Publication of the international application

Art. 153(3) and (4)

The publication of the international application under the PCT takes the place of the publication referred to in VI, 1, provided that the international application is published in an official language of the EPO. Where the international application is published in a non-official language, the translation of the international application as furnished by the applicant is published by the EPO; the provisions of VI, 1, insofar as they are relevant, apply to such publication.

5.2 Request for examination

Art. 153(6)
Art. 150(2)
Rule 159(1)(f)

The time limit for filing the request for examination referred to in VI, 2 runs from the date of publication under Art. 21 PCT of the international search report. However, this time limit will not expire before the time prescribed by Rule 159(1)(f) (31 months from the priority date). See also VII, 1.3.

5.3 Supplementary European search

Rule 70(2)

If a supplementary European search report has to be drawn up in respect of an international application which is deemed to be a European patent application, the applicant is entitled to receive the invitation provided for in Rule 70(2) (see VI, 2.3, 2nd paragraph, and J 8/83, OJ 4/1985, 102).

6. Reduction and refunds of fees in respect of international (PCT) applications

See XI, 9.3 and 10.2.

7. The communication according to Rule 161

Rule 161(1)

If the EPO has acted as the ISA and, where a demand was filed, also as the IPEA for a Euro-PCT application, it gives the applicant the opportunity to comment on the written opinion of the ISA or the International Preliminary Examination Report and, where appropriate, invites him to correct any deficiencies noted therein and to file amendments within a period of one month from the respective communication. If the applicant does not respond in due time, the application will be deemed to be withdrawn, subject to certain exceptions (see C-VI, 3.5.1 for details). If the EPO has acted as ISA, but another office has acted as IPEA, under Rule 161(1) the applicant is required to respond to the written opinion prepared by the EPO as

ISA and not to the International Preliminary Examination Report prepared by the other office.

Where the EPO draws up a supplementary European search report on a Euro-PCT application (see B-II, 4.3), the application may be amended once within a period of one month from a communication informing the applicant accordingly. The application as amended serves as the basis for the supplementary European search. Failure to respond to this communication will not result in any sanction. However, the applicant will be required to respond to a search opinion accompanying the supplementary European search report for such an application, subject to certain exceptions (see B-XII, 9 for details). *Rule 161(2)*

If, on expiry of the time limit according to Rule 161(1) or (2), Rule 137(4) is not complied with in respect of amendments on which the further procedure is to be based (see C-VI, 5.7), after the Examining Division has assumed responsibility for the application (see C-VI, 1.1) it may send a communication according to Rule 137(4), requesting the applicant to remedy this deficiency (see C-VI, 3.5.1 and C-VI, 5.7.1), provided that the application is of one of the types mentioned in C-VI, 5.7.4.

Chapter VIII

Languages

1. Provisions concerning the language of the proceedings

1.1 Admissible languages; time limit for filing the translation of the application

European patent applications can be filed in any language. However, if filed in a language other than an official language of the EPO (English, French or German), a translation into English, French or German must be filed within two months of the date of filing (Rule 6(1)). Such translation may be subsequently brought into conformity with the original text of the application (but see VIII, 6.2). For the procedure where the translation is not filed in time, see III, 14.

Art. 14(1) and (2)
Rule 6(1)
Art. 90(3)

Where the description is filed by reference to a previously filed application (see II, 4.1.3.1) and the previously filed application used for the reference is not in an official language of the EPO, the applicant must also file a translation into one of those languages within two months of the date of filing. With regard to the procedure when the translation is not filed on time, see also III, 14.

Rule 40(3)

However, the use of a non-EPO language does not automatically qualify the application for a reduction in the filing fee. This is only available under certain circumstances (see XI, 9.2.1 and 9.2.2).

1.2 Language of the proceedings

The language (chosen from English, French or German) in which the application is filed, or into which it is subsequently translated, constitutes the "language of the proceedings". Amendments to a European patent application or European patent must be filed in the language of the proceedings. This language is also used by the EPO in written proceedings. (As regards documents which are not filed in the correct language, see VIII, 4 below).

Art. 14(3)
Rule 3(2)

1.3 European divisional applications; Art. 61 applications

Any European divisional application must be filed in the language of the proceedings of the earlier application from which it is divided. Alternatively, if the earlier (parent) application was not in an official language of the European Patent Office, the divisional application may be filed in the language of the earlier application. In this case a translation into the language of the proceedings for the earlier application shall then be filed within two months of the filing of the divisional application (see A-III, 14). The same applies for the filing of a new European patent application under Art. 61(1)(b).

Rule 36(2)
Art. 61(2)

2. Derogations from the language of the proceedings in written proceedings

Rule 3(1)
Art. 14(3) and (4)
Rule 6(2)

In written proceedings before the EPO any party may use any official language of the EPO. However, in such proceedings the EPO uses the language of the proceedings in the sense of Art. 14(3). Natural or legal persons having their residence or principal place of business within an EPC Contracting State having a language other than English, French or German as an official language, and nationals of that state resident abroad, may file documents which have to be filed within a time limit in an official language of that state. For example, an Italian or Swiss applicant may file a reply to a communication from the Examining Division issued under Art. 94(3) in the Italian language. A translation of this document, into an official language of the EPO must be filed (Rule 6(2)). The translation can be into any EPO official language, regardless of the language of the proceedings.

Normally, the period allowed for filing this translation is one month after filing of the document, but if the document is a notice of opposition or appeal, or a petition for review (Art. 112a), the period extends to the end of the opposition or appeal period or the period for the petition for review, if this period expires later.

3. Documents to be used as evidence

Rule 3(3)

Documents which are to be used as evidence may be filed in any language. This applies during any proceedings before the EPO and applies especially to publications (for instance, an extract from a Russian periodical cited by an opponent to show lack of novelty or lack of inventive step). However, the department dealing with the case may require a translation in one of the languages of the EPO, at the choice of the person filing the document. If the document is filed by the applicant in pre-grant proceedings, the EPO should require a translation, unless the examiners are fully competent in the language concerned. In most cases, however, such documents will be filed in opposition proceedings and a translation should be required. The department concerned may require this translation to be filed within a time limit. This is to be fixed on a case-by-case basis. The period allowed should depend on the particular language concerned and on the length of the document to be translated, taking into account the provisions of Rule 132 (minimum of two months, maximum of four months, exceptionally six months). Failure to provide the translation within the specified time limit means that the EPO may disregard the document in question.

4. Documents filed in the wrong language

4.1 Documents making up a European patent application

Art. 78(1)

As explained in VIII, 1.1, all the documents making up a European application can be filed in any language (i.e. those listed in II, 4.1, plus the claims if present on the date of filing and any text of the drawings present on the date of filing). Consequently, it is not possible to file

these documents in the wrong language, provided that they are all in the same language and are furnished on the date of filing.

Divisional applications and applications according to Art. 61(1)(b), however, must be filed in the language of the proceedings of the earlier parent application from which they derive (see IV, 1.3.3).

4.2 Other documents

If any document other than those making up the application (e.g. a letter from the applicant in reply to an invitation under Art. 94(3)) is not filed in one of the prescribed languages or, where the applicant avails himself of Art. 14(4), the required translation is not filed in due time, it is deemed not to have been received. The person who has filed the document must be notified accordingly by the EPO. Accompanying documents relating to performance of a procedural act subject to a time limit (e.g. filing the designation of the inventor, the certified copy of the earlier application for which priority is claimed or that application's translation under Rule 53(3) into one of the official languages of the EPO) are dealt with as follows: if the European application number is given, the document goes into the dossier and the procedural act is recognised as having been performed, but any other contents are ignored. Regarding the signature of accompanying documents, see IX, 3.1.

Art. 14(4)
Rule 3(1) and (2)

According to Art. 115, following the publication of the European patent application, any person may file observations in writing concerning the patentability of the invention in respect of which the application has been filed. These written observations must be filed in English, French or German. Otherwise, they are deemed not to have been received.

Art. 115
Rule 114(1)

Even though deemed not to have been received, the document not filed in the prescribed language will become part of the file and therefore accessible to the public according to Art. 128(4). Observations by third parties and notices of oppositions will be communicated to the applicant or the patent proprietor, respectively, even if they have not been filed in the prescribed language and are therefore deemed not to have been filed (see Art. 14(4) and Rule 3(1) regarding the notice of opposition or Art. 14(4) and Rule 114(1) regarding third party observations) (see D-IV, 1.2.1 (v) regarding the legal consequences where a notice of opposition or notice of intervention of the assumed infringer is filed in a non-prescribed language).

Art. 128(4)
Art. 14(4)

5. Translation of the priority document

This point is dealt with in III, 6.8, C-V, 3.4 and D-VII, 2.

6. Authentic text

6.1 General remark

The text of an application or patent in the language of the proceedings is the authentic text. It follows therefore that the translation of the

Art. 70(1)

claims of the patent specification required by Art. 14(6) is for information only.

6.2 Conformity of translation with the original text

Rule 7
Art. 70(2)
Art. 14(2)

Where the applicant has filed an application in a language other than an official language of the EPO in accordance with Art. 14(2), or the application was filed by reference to a previously filed application which was not in an official language of the EPO (see II, 4.1.3.1) and the question arises as to whether a particular amendment proposed by the applicant or proprietor extends the content of the application or patent beyond the content of the application as filed and thus offends against Art. 123(2), the EPO should normally assume, in the absence of proof to the contrary, that the original translation into English, French or German is in conformity with the text in the original language, which can be any language (e.g. Japanese). However, it is the original text which constitutes the basis for determining such a question. Similarly, it is the original text which determines the content of the application as filed for the purposes of Art. 54(3) (see C-IV, 7.1). An erroneous translation from the original language of filing may be brought into conformity with the original language at any time during proceedings before the EPO, i.e. during pre-grant proceedings and also during opposition proceedings. But during opposition proceedings any amendment to bring the translation into conformity must not be allowed if it offends against Art. 123(3), that is if it is an amendment of the claims of the patent which extends the protection conferred.

7. Certificate of translation

Rule 5

The EPO has the power to require the filing of a certificate, certifying that a translation supplied corresponds to the original text, within a period to be determined by it. The exercise of this power should be determined on a case-by-case basis and ought to be used only when the official concerned has serious doubts as to the accuracy of the translation. The certificate could be called for either from the person who made the translation or from some other competent person. Failure to file the certificate in due time will lead to the document being deemed not to have been received unless the EPC provides otherwise. This partial loss of rights is subject to further processing under Art. 121 and Rule 135.

Rule 71(3)

Certificates are not in principle required in respect of the translations of the claims into the other two official languages required under Rule 71(3).

8. Derogations from the language of the proceedings in oral proceedings

Rule 4

These derogations are dealt with in E-V.

Chapter IX

Common provisions

1. Representation

1.1 Representation by a professional representative

Subject to the next sentence, no person may be compelled to be represented by a professional representative in proceedings before the EPO; this holds for all parties to such proceedings, e.g. applicants, proprietors, opponents. A party (natural or legal person) who has neither his residence nor principal place of business in a Contracting State must be represented by a professional representative; the party must act through this professional representative in all proceedings (other than filing the application including all acts leading to the assignment of a date of filing). To "be represented" is to be interpreted as meaning due representation, including not only notice of the appointment of a professional representative but also, where applicable, the filing of authorisations of the appointed representative (see IX, 1.5). Should an opponent who is party to the proceedings and does not have either a residence or his principal place of business within the territory of one of the Contracting States fail to meet the requirement set out under Art. 133(2) in the course of the opposition procedure (e.g. the representative withdraws from the opposition case or the appointed representative is deleted from the list of professional representatives), he is requested to appoint a new representative. Irrespective of whether he does so, he should nevertheless be informed of the date and location of any oral proceedings. However, it has to be drawn to his attention that if he appears only by himself he is not entitled to act before the Division.

Art. 133(1) and (2)
Art. 90(3)
Rule 152

1.2 Representation by an employee

Parties having their residence or principal place of business in a Contracting State are not obliged to be represented by a professional representative in proceedings before the EPO. They may, irrespective of whether they are legal or natural persons, be represented by an employee, who need not be a professional representative but who must be authorised. However, where such parties wish to be represented professionally before the EPO, such representation may only be by a professional representative. The parties themselves may also act directly before the EPO, even if they are represented by an employee or a professional representative. When conflicting instructions are received from the party and his representative, each should be advised of the other's action.

Art. 133(3)
Art. 134(1)
Rule 152

1.3 Common representative

Joint applicants, joint proprietors of patents and more than one person giving joint notice of opposition or intervention may act only through a common representative. If the request for the grant of a European patent, the notice of opposition or the request for intervention does not

Art. 133(4)
Rule 151(1)

name a common representative, the party first named in the relevant document will be considered to be the common representative. This representative can thus be a legal person. However, if one of the parties is obliged to appoint a professional representative this representative will be considered to be the common representative, unless the first named party in the document has appointed a professional representative. If during the course of proceedings transfer is made to more than one person, and such persons have not appointed a common representative, the preceding provisions will apply. If such application is not possible, the EPO will require such persons to appoint a common representative within a period to be specified. If this request is not complied with, the EPO will appoint the common representative.

For Rule 151 to apply, each party or his duly authorised representative must have signed the document (request for grant, notice of opposition, etc.) giving rise to his participation (see also III, 4.2.2 and IX, 3.2 and 3.4). Otherwise the party cannot take part in the proceedings, nor therefore be represented by a common representative.

1.4 List of professional representatives; legal practitioners

Art. 134(1) and (8)

Professional representation of natural or legal persons or companies equivalent to legal persons may only be undertaken by professional representatives whose names appear on a list maintained for this purpose by the EPO. However, professional representation may also be undertaken in the same way as by a professional representative by any legal practitioner qualified in one of the Contracting States and having his place of business within such State, to the extent that he is entitled, within the said State, to act as a professional representative in patent matters.

1.5 Signed authorisation

Rule 152

Representatives acting before the EPO must on request file a signed authorisation (see IX, 3.2) within a period to be specified by the EPO. If the requirements of Art. 133(2) are not fulfilled, the same period will be specified for the communication of the appointment and, where applicable, for the filing of the authorisation. Professional representatives who identify themselves as such will be required to file a signed authorisation only in certain cases (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, L.1). However, a legal practitioner entitled to act as a professional representative in accordance with Art. 134(8) or an employee acting for an applicant in accordance with Art. 133(3), first sentence, but who is not a professional representative, must file a signed authorisation; in Euro-PCT proceedings, persons representing clients in these capacities are not required to file signed authorisations if they have already filed an authorisation expressly covering proceedings established by the EPC with the EPO as receiving Office.

The authorisation can also be filed by the applicant. This also applies where the applicant is obliged to be represented, as fulfilling the requirement to be represented is not itself a procedural step under Art. 133(2) to which the rule of obligatory representation applies.

An authorisation remains in force until its termination is communicated to the EPO. The authorisation will not terminate upon the death of the person who gave it unless the authorisation provides to the contrary.

1.6 General authorisation

An authorisation may cover more than one application or patent. Also, a general authorisation enabling a representative to act in respect of all the patent transactions of the party making the authorisation may be filed. A corresponding procedure applies to the withdrawal of an authorisation.

Art. 133(2)
Rule 152(2), (4), (7), (8) and (9)

1.7 Invitation to file authorisation

Where the appointment of a legal practitioner entitled to act as professional representative in accordance with Art. 134(8), or an employee acting for an applicant in accordance with Art. 133(3), first sentence, but who is not a professional representative, is communicated to the EPO without an authorisation being filed, the representative is invited to file the authorisation within a period to be specified by the EPO. Where a party having neither residence nor principal place of business within a Contracting State has failed to fulfil the requirements of Art. 133(2) (cf. IX, 1.1), the invitation will be sent to him. The same period will be specified for the communication of the appointment and, where applicable, for the filing of the authorisation. The period may be extended in accordance with Rule 132 on request by the representative or party as the case may be (see E-VIII, 1.6). If such authorisation is not filed in due time, any procedural steps taken by the representative other than the filing of a European patent application will, without prejudice to any other legal consequences provided for in the EPC, be deemed not to have been taken. The party is informed accordingly.

Rule 152(2) and (6)
Rule 132

2. Form of documents

2.1 Documents making up the European patent application

The physical requirements which the documents making up the European patent application, i.e. request, description, claims, drawings and abstract, must satisfy are set out in Rule 49 and with regard to drawings in Rule 46. The President of the EPO may lay down further special formal or technical requirements for the filing of documents, in particular with regard to the filing of documents by technical means (Rule 2(1)). Notes on the preparation of OCR-readable patent applications were published in OJ 1-2/1993, 59. In relation to the drawings, the particular requirements are dealt with in Chapter X. The latter Chapter should, however, also be consulted with regard to the other documents mentioned, as the comments therein on the provisions of Rule 49 are of general application. Here, attention

need only be drawn to Rule 49(7) which states that "the lines of each sheet of the description and of the claims shall preferably be numbered in sets of five, the numbers appearing on the left side, to the right of the margin".

2.2 Replacement documents and translations

Rule 49(1)
Rule 50(1)

Replacement documents and translations in an official language of documents filed under the provisions of Art. 14(2) or Rule 40(3) are subject to the same requirements as the documents making up the application.

2.3 Other documents

Rule 50(2)

Documents other than those referred to in the previous paragraphs should be typewritten or printed with a margin of about 2.5 cm on the left-hand side of each page.

2.4 Number of copies

Documents relating to more than one application or patent (e.g. a general authorisation), or having to be communicated to more than one party, only need to be filed in one copy. However, letters accompanying submitted documents (in particular Form 1038) must be filed in one copy for each file to which the document they accompany relates.

For example, where two different applications share a common priority claim, the applicant only needs to file one copy of the priority document, but this must be accompanied by two different letters each relating to one or the other application (preferably two copies of Form 1038). Each letter (or Form 1038) must be duly signed and indicate one or the other of the two application numbers in respect of which the priority document is being filed (see also IX, 3.1).

2.5 Filing of subsequent documents

Rule 2(1)

After a European patent application has been filed, documents as referred to in Rule 50 may be filed by delivery by hand or by post or, with the exception of authorisations and priority documents, may be filed by fax at the EPO's filing offices (see II, 1.2). Such documents may not be filed on diskette, by teleteX, by e-mail, telegram, telex or similar means (see also the Notice dated 12 September 2000 concerning correspondence with the Office via e-mail, OJ 10/2000, 458). If documents relating to European patent applications are filed by fax, written confirmation reproducing the contents of the documents filed by these means and complying with the requirements of the Implementing Regulations to the EPC must be supplied on invitation from the EPO within a period of two months. If the applicant fails to comply with this request in due time, the fax is deemed not to have been received (cf. the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.3).

Written confirmation is required if the documents so communicated are of inferior quality.

If in a fax a party avails himself of Art. 14(4), the subsequent copy must be filed in the same language as the fax, in which case the copy is deemed to have been received on the date of filing of the fax. The period under Rule 6(2) for filing the translation under Art. 14(4) begins on the day following the date of filing of the fax. *Art. 14(4)* *Rule 6(2)*

For the filing of subsequent documents in electronic form, either online or on electronic data carriers, see additionally II, 1.3, 2nd paragraph.

3. Signature of documents

3.1 Documents filed after filing the European patent application

All documents other than annexes filed after filing the European patent application must be signed by the person responsible. The principles of Art. 133 are that only the applicant or his representative may act in the European patent grant procedure. Documents filed after filing the European patent application may therefore be effectively signed only by these persons. *Rule 50(3)* *Art. 133*

Documents such as the priority document or the translation thereof must be accompanied by a separate letter or at least bear a note on the document itself that it is addressed to the EPO, duly signed by a person authorised to act before the EPO. This also applies, for example, to the designation of inventor if this has been signed by an applicant with neither residence nor principal place of business in one of the Contracting States to the EPC. As regards the authorisation, see IX, 1.5. The signature of the entitled person confirming performance of a written act of procedure helps to clarify the state of the proceedings. It shows whether the act of procedure has been validly performed, and also prevents circumvention of the provisions relating to representation. Form 1038 (Letter accompanying subsequently filed items) may also be used as a separate letter. A separate form must be used for each file (see the Notice from the EPO, OJ 1-2/1991, 64). The same applies when, instead of using Form 1038, the applicant submits an accompanying letter with the document in question (see also IX, 2.4). In the case of electronic filing, several documents for a file can be attached on a single Form 1038E.

If the signature is omitted on a document not falling within the meaning of IX, 3.2, the EPO must invite the party concerned to sign within a fixed time limit. This also applies if the document in question bears the signature of an unentitled person (e.g. the secretary of an authorised representative), a deficiency which for the purposes of the time limits under way is treated as equivalent to omission of the signature of an entitled person. If signed in due time, the document retains its original date of receipt; otherwise it is deemed not to have been received. Likewise, documents filed electronically must be signed by an entitled *Rule 50(3)*

person, although they may be transmitted using a smart card issued to another person. See also IX, 3.2 below.

3.2 Documents forming part of the European patent application

In addition to the documents referred to in IX, 3.1 above, certain documents forming part of the application must be signed. These documents include the request for grant, the designation of the inventor and, where applicable, the authorisation of a representative. In the case of electronic filing of a European patent application, a facsimile image of the signer's handwritten signature, a text-string signature or an enhanced electronic signature may be used to sign the aforementioned documents (Art. 7 of the Decision of the President of the EPO dated 26 February 2009, OJ EPO 3/2009, 182).

With the exception of the authorisation of a representative, the documents may be signed by an appointed representative instead of the applicant.

3.3 Form of signature

A rubber stamp impression of a party's name, whether a natural or legal person, must be accompanied by a personal signature. Initials or other abbreviated forms will not be accepted as a signature. Where the party concerned is a legal person, a document may in general be signed by any person who purports to sign on behalf of that legal person. The entitlement of a person signing on behalf of a legal person is not checked by the EPO, except where there is reason to believe that the person signing is not authorised and in that case evidence of authority to sign should be called for.

Where a document is filed by fax, the reproduction on the facsimile of the signature of the person filing the document will be considered sufficient. The name and position of that person must be clear from the signature (cf. Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.3).

3.4 Joint applicants

Rule 151(1)

If there is more than one applicant (see IX, 1.3), each applicant or his representative must sign the request for grant and, where applicable, the appointment of the common representative. This also applies if one of the applicants is considered the common representative pursuant to Rule 151(1), first sentence. However, the common representative may sign the designation of inventor and all documents filed after the filing of the application pursuant to Rule 50(3). Authorisations on behalf of more than one applicant must be signed by all applicants.

Chapter X

Drawings

This Chapter of the Guidelines deals with the requirements to be met by drawings contained in the application or patent. However, it should be noted that the comments on the provisions of Rule 49 apply generally to the documents making up the European patent application and documents replacing them.

Rule 49
Rule 50

1. Graphic forms of presentation considered as drawings

1.1 Technical drawings

All types of technical drawings are considered drawings within the meaning of the EPC; these include, for instance, perspectives, exploded views, sections and cross-sections, details on a different scale, etc. Drawings also cover "flow sheets and diagrams", under which are subsumed functional diagrams and graphic representations of a given phenomenon which express the relationship between two or more magnitudes.

Rule 46(3)

There are also other graphic forms of presentation which may be included in the description, claims or abstract, in which case they are not subject to the same requirements as drawings. The forms concerned are chemical and mathematical formulae and tables. These are dealt with in X, 11. They may nevertheless be submitted as drawings, in which case they are subject to the same requirements as drawings.

Rule 49(9)

1.2 Photographs

The EPC makes no express provision for photographs; they are nevertheless allowed where it is impossible to present in a drawing what is to be shown and provided that they are in black and white, directly reproducible and fulfil the applicable requirements for drawings (e.g. paper size, margins, etc.). Colour photographs are not accepted.

2. Representation of drawings

2.1 Grouping of drawings

All drawings must be grouped together on the sheets specifically for drawings and may in no event be included in the description, claims or abstract, even if these finish at the top of a page or leave sufficient room, and even if there is only one figure.

Rule 49(9)

2.2 Reproducibility of drawings

In accordance with Rule 49(2) the drawings must be so presented as to admit of electronic as well as of direct reproduction by scanning, photography, electrostatic processes, photo offset and micro-filming, in an unlimited number of copies.

Rule 49(2)

2.3 Figure accompanying the abstract

As regards the figure, or exceptionally figures, to accompany the abstract, where a European patent application contains drawings, reference should be made to III, 10.3 and B-XI, 3(vi) and 4. The figure(s) illustrating the abstract must be the figure(s) most representative of the invention and must be chosen from the drawings accompanying the application. It is therefore not permissible to draw a special figure for the abstract which differs from the other figures in the application.

3. Conditions regarding the paper used

Rule 49(3) Drawings must be on sheets of A4 paper (29.7 cm x 21 cm) which must be pliable, strong, white, smooth, matt and durable (recommended paper weight: 80-120 g/m^2, see OJ 1-2/1994, 74).

Rule 49(2) All sheets must be free from cracks, creases and folds. Only one side of the sheet may be used. The use of card is not allowed.

Rule 49(12) Each sheet must be reasonably free from erasures and must be free from alterations. Non-compliance with this rule may be authorised if the authenticity of the content is not in question and the requirements for good reproduction are not in jeopardy.

Any corrections made must be durable and permanent, so that they cannot give rise to any doubt. They must be made on all copies of the application. Special products for corrections, such as white masking fluid, may be used, provided they are indelible and comply with the other requirements under Rule 49(12).

Rule 49(4) The sheets must be connected in such a way that they can easily be turned over, separated and joined together again.

Permanent fastenings (for example, crimped eyelets) are not permitted. Only temporary fastenings (staples, paper clips and grips, etc.), which leave only slight marks in the margin, may be used.

4. Presentation of the sheets of drawings

4.1 Usable surface area of sheets

Rule 46(1) On sheets containing drawings, the usable surface area may not exceed 26.2 cm x 17 cm. These sheets may not contain frames round the usable or used surface. The minimum margins are as follows: top side: 2.5 cm; left side: 2.5 cm; right side: 1.5 cm; bottom: 1 cm.

4.2 Numbering of sheets of drawings

Rule 49(6) All the sheets contained in the European patent application must be numbered in consecutive Arabic numerals. These must be centred at the top of the sheet, but not in the top margin.

Rule 46(1) The sheets of drawings must be numbered within the maximum usable surface area as defined in Rule 46(1). Instead of numbering the sheet

in the middle, it will, however, be acceptable for it to be numbered towards the right-hand side if the drawing comes too close to the middle of the edge of the usable surface. This numbering should be clear, for example in numbers larger than those used for reference numbers.

Rule 49(6) requires all application sheets to be numbered consecutively. According to Rule 49(4), the application consists of all the following documents: the request, the description, the claims, the drawings and the abstract. The numbering should preferably be effected by using three separate series of numbering each beginning with one, the first series applying to the request only and being already printed on the form to be used, the second series commencing with the first sheet of the description and continuing through the claims until the last sheet of the abstract, and the third series being applicable only to the sheets of the drawings and commencing with the first sheet of such drawings. *Rule 49(4)*

There are no objections to including the description, claims and drawings in one series of numbering beginning with one. The series of numbering must then commence with the first sheet of the description.

5. General layout of drawings

The various figures on the same sheet of drawings must be laid out according to certain requirements as to page-setting and numbering, and figures divided into several parts must comply with particular requirements.

5.1 Page-setting

As far as possible all figures of the drawings should be set out upright on the sheets. If a figure is broader than it is high, it may be set out so that the top and bottom of the figure lie along the sides of the sheet with the top of the figure on the left side of the sheet. *Rule 46(2)(h)*

In this case, if other figures are drawn on the same sheet, they should be set out in the same way, so that all the figures on a single sheet lie along parallel axes.

Where the sheet has to be turned in order to read the figures, the numbering should appear on the right-hand side of the sheet.

5.2 Numbering of figures

The different figures must be numbered consecutively in Arabic numerals, independently of the numbering of the sheets. *Rule 46(2)(h)*

This numbering should be preceded by the abbreviation "FIG", whatever the official language of the application. Where a single figure is sufficient to illustrate the invention, it should not be numbered and the abbreviation "FIG" must not appear. Rule 46(2)(d) also applies to numbers and letters identifying the figures, i.e. they must be simple and clear and may not be used in association with brackets, circles, or *Rule 46(2)(d)*

inverted commas. They should also be larger than the numbers used for reference signs.

An exception to Rule 46(2)(h) referred to above may be permitted only as regards partial figures intended to form one whole figure, irrespective of whether they appear on one or several sheets. In this case the whole figure may be identified by the same number followed by a capital letter (e.g. FIG 7A, FIG 7B).

5.3 Whole figure

Rule 46(2)(h)

Where figures drawn on two or more sheets are intended to form one whole figure, the figures on the several sheets shall be so arranged that the whole figure can be assembled without concealing any part of the partial figures.

Partial figures drawn on separate sheets must always be capable of being linked edge to edge, that is to say no figure may contain parts of another.

The case may arise where the parts of a whole figure are drawn on a single sheet following a layout different from that of the whole figure, e.g. a very long figure divided into several parts placed one above the other and not next to one another on a sheet. This practice is permitted. However, the relationship between the different figures must be clear and unambiguous. It is therefore recommended that a scaled-down figure be included showing the whole formed by the partial figures and indicating the positions of the sections shown.

6. Prohibited matter

Rule 48(1) and (2)

The provisions as to the omission of prohibited matter within the meaning of Rule 48(1)(a) (see III, 8.1 and C-II, 7.2) also apply to drawings.

Rule 48(1)(c)

Statements or other matter of the type referred to under Rule 48(1)(c) (see C-II, 7.4) which are likely to appear in drawings are in particular various kinds of advertising, e.g. where the applicant includes in the drawing obvious business or departmental markings or a reference to an industrial design or model, whether registered or not. By doing so, matter would be introduced which is clearly irrelevant or unnecessary, which is expressly prohibited by Rule 48.

7. Executing of drawings

7.1 Drawings of lines and strokes

Rule 46(2)(a)
Rule 49(2)

Rule 46(2)(a) sets certain standards for lines and strokes in the drawing, to permit satisfactory reproduction by the various means described in Rule 49(2).

The drawings must be executed in black.

Heliographic prints seldom satisfy the requirements for drawings and it is therefore strongly advised that copies of this type should not be filed.

In all cases the thickness of the lines and strokes must take into account the scale, nature, execution and perfect legibility of the drawing and of the reproductions.

All lines must be drawn with the aid of drafting instruments save those for which no instrument exists, e.g. irregular diagrams and structures. *Rule 46(2)(e)*

7.2 Shading

The use of shading in figures is allowed provided this assists in their understanding and is not so extensive as to impede legibility.

7.3 Cross-sections

7.3.1 Sectional diagrams

Where the figure is a cross-section on another figure, the latter should indicate the position and may indicate the viewing direction.

Each sectional figure should be capable of being quickly identified, especially where several cross-sections are made on the same figure, e.g. by inscribing the words "Section on AB", or to avoid the use of lettering, by marking each end of the cross-section line on the diagram with a single Roman numeral. This number will be the same as the (Arabic) numeral identifying the figure where the section is illustrated. For example: "Figure 22 illustrates a section taken along the line XXII-XXII of Figure 21".

7.3.2 Hatching

A cross-section must be set out and drawn in the same manner as a normal view whose parts in cross-section are hatched with regularly spaced strokes, the space between strokes being chosen on the basis of the total area to be hatched. *Rule 46(2)(b)*

Hatching should not impede the clear reading of the reference signs and leading lines. Consequently, if it is not possible to place references outside the hatched area, the hatching may be broken off wherever references are inserted. Certain types of hatching may be given a specific meaning.

7.4 Scale of drawings

If the scale of the figure is such that all the essential details would not be clearly distinguished if the figure is reproduced, electronically or photographically, with a linear reduction in size to two-thirds, then the figure must be redrawn to a larger scale, and if necessary the figure should be split up into partial figures so that a linear reduction in size to two-thirds is still intelligible. *Rule 46(2)(c)*

The graphic representation of the scale of drawings in cases where its inclusion is considered useful must be such that it is still usable when

the drawing is reproduced in reduced format. This excludes indications of size such as "actual size" or "scale ½", both on the drawings and in the description, in favour of graphic representations of the scale.

7.5 Numbers, letters and reference signs

Rule 46(2)(d) Numbers, letters and reference signs and any other data given on the sheets of drawings, such as the numbering of figures, pages of the drawing, acceptable text matter, graduations on scales, etc., must be simple and clear, and not used in association with any brackets, inverted commas, circles or outlines whatsoever. Signs such as 6' and 35" are not regarded as including inverted commas and are therefore permitted.

Numbers, letters and reference signs should preferably all be laid out the same way up as the diagram so as to avoid having to rotate the page.

7.5.1 Leading lines

Leading lines are lines between reference signs and the details referred to. Such lines may be straight or curved and should be as short as possible. They must originate in the immediate proximity of the reference sign and extend at least as far as the features indicated.

Rule 46(2)(a) Leading lines must be executed in the same way as lines in the drawing, viz. in accordance with Rule 46(2)(a).

7.5.2 Arrows

Arrows may be used at the end of the leading lines provided that their meaning is clear. They may indicate a number of points:

(i) a freestanding arrow indicates the entire section towards which it points;

(ii) an arrow touching a line indicates the surface shown by the line looking along the direction of the arrow.

7.5.3 Height of the numbers and letters in the drawings

Rule 46(2)(g) Under Rule 46(2)(g), a minimum size of 0.32 cm is required for all numbers and letters used on the drawings so that their reduction in size to two-thirds remains easily legible.

The Latin alphabet should normally be used for letters. The Greek alphabet is to be accepted however where it is customarily used, e.g. to indicate angles, wavelengths, etc.

7.5.4 Consistent use of reference signs as between description, claims and drawings

Rule 46(2)(i) Reference signs not mentioned in the description and claims may not appear in the drawing, and vice versa.

Reference signs appearing in the drawing must be given in the description and the claims taken as a whole. As regards use of these signs in the claims, reference should be made to C-III, 4.19

Features of a drawing should not be designated by a reference in cases where the feature itself has not been described. This situation may arise as a result of amendments to the description involving the deletion of pages or whole paragraphs. One solution would be to strike out on the drawing reference signs which have been deleted in the description. Such corrections would have to be made in accordance with Rule 49(12). *Rule 49(12)*

Where for any reason a figure is deleted then of course the applicant or proprietor ought to delete all reference signs relating solely to that figure appearing in the description and claims.

In the case of applications dealing with complex subjects and incorporating a large number of drawings, a reference key may be attached to the end of the description. This key may take whatever form is appropriate and contain all the reference signs together with the designation of the features which they indicate. This method could have the advantage of standardising the terminology used in the description.

7.5.5 Consistent use of reference signs as between drawings

The same features, when denoted by reference signs, must, throughout the application, be denoted by the same signs. *Rule 46(2)(i)*

There would be considerable confusion if a single feature were allocated different reference signs in the various drawings. However, where several variants of an invention are described, each with reference to a particular figure, and where each variant contains features whose function is the same or basically the same, the features may, if this is indicated in the description, be identified by reference numbers made up of the number of the figure to which it relates followed by the number of the feature, which is the same for all variants, so that a single number is formed, e.g. the common feature "15" would be indicated by "115" in Fig. 1 while the corresponding feature would be indicated by "215" in Fig. 2.This system has the advantage that an individual feature and the figure on which it is to be considered can be indicated at the same time. It can also make complex cases involving many pages of drawings easier to read. Instead of the common reference sign being prefixed by the number of a figure, it may, when the individual variants are described with reference to particular groups of figures, be prefixed by the number of the particular variant to which it relates; this should be explained in the description.

7.6 Variations in proportions

Rule 46(2)(f)

Elements of the same figure must be in proportion to each other, unless a difference in proportion is indispensable for the clarity of the figure.

As a preferred alternative to a difference in proportion within one figure for the purpose of achieving the necessary clarity, a supplementary figure may be added giving a larger-scale illustration of the element of the initial figure. In such cases it is recommended that the enlarged element shown in the second figure be surrounded by a finely drawn or "dot-dash" circle in the first figure pinpointing its location without obscuring the figure.

8. Text matter on drawings

Rule 46(2)(d) and (g)

It should first be noted that Rule 46(2)(d) and (g) also applies to text matter on the drawings.

For indications of the type "section on AB", see X, 7.3.1.

Rule 46(2)(j)

The drawings must not contain text matter, except, when absolutely indispensable, a single word or a few words.

Where text matter is deemed indispensable for understanding the drawing, a minimum of words should be used, and a space free of all lines of drawings should be left around them for the translation.

As regards the justification for text matter on drawings, see C-II, 5.1.

9. Conventional symbols

Rule 49(10)

Known devices may be illustrated by symbols which have a universally recognised conventional meaning, provided no further detail is essential for understanding the subject-matter of the invention. Other signs and symbols may be used on condition that they are not likely to be confused with existing conventional symbols, that they are readily identifiable, i.e. simple, and providing that they are clearly explained in the text of the description.

Different types of hatching may also have different conventional meanings as regards the nature of a material seen in cross-section.

10. Amendments to drawings

Amendments of the drawings are permitted, as well as of the other documents. These amendments may be made at the request of the party concerned or at the request of the EPO. The amendments may concern either clerical errors or more substantial changes.

Amendments to drawings are, in general, subject to the same rules as apply in respect of amendments to other application documents and therefore do not require further analysis here. Reference may be made to III, 16; V, 2; B-XII, 9; C-VI, 3.3, 4.6, 4.7, 5, 5.7 and 5.7.1 to 5.7.4; and E-II.

The general rule governing the admissibility of amendments, which the examiner must always bear in mind, is that they must not extend the content of the application as filed, i.e. they must not have the effect of introducing new material. *Art. 123(2)*

If drawings which depart substantially from the physical requirements laid down in the Rules are filed in order to establish a particular date of filing or retain a priority date, the Receiving Section will permit such drawings to be amended or replaced so as to provide drawings complying with the Rules, provided that it is clear that no new material is thereby introduced into the application. In view of this proviso, applicants should take care that any "informal" drawings which they file clearly show all the features necessary to illustrate the invention.

11. Graphic forms of presentation not considered as drawings

11.1 Chemical and mathematical formulae

Chemical or mathematical formulae may be written by hand or drawn if necessary, but it is recommended that appropriate aids such as stencils or transfers be used. For practical reasons, formulae may be grouped together on one or more sheets annexed to the description and paginated with it. It is recommended in such cases that each formula be designated by a reference sign and the description should contain references to these formulae whenever necessary. *Rule 49(8)*

The chemical or mathematical formulae must employ symbols in general use and must be drawn in such a way that they are completely unambiguous. Figures, letters and signs which are not typed must be legible and identical in form in the various formulae, irrespective of the document in which they appear. *Rule 49(11)*

Chemical or mathematical formulae appearing in the text of the application or patent must have symbols, the capital letters of which are at least 0.21 cm high. Where they appear on sheets of drawings, these symbols must be at least 0.32 cm high. *Rule 49(8)* *Rule 46(2)(g)*

All mathematical symbols used in a formula which appears in a description, in an annex or on sheets of drawings must be explained in the description, unless their significance is clear from the context. In any case, the mathematical symbols used may be collated in a list.

11.2 Tables

11.2.1 Tables in the description

For the sake of convenience, the tables may also be grouped together in one or more sheets annexed to the description and paginated with it. *Rule 49(9)*

If two or more tables are necessary, each should be identified by a Roman number, independently of the pagination of the description or drawings or of the figure numbering, or by a capital letter, or by a title indicating its contents, or by some other means.

Each line or column in a table must begin with an entry explaining what it represents and, if necessary, the units used.

Rule 49(5) and (8)

It should be remembered that the characters must satisfy the requirements of Rule 49(8) and that Rule 49(5) regarding the maximum usable surface areas of sheets applies to tables as well.

11.2.2 Tables in the claims

Rule 49(9)

The claims may include tables if this is desirable in view of the subject-matter involved. In this case, the tables must be included in the text of the relevant claim; they may not be annexed to the claims nor may reference be made to tables contained in or annexed to the description. Rule 43(6) stipulates that the claims may refer to other application documents only where this is absolutely necessary (see C-III, 4.17). The mere desire to eliminate the need to prepare further copies does not constitute absolute necessity.

Chapter XI

Fees

1. General

Various fees have to be paid for a European patent application, renewing a European patent and obtaining legal remedies. Fees may also need to be paid by third parties, such as for applications to inspect the files of European patent applications or European patents. Fees may be validly paid by any person (see Legal Advice No. 6/91 rev., OJ 11/1991, 573). The amounts of the fees, the ways in which they are to be paid and the date of payment are determined in the Rules relating to Fees (RFees). Guidance for the payment of fees, costs and prices with information about:

– the current version of the Rules relating to Fees and the schedule of fees;

– important implementing rules to the Rules relating to Fees;

– the payment and refund of fees and costs;

– other notices concerning fees and prices; and

– international applications, including Euro-PCT applications entering the European phase,

as well as the amounts of the principal fees for European and international applications and an extract from the Rules relating to Fees is published at regular intervals in the Official Journal. A list of bank accounts opened in the name of the European Patent Organisation for payment appears each month on the inside back cover.

The EPC and the Implementing Regulations thereto lay down the time limits for paying fees and the legal consequences of non-compliance with the time limits. The time limits for payment and the legal consequences of non-payment are dealt with in the Chapters of the Guidelines covering the respective stages of the procedure. The methods of payment, the date on which payment is considered to be made, due dates, particulars concerning the purpose of payments and reimbursement of fees are all dealt with below.

2. Methods of payment

Fees may be paid in the following ways: *Art. 5 RFees*

(i) by payment or transfer to a bank account held by the EPO;

(ii) by debiting a deposit account opened in the records of the EPO in Munich (see XI, 4.2 and 4.3).

Payment by cheque delivered or sent directly to the EPO was abolished with effect from 1 April 2008 (OJ 11/2007, 533 and OJ 11/2007, 626).

Neither the PCT, nor the EPC allows for payment of any fee due by way of compensation (offset) with any fee to be refunded.

By way of exception, certain fees and costs at the Munich Information Office, namely for photocopies made by the EPO staff or by the requester in the course of file inspection or for purchases of patent information products, other copies of EPO documents and publications, may also be paid by credit card (Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, M.4).

3. Currencies

Art. 5 RFees
Point 3 ADA

The fees due to the EPO shall be paid in euro. A debit order shall be in euro.

4. Date considered as date on which payment is made

4.1 Payment or transfer to a bank account held by the European Patent Organisation

Art. 7(1), (3) and (4) RFees

The date on which the amount is actually entered in the European Patent Organisation's bank account is considered as the date on which payment is made. It is therefore also possible for the day following the inpayment or transfer to be considered as the date on which payment is made or an even later date in the event of delays within the bank. However, payment may still be considered to have been made in due time, despite being paid late, if the inpayment or transfer has been effected before expiry of the time limit for payment in a Contracting State and, where appropriate, a surcharge has been paid (see XI, 6).

4.2 Deposit accounts with the EPO

4.2.1 General remarks

Art. 7(2) RFees

The Arrangements for deposit accounts (hereinafter abbreviated to "ADA") and their annexes were published as Supplement No. 1 to OJ 3/2009. A distinction must be drawn, in connection with deposit accounts, between:

Point 4 ADA

(i) payments to replenish deposit accounts; and

Point 6 ADA

(ii) payments of fees or of expenses for publications or services of the EPO by debiting the deposit account.

4.2.2 Inpayments to replenish a deposit account

Points 3 and 4 ADA

Inpayments to replenish a deposit account are to be made in euro. Payments in a different currency will only be accepted if freely convertible. Payments must be made to an EPO bank account. However, the deposit account will always be credited in euro (the only

currency in which these accounts are kept) after conversion at the current rate of exchange.

4.2.3 Debiting the deposit account

The debit order must be clear, unambiguous and unconditional. It must contain particulars necessary to identify the purpose of the payment, including the amount of each fee or expense concerned, and must indicate the number of the account which is to be debited. The Boards of Appeal have decided that a debit order must be carried out notwithstanding incorrect information given in it if the intention of the person giving the order is clear (see T 152/82, OJ 7/1984, 301). Debiting occurs in principle on the basis of a written debit order signed by the account holder. The various ways in which a debit order may be filed, including online and fax filing, are given in point 6.2 ADA. Paper confirmation is not required.

Points 6.2 and 6.3 ADA

4.2.4 Date of receipt of the debit order; insufficient funds

Provided that there is a sufficient amount in the deposit account on the date of receipt of the debit order by the EPO, that date will be considered as the date on which the payment is made. This is also applicable where a debit order is filed together with an application under point 6.9 or point 6.12 ADA with a competent national authority of a Contracting State. If the debit order is not received at the EPO until after expiry of the period allowed for payment of fees which can be paid on filing, that period is deemed to have been observed if evidence is available or presented to the EPO to show that the debit order was filed with the competent authority of the Contracting State at the same time as the application, provided that sufficient funds were available in the account at the time the period expired.

Points 6.3, 6.9, 6.10 and Point 6.12 ADA

If on the date of receipt of a debit order, the account does not contain sufficient funds to cover the total fee payments indicated for an application (shortfall), the debit order is not carried out for it and the account holder is informed accordingly by the Treasury and Accounts Department of the EPO. By replenishing the account and paying an administrative fee, the holder can ensure that the date of receipt of the debit order is deemed to be the date on which payment was effected. The administrative fee is 30% of the shortfall. The Arrangements for deposit accounts further fix a maximum and a minimum amount for this administrative fee.

Points 6.4, 6.5 and 6.6 ADA

4.3 Automatic debiting procedure

A deposit account may also be debited on the basis of an automatic debit order signed by or on behalf of the account holder (automatic debiting procedure). Such an order may only be filed on behalf of the applicant or the patent proprietor or his representative and extends to all types of fees covered by the automatic debiting procedure and payable by him in respect of the proceedings specified in the automatic debit order. As the proceedings progress, each such fee is automatically debited and treated as having been paid in due time. The automatic debit order may not be restricted to specific types of fees.

Point 8 ADA

The Arrangements for the automatic debiting procedure (abbreviated to "AAD") plus explanatory notes are published as Annexes A.1 and A.2 to the ADA in Supplement No. 1 to OJ 3/2009.

5. Due date for fees

5.1 General

5.1.1 Due date

Art. 4(1) RFees
Rule 51(1), 2nd sentence

In the EPC, the term "due date" has a special meaning, namely the first day on which payment of a fee may be validly effected, not the last day of a period for such payment (see XI, 6 "Payment in due time"). The due date for fees is generally laid down by provisions of the EPC or of the PCT. If no due date is specified, the fee is due on the date of receipt of the request for the service incurring the fee concerned. A fee may not be validly paid before the due date. The only exception to that principle is with renewal fees, which may be validly paid up to three months before the due date (see XI, 5.2.4).

Payments made before the due date which are not valid may be refunded by the EPO. If payment is made shortly before the due date, it is possible that the EPO will not return the payment. In this case, however, payment only takes effect on the due date. See XI, 5.2.4 regarding renewal fees for a European patent application.

5.1.2 Amount of the fee

When the fees are generally increased, the date of payment is set as the relevant date for determining the amount of the fees (cf. Art. 2 of the Decision of the Administrative Council dated 5 June 1992, OJ 7/1992, 344). Setting the date of payment as the relevant date makes it unnecessary as a rule to ascertain the actual due date for determining the amount of the fee. Fees cannot validly be paid before the due date (with the exception of renewal fees – see XI, 5.1.1). Thus, for example, the fee for grant and publishing cannot be validly paid in advance before notification of the communication under Rule 71(3).

5.2 Due date for specific fees

5.2.1 Filing fee, search fee, designation fee

The filing, search and designation fees are due on the day the European patent application is filed. For the additional fee payable as part of the filing fee, see A-III, 13.2.

5.2.2 Examination fee

The examination fee is due when the request for examination is filed. Since the latter is contained in the prescribed form for the request for grant (Form 1001), the examination fee may be paid straight away on the date of filing of the European patent application if the application is filed with said prescribed Form 1001. It may be paid up to expiry of the period laid down in Rule 70(1).

5.2.3 Fee for grant and publishing

The fee for grant and publishing fall due on notification of the communication under Rule 71(3) requesting that this fee be paid. Under Rule 71(6), the same applies for claims fees, unless they were already paid under Rule 45(1) and (2) or Rule 162(1) and (2).

5.2.4 Renewal fees

Rule 51(1) and (2)

Renewal fees for a European patent application in respect of the coming year are due on the last day of the month containing the anniversary of the date of filing of the European patent application. Renewal fees may not be validly paid more than three months before they fall due. Renewal fee payments which are not valid will be refunded by the EPO. If payment is made only shortly before the permissible prepayment period, the EPO may elect not to return the payment. In this case, however, payment only takes effect on the first day of the permissible prepayment period. If the renewal fee has not been paid on or before the due date, it may be validly paid within six months of the said date, provided that the additional fee is paid within this period. For the calculation of the additional period, see J 4/91, OJ 8/1992, 402. Whilst the applicant's attention is drawn to this possibility, he may not invoke the omission of such notification (see J 12/84, OJ 4/1985, 108, and J 1/89, OJ 1-2/1992, 17). See also Legal Advice No. 5/93 rev., OJ 4/1993, 229, for Euro-PCT applications. For renewal fees for European divisional applications see IV, 1.4.3.

The obligation to pay renewal fees terminates with the payment of the renewal fee due in respect of the year in which the mention of the grant of the European patent is published (Art. 86(2); see OJ 6/1984, 272).

5.2.5 Claims fees

Claims fees are due upon the filing of the first set of claims, which may be the date of filing or which may occur later (see III, 9 and 15).

5.2.6 Fees for limitation/revocation, opposition, appeal, petition for review

All of these fees are due on the date that the document in question is filed (request for limitation, request for revocation, notice of opposition, notice of appeal and petition for review).

6. Payment in due time

6.1 Basic principle

A fee is considered to have been paid in due time if the date of payment (see XI, 4) fell on or before the last day of the relevant time limit – or the time limit extended pursuant to Rule 134.

6.2 Ten-day fail-safe arrangement

6.2.1 Requirements

Art. 7(3) and (4) RFees

If the payer provides evidence to the EPO that within the period in which the payment should have been made in an EPC Contracting State:

(i) he effected payment through a banking establishment; or

(ii) he duly gave an order to a banking establishment to transfer the amount of the payment; or

Point 6.8 ADA

(iii) he despatched at a post office a letter bearing the address of one of the filing offices (see II, 1.1) of the EPO containing the debit order, provided that there is a sufficient amount in the account on the date on which the time limit expires,

then he is considered to have observed the period for payment, even if the payment is entered in the bank account of the European Patent Organisation after the expiry of the period or if a debit order despatched to the EPO is received there after the expiry of the period.

Art. 7(3)(b) and (4) RFees
Point 6.8(b) ADA

However, if, in such a case, the payment has been effected later than 10 days before expiry of the period for payment, but still within that period, a surcharge of 10% on the relevant fee or fees, but not exceeding EUR 150, must be paid in order for the period for payment to be considered observed.

6.2.2 Application of the ten-day fail-safe arrangement to replenishment of deposit account

Point 5.2 ADA

The ten-day fail-safe arrangement under Art. 7(3), (a) and (b), second half sentence RFees applies mutatis mutandis to payments to replenish deposit accounts. If one of the steps referred to under XI, 6.2.1(i) and (ii) is carried out in order to replenish a deposit account, then for the purpose of complying with time limits for payment by issuing debit orders, the account is considered to have been replenished on the tenth day after one of those steps was taken. For the application of the administrative fee, see A-XI, 4.2.4.

6.2.3 Debit orders

Points 6.9 ADA, Point 6.10 and Point 6.12 ADA

For debit orders accompanying applications filed with a competent national authority, see XI, 4.2.4.

6.2.4 Payment of fee at the normal fee rate

Where a fee can either be paid within a normal period at the normal fee rate or within the period for further processing with the requisite further processing fee, if the normal period for payment is considered to have been observed when applying the ten-day fail-safe arrangement, the above-mentioned further processing fee need not be paid.

6.2.5 Amount of fee payable

As noted in XI, 5.1.2, the amount of fee payable is always that applying on the date of payment (see also the transitional provisions in the Administrative Council decisions revising fees). The payer cannot therefore in this respect seek to rely on the ten-day fail-safe arrangement in order to benefit from an old amount, arguing that he gave instructions for payment before the entry into force of the new amount of fee (see J 18/85, OJ 8/1987, 356); Art. 7(3) and (4) RFees protects the applicant in the event of late payment from the legal consequences of expiry of the payment period, but not from the obligation to make up any differences resulting from an increase in the amount of fee in the meantime.

6.2.6 Noting of loss of rights

Rule 112

If an applicant who has been sent a communication under Rule 112(1) noting non-compliance with a time limit for payment claims that the payment was made in due time pursuant to Art. 7(1), (3) and (4) RFees and points 5.2, 6.5, 6.8 or 6.10 of the Arrangements for deposit accounts, he must apply for a decision pursuant to Rule 112(2) and submit the requisite evidence.

7. Purpose of payment

7.1 General

7.1.1 Condition for valid payment

An essential condition for a valid payment to the EPO in the case of payment or transfer to a bank account held by the European Patent Organisation is that the amount is entered in that account. The payment is valid in respect of the amount entered. If an insufficient amount has been paid by mistake, it is not possible to rectify the error by having the shortfall paid subsequently deemed to be paid on the original date of payment. Payment is a matter of fact whereby a certain amount is transferred to and put at the disposal of the EPO. It is not, therefore, a procedural declaration which may be corrected pursuant to Rule 139. The same applies to debit orders (see T 170/83, OJ 12/1984, 605, reasons 8). Therefore, time limits for payment are in principle deemed to have been observed only if the full amount of the fee has been paid in due time. However, the EPO may, where this is considered justified, overlook any small amounts lacking without prejudice to the rights of the person making the payment (Art. 8(1) RFees).

7.1.2 Purpose of payment

Art. 6 RFees

A distinction must be drawn between these conditions for valid payment and the indication of the purpose of the payment. Indication of the purpose of the payment serves to identify the proceedings for which the fee is intended (e.g. for fee payments, the application number) and the specific type of fee. If the purpose of the payments cannot immediately be established, the person making the payment will be requested to communicate the purpose in writing within a

specified period. If he complies with this request in due time, the payment and the original payment date remain valid. This is also the case when the clarification involves re-assigning the payment to another application. Otherwise the payment will be considered not to have been made. The Boards of Appeal have decided that if the purpose of the payment has evidently been given incorrectly, this deficiency is not prejudicial if the intended purpose can be established without difficulty from the remaining information. The inadvertent use of a fee by the EPO for a different purpose from that evidently intended by the person making the payment has no effect on the purpose intended by that person (see J 16/84, OJ 12/1985, 357). Similarly, a debit order must be carried out notwithstanding incorrect information given in it if the intention of the person giving the order is clear. Instructions to carry out the order must be given by the EPO department qualified to recognise what is clearly intended (see T 152/82, OJ 7/1984, 301).

In the case of changes to the purpose of payment not arising from Art. 6(2) RFees, the date of payment is the date of receipt of the request for the change.

7.2 Indication of the purpose of the payment in the case of designation fees

Art. 2, No. 3, RFees, old version

The following applies only to applications filed before 1 April 2009.

Art. 6(1) RFees

The designation fees are deemed paid for all Contracting States upon payment of seven times the amount of one designation fee. Such payments simply need to be marked "designation fees" in order for the purpose of the payment to be established. If fewer than seven designation fees are paid and the payment agrees with the declaration in the appropriate section of the Request for Grant form (Form 1001), payment should once again simply be marked "designation fees". However, if the payment differs from the intended payment as stated in the request form, the Contracting States for which the payment is now intended should be indicated with the payment.

If there is no such indication and the amount paid is insufficient to cover all the Contracting States mentioned in the appropriate section of the request form, the procedure under III, 11.3.7 applies.

If an automatic debit order has been issued (see the appropriate sections of Form 1001), the applicant must inform the EPO prior to expiry of the basic period under Rule 39(1) if he wishes to pay designation fees for Contracting States other than those indicated in the request form. If not, an amount equal to seven times the amount of one designation fee or the designation fees for the Contracting States indicated in the request form is debited.

The same applies where Form 1200 is used for entry into the European phase of a Euro-PCT application, if the application enters the regional phase before 1 April 2009.

7.3 Indication of the purpose of payment in the case of claims fees

7.3.1 Claims fees payable on filing the European patent application

If the applicant pays the claims fees for all the claims incurring fees, the indication "claims fees" suffices to identify the purpose of the payment. If the amount paid is insufficient to cover all the claims fees, the procedure under III, 9 applies. *Rule 45(1)*

7.3.2 Claims fees payable before the grant of the European patent

In the communication under Rule 71(6), the applicant may be requested to pay claims fees due before grant of the European patent. If the applicant fails to pay the fee for all the claims in due time, the application is deemed to be withdrawn (Rule 71(7)). *Rule 71(6)*

8. No deferred payment of fees, no legal aid, no discretion

The EPC makes no provision for deferring payment of fees (see J 2/78, OJ 6-7/1979, 283, reasons 3, German text only) or for granting legal aid. An indigent party still has the possibility of applying for legal aid from the competent national authority. However, the time limit for payment is not extended in such a case; a party claiming national legal aid must make the corresponding arrangements as early as possible so that he is in a position to pay the fee in due time. The EPO has also no discretion in waiving or refunding, without any legal basis, fees that have become due (see J 20/87, OJ 3/1989, 67).

9. Reduction of fees

9.1 General

The EPC provides in certain cases for the reduction of the filing fee, examination fee, opposition fee, fee for appeal, limitation or revocation fee and fee for petition for review. The reduction is fixed in the Rules relating to Fees as a percentage of the fee.

Where a fee is reduced – in contrast to cases of fee refunds – the reduced rate may be paid instead of the full fee. The factual conditions for a reduction of the fee must be met on or before the day the period for payment expires.

9.2 Reduction under the language arrangements

9.2.1 Conditions

European applications can be filed in any language. If filed in a language other than an official language of the EPO, a translation must be furnished. Consequently, the languages which can be used for filing European applications fall into three categories: *Art. 14(2)*

(i) official languages of the EPO

(ii) official languages of Contracting States which are not official languages of the EPO, such as Dutch, Italian or Spanish (hereinafter "admissible non-EPO languages"), and

(iii) all other languages, such as Chinese, Japanese or Russian.

Art. 14(4)

Furthermore, documents which have to be filed within a time limit may also be filed in an "admissible non-EPO language" if the applicant has his residence or principal place of business within the territory of a Contracting State having this as an official language or if the applicant is a national of such a Contracting State. See VIII, 1.1 and 1.2.

Rule 6(3)
Art. 14(1) RFees

Subject to certain conditions, where an admissible non-EPO language is used, a reduction in fees (20%) is allowed. It serves to compensate the parties for the disadvantages that result from the fact that not all official languages of the Contracting States are official languages of the EPO. The conditions to be fulfilled for the grant of a reduction in fees vary for each procedural step for which a reduction is claimed (see G 6/91, OJ 9/1992, 491).

The reduction is only allowed if the translation into an EPO official language is filed in due time, that is to say at the earliest at the same time as when the European patent application or the document subject to a time limit is filed in the admissible non-EPO language (see G 6/91, OJ 9/1992, 491).

9.2.2 Reduction of the filing fee

According to G 6/91 (OJ 9/1992, 491), the entitlement to the fee reduction only exists if the essential element of the act in question is filed in the admissible non-EPO language. In the case of the filing of the European application, the presence of a description is necessary for the accordance of a date of filing (Rule 40(1)(c)), but claims are no longer required for this. According to J 4/88 (OJ 12/1989, 483), only the description and claims needed to be in this language to qualify for the fee reduction (not the Request for grant for example). However, since claims are no longer required for a date of filing, the essential element is now the description.

Consequently, the filing fee is reduced if the European patent application (i.e. at least the description) is filed in an admissible non-EPO language (i.e. an official language of a Contracting State which is not an official language of the EPO). The reduction only applies when the application is filed by a resident or national of a Contracting State having this language as an official language. For example, a national and resident of Mexico filing a European application in Spanish does not qualify for a fee reduction, nor does an applicant filing in Japanese, regardless of his nationality or residence.

Where the application is filed by reference to a previously filed application (see II, 4.1.3.1), and the previously filed application referred to, is in an admissible non-EPO language and the applicant

satisfies the residency and/or nationality criteria mentioned above, then the applicant is also entitled to the reduction in the filing fee. For the purposes of the reduction, it does not matter whether or not the applicant requested that the claims of the previously filed application take the place of the claims in the application as filed (see above).

Since the additional fee which is payable if the application comprises more than thirty-five pages forms part of the filing fee, the reduction applies also to it.

9.2.3 Reduction of the examination fee

Art. 14(4)
Rule 6(3)

The applicant will be allowed a reduction in the examination fee if the request for examination is filed in an admissible non-EPO language and a translation of the request for examination in an EPO official language is also filed. For the reduction to be allowed, the request for examination in the admissible non-EPO language may already be filed as part of the request for grant (Form 1001), since the form already contains a pre-printed box for the request for examination in the official languages of the EPO and the request for examination in the admissible non-EPO language can be entered in the box provided for the request for examination. Alternatively, for the reduction to be allowed, the request for examination in the admissible non-EPO language and the translation of the request may be filed later, namely up to the date of payment of the examination fee, provided that the translation is filed no earlier than simultaneously with the request (see J 21/98, OJ 8-9/2000, 406, and G 6/91, OJ 9/1992, 491). In order to benefit from the reduction, it is not necessary to file subsequent additional documents for the examination proceedings in an admissible non-EPO language.

For the case where a reduction in the examination fee for the above reasons coincides with a reduced examination fee because the EPO drew up the international preliminary examination report, see XI, 9.3.2.

9.2.4 Reduction of the opposition fee

Art. 14(4)
Rule 6(3)

The opposition fee is reduced if the notice of opposition including the written reasoned statement of grounds is filed in an admissible non-EPO language as well as in an EPO official language in translation (see T 290/90, OJ 7/1992, 368). If, during the opposition procedure only, an opponent files a document that has to be filed within a time limit in an admissible non-EPO language, he is not given a reduction in the fees.

9.2.5 Reduction of the appeal fee

Art. 14(4)
Rule 6(3)

A reduction in the appeal fee is allowed if the notice of appeal is filed in an admissible non-EPO language as well as in an EPO official language in translation. The grant of a reduction does not depend on the subsequent filing of the statement setting out the grounds of appeal in an admissible non-EPO language.

9.2.6 Reduction of the fee for limitation and revocation

Art. 14(4)
Rule 6(3)

A reduction in the fee for limitation and the fee for revocation is allowed if the request for limitation or revocation is filed in an admissible non-EPO language as well as in an EPO official language in translation. In order to qualify for the reduction, the applicant must file the items referred to in Rule 92(2)(a), (b), (c) and (e) in the admissible non-EPO language.

9.2.7 Reduction of the fee for the petition for review

Art. 14(4)
Rule 6(3)

A reduction of the fee for the petition for review is allowed if the petition for review is filed in an admissible non-EPO language as well as in an EPO official language in translation. In order to qualify for the reduction, the applicant must file the item referred to in Rule 107(2) in the admissible non-EPO language

9.3 Special reductions

9.3.1 Reduction of the search fee for a supplementary European search

Art. 153(7)

The search fee for a supplementary European search report is reduced for PCT applications for which the Patent Office of the USA, Japan, China, Australia, Russia or Korea was the International Searching Authority. In these cases, the supplementary search fee is reduced by a fixed amount (see OJ 11/2005, 548).

The search fee for a supplementary European search report is also reduced by a fixed amount for PCT applications for which the Patent Office of Austria, Finland, Spain or Sweden or the Nordic Patent Institute was the International Searching Authority (cf. OJ EPO 12/2007, 642 and OJ EPO 1/2008, 12).

PCT applications for which the Patent Office of Canada was the International Searching Authority do not qualify for any reduction in the supplementary search fee (see OJ 3/2006, 192 and OJ 11/2005, 577).

9.3.2 Reduction of the examination fee where the international preliminary examination report is being drawn up by the EPO

Art. 14(2) RFees

Where the EPO has drawn up the international preliminary examination report in respect of an international application, the examination fee is reduced by 50% if the EPO is the designated Office (elected Office).

If the conditions for a reduction under the language arrangements (see XI, 9.2.3) are also fulfilled, the examination fee is first reduced by 50%, then by a further 20%, i.e. the total reduction is 60% of the full fee.

9.3.3 Reduction of the fees for the international search and international preliminary examination of an international application

The fees for the international search and preliminary examination of an international application are reduced by 75% if the application is filed by a natural person who is a national and a resident of a state which is not an EPC Contracting State and which, on the date of filing of the application or of the demand, is listed as a low-income or lower-middle-income economy by the World Bank (OJ EPO 11/2008, 521).

10. Refund of fees

10.1 General remarks

10.1.1 Fee payments lacking a legal basis

There are two conditions for a fee payment to be fully valid:

(i) the payment must relate to proceedings that are pending; and

(ii) the date of payment (see XI, 4) must be on or after the due date (see XI, 5.1.1).

If a payment does not relate to a pending European patent application (e.g. it relates to a patent application already deemed to have been withdrawn), there is no legal basis for the payment; the amount paid must be refunded.

If the payment is made before or on the due date and if, no later than that date, the legal basis ceases to exist (e.g. because the patent application is deemed to be withdrawn or is withdrawn), the amount paid is to be refunded. This also applies to renewal fees validly paid before the due date (Rule 51(1), second sentence).

10.1.2 Fee payments which are not valid

If fees have not been validly paid they must be refunded. Examples: filing fee, search fee, designation fee or examination fee paid late, as laid down under the provisions relating to further processing (Art. 121 and Rule 135), without the further processing fee required by Rule 135(1) and Art. 2, No. 12 RFees. Fees paid on or after the due date are refunded only if there is a particular reason for a refund (see XI, 10.2).

10.1.3 Insignificant amounts

Where the sum paid is larger than the fee, the excess will not be refunded if the amount is insignificant and the party concerned has not expressly requested a refund. It has been decided that any amount up to EUR 10 constitutes an insignificant amount (Art. 1 of the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, M.3).

Art. 12 RFees

10.2 Special refunds

10.2.1 Refund of the search fee

Art. 9 RFees

The search fee for a European or supplementary European search is refunded in cases provided for in Art. 9 RFees and in the Decision of the President of the EPO dated 22 December 2008, OJ 2/2009, 96, which applies to European patent applications in respect of which the European or supplementary European search is completed on or after 1 April 2009. Details on criteria for refund of search fees are given in the Notice from the EPO dated 9 January 2009, OJ 2/2009, 99.

10.2.2 Refund of the further search fee

Rule 64(2)

If an applicant, following a communication from the Search Division, has paid a further search fee but the Examining Division, at the applicant's request, has found that there was no justification for charging the further search fee, the latter will be repaid.

10.2.3 Refund of the international search fee

Rule 16.2 and 16.3 PCT
Rule 41 PCT

The international search fee will be refunded in the cases specified in Rules 16.2, 16.3 and 41 PCT and in Annex C of the Agreement between the European Patent Organisation and the International Bureau of the World Intellectual Property Organization (WIPO) under the PCT (OJ 11/2007, 617). Following amendment of the provisions set out in Annex C, Part II(3) of the above mentioned agreement, any refund of the international search fee paid for an international application filed on or after 1 January 2004 will be granted to the extent set out in the Notice from the President of the EPO dated 14 July 2007, Special edition No. 3, OJ EPO 2007, N.3 for international applications for which the international search is completed before 1 April 2009, and in the Decision of the President of the EPO dated 22 December 2008, OJ 2/2009, 114 for international applications for which the international search is completed on or after 1 April 2009. Details on the criteria for the refund of international search fees are given in the Notice from the EPO dated 9 January 2009, OJ 2/2009, 99.

10.2.4 Refund of the examination fee

Art. 11 RFees

The examination fee will be refunded in the situations described in Art. 11 RFees (see VI, 2.2, 3rd paragraph, and 2.5).

If an international application and a European application are consolidated in accordance with the conditions laid down by Legal Advice No. 10/92 rev., OJ 11/1992, 662, the examination fee paid in respect of the European patent application will be refunded in full if the request for consolidation was made before the Examining Division had taken responsibility for both applications or at a rate of 75% if the Examining Division had already taken responsibility for both applications but had not yet begun substantive examination of the second application when consolidation was requested. This also applies where there has been an international preliminary examination under Chapter II PCT.

10.2.5 Refund of the international preliminary examination fee

For international applications filed on or after 1 January 2004 the EPO has discontinued the rationalised international preliminary examination procedure (OJ 11/2001, 539). Consequently, no request for ''detailed'' examination will be required, and the fee refund for the rationalised procedure is no longer available.

10.2.6 Refund pursuant to Rule 37(2)

Rule 37(2)

If a European patent application filed with a competent national authority is deemed to be withdrawn pursuant to Art. 77(3), all fees, in particular the filing, search and designation fees and any claims fees paid, will be refunded.

10.2.7 Refund of claims fees and of the fee for grant and publishing

Art. 97(1)
Rule 71(5)

The fee for grant and publishing will be refunded if the European patent application is withdrawn before communication of the decision to grant. If it is withdrawn after communication of the decision to grant, the fee for publishing cannot be refunded as it is part of the fee for grant. If, following a communication under Rule 71(5), the application is refused, withdrawn or deemed to be withdrawn, the fee for grant and publishing and any claims fees paid under Rule 71(6), are refunded.

10.3 Method of refund

If the person to whom the refund is payable holds a deposit account with the EPO, the refund may take the form of crediting that deposit account. If the payer wishes any refund to be made to a deposit account, he can give the number of the account in the space provided in the Request for Grant form. Otherwise refunds will be made by means of a cheque.

10.4 Person to whom refund is payable

Fees will be refunded to the party concerned. However, if the party's representative is authorised to receive payments, the refund will be made to the representative. A refund will not be made to a third party who paid the fee (see Legal Advice No. 6/91 rev., points 4 and 5, OJ 11/1991, 573).

10.5 Re-allocation instead of refund

If a party files a written request, the payment may be re-allocated instead of being refunded. The date of receipt of the re-allocation instructions is then considered to be the date of payment for the new purpose of payment.

Chapter XII

Inspection of files; communication of information contained in files; consultation of the Register of European Patents; issuance of certified copies

1. General

Provision is made for inspection of files and communication to the public of information contained in files. This applies to the files of European patent applications and European patents. *Art. 128*

For international (PCT) applications, see E-IX, 5.8 and 6.4.

The provisions governing inspection of files are contained in Art. 128 and Rules 144 and 145, those for communication of information in Rule 146. *Rule 144, Rule 145 Rule 146*

The fee for inspection of files and the fee for communication of information contained in files are laid down by the President pursuant to Art. 3(1) RFees and are regularly published in the Official Journal. *Art. 3(1) RFees*

2. Inspection of files

2.1 Extent of file inspection

Inspection of the files of European patent applications and of European patents is granted in respect of the original documents or of copies thereof or, if the files are stored on other media, in respect of these media. All parts of the file compiled when conducting the examination, opposition and appeal procedure with the parties are open for inspection. It also includes the search opinion if applicable. *Rule 145(1) Rule 147(2)*

Observations by third parties (Art. 115) are an integral part of the files and as such are open to inspection in accordance with Art. 128. If a third party asks that his observations or a part thereof be treated confidentially, that request cannot be granted and the third party will be notified accordingly.

The parts of the file excluded from inspection are: *Art. 128(4)*

(i) the documents relating to the exclusion of or objections to members of the Boards of Appeal or of the Enlarged Board of Appeal; *Rule 144(a)*

(ii) draft decisions and opinions, and all other documents, used for the preparation of decisions and opinions, which are not communicated to the parties; *Rule 144(b)*

Rule 144(c)

(iii) the designation of the inventor if he has waived his right to be mentioned as inventor under Rule 20(1);

Rule 144(d)

(iv) any other document excluded from inspection by the President of the EPO on the ground that such inspection would not serve the purpose of informing the public about the European patent application or the resulting patent. These documents include documents relating to file inspection and requests for accelerated search and accelerated examination under the "PACE" programme (if submitted using EPO Form 1005 or in a separate document) (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, J.3);

Art. 38(1) PCT
Rule 94 PCT

(v) subject to Rules 94.2 and 94.3 PCT, the files of the international preliminary examination for a Euro-PCT application in respect of which the EPO is the international preliminary examining authority and for which an international preliminary examination report has not yet been established (see OJ 7/2003, 382; see also E-IX, 5.8 and 6.4).

The parts of the file excluded from inspection are kept separate in the files from those open to inspection.

2.2 Procedure for file inspection

Rule 145(2)

The President of the EPO determines all file inspection arrangements, including the circumstances in which an administrative fee is payable (see the Decisions of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, J.2).

Files that are available in electronic form can be inspected free of charge online via the Register Plus online service (see also the above mentioned Decision of the President of the EPO).

Other forms of file inspection, e.g. by furnishing paper copies, are available on request. No particular form is prescribed for the request, except that it must be filed in writing with the EPO at one of its filing offices. The EPO offers a form via its website on the Internet. The request should contain information about the payment of the fee. Requests filed by fax (see IX, 2.5) or submitted through the Internet will be processed without confirmation.

Rule 145(2)

A fee, if any, falls due when the request is received. The method of payment and date on which payment is deemed to have been made are dealt with in the Rules relating to Fees (see XI). Where the administrative fee has been duly paid, it will not be refunded.

2.3 Restrictions to file inspection

Subsequent to the publication of the European patent application any person may inspect and obtain information from the files. Inspection of files and communication of information are subject to the restrictions laid down in Rule 144 (see XII, 2.1). If it is decided that certain papers marked "confidential" are not to be excluded from file inspection under Rule 144, they are returned to the sender (see T 516/89, OJ 8/1992, 436).

Art. 128(4)
Rule 146
Rule 145
Rule 144

2.4 Confidentiality of the request

Correspondence from the proceedings relating to the inspection of files conducted between the EPO and the person requesting the inspection is filed in the non-public part of the file. The EPO does not provide the applicant with any information about the proceedings relating to the inspection of files (see, however, XII, 2.5, third paragraph).

2.5 File inspection before publication of the application

Until such time as the European patent application is published, the files may be inspected only by the applicant or with his consent. Secure File Inspection, which is available via My.epoline® allows the applicant to inspect online the public part of the files relating to his own as yet unpublished application (see Notice from the EPO dated 9 December 2003, OJ 1/2004, 61). If a third party requests file inspection without at the same time submitting the applicant's consent, the EPO will not release the files until the applicant's approval has been presented.

Art. 128(1)

However, prior to publication of the European patent application, any person who can prove that the applicant has invoked his rights under the application against him may also inspect the files. The rights under a European patent application are also deemed to have been invoked where rights under a first filing in a Contracting State have been invoked and the subsequent European application is mentioned at the same time (see J 14/91, OJ 8/1993, 479). If such proof is not furnished together with the request, the EPO will invite the requester within a specified period to supply proof. If he fails to do so in due time, the request will be refused.

Art. 128(2)

In case of a request for inspection of the files under Art. 128(2), the applicant is entitled to notification of the identity of the person making the request. Professional representatives requesting inspection of the files on behalf of a third party pursuant to Art. 128(2) must accordingly give the third party's name and address and file an authorisation.

A decision on a request for inspection of the files pursuant to Art. 128(2) is only taken once the applicant has been heard. If the applicant objects and provides grounds for his belief that the requirements under Art. 128(2) are not met within the period set by the EPO, a decision will be delivered. This decision is subject to appeal.

Art. 128(3)

Prior to publication of a European divisional application the file of this divisional application may only be inspected in the cases described in Art. 128(1) and (2). This also applies where the parent application has already been published. However, where a European divisional application or a new European patent application filed under Art. 61(1)(b) is published, the files of the earlier application may be inspected prior to the publication of that earlier application and without the consent of the relevant applicant.

2.6 Publication of bibliographic data before publication of the application

Art. 128(5)

The EPO has not hitherto availed itself of the power under Art. 128(5) to publish bibliographic data before the European patent application is published.

3. Communication of information from the files

Rule 146

Subject to the restrictions provided for in Art. 128(1) to (4) and Rule 144, the EPO may, upon request, communicate information concerning any file of a European patent application or European patent. This may be subject to the payment of an administrative fee.

However, the EPO may require the exercise of the option to obtain inspection of the file itself, should it deem this to be appropriate in view of the quantity of information to be supplied.

Correspondence from the proceedings relating to the communication of information conducted between the EPO and the person requesting the information is filed in the part of the file which is not accessible to the public. The EPO does not provide the applicant with any information about the proceedings relating to the communication of information.

4. Consultation of the European Patent Register

Art. 127
Rule 143

The European Patent Register, containing the particulars specified in Rule 143, may be consulted in order to ascertain the state of the proceedings and the legal status of patent rights. Entries are made in the European Patent Register up to expiry of the period of opposition or the termination of opposition proceedings. Where applicable, the date and purport of any decision taken in revocation or limitation proceedings (Art. 105b(2)) and/or on a petition for review (Art. 112a) are also included (Rule 143(1)(x) and (y)). The correction of the designation of the inventor, may be made at any time. The Online European Patent Register via the Internet (www.epoline®.org) can be accessed free of charge. Apart from the data entered in the European Patent Register, the Online Register includes additional application and procedural data not published in the European Patent Bulletin. Register data may also be obtained by telephone from the Information Offices in Munich, The Hague, Berlin or Vienna.

5. Certified copies

The EPO will issue on request a certified copy of the European patent application or European patent specification, of other documents from the files of European applications and patents, provided that the conditions for file inspection (Art. 128(1) to (4)) are fulfilled and, where necessary, an administrative fee has been paid.

Costs incurred in preparing the copies certified will be charged to the requester.

If it is indicated, when the request is filed, that the cost should be debited from the requester's deposit account, the amount of the invoice will be charged to the deposit account.

6. Priority documents issued by the EPO

Rule 54

Any priority document (i.e. the certified copy of the European application together with the certificate stating the date of filing thereof) will only be issued to the (original) applicant or his successor in title. In the case of applications filed in a language other than an official language of the EPO (Art. 14(2)), the priority document relates to the application as originally filed, not to the translation in one of the official languages of the EPO.

The President of the EPO determines all necessary arrangements, including the form of the priority document and the circumstances in which an administrative fee is payable.

Part B

Guidelines for Search

Contents

Chapter I – Introduction **I-1**

1.	Purpose of Part B	I-1
2.	Search Division	I-1
3.	Search work	I-1
4.	The Extended European Search Report (EESR)	I-1

Chapter II – General **II-1**

1.	Search and substantive examination	II-1
2.	Objective of the search	II-1
3.	Search documentation	II-1
4.	Search report	II-1
4.1	European searches	II-1
4.2	Additional European searches	II-2
4.3	Supplementary European searches	II-2
4.4	International (PCT) searches	II-4
4.5	International-type searches	II-4
4.6	Searches on national applications	II-4

Chapter III – Characteristics of the search **III-1**

1.	The objective of the search	III-1
1.1	Opinions in relation to the search report	III-1
1.2	Opinions on matters relating to the limitation of the search	III-1
2.	Scope of the search	III-1
2.1	Completeness of the search	III-1
2.2	Effectiveness and efficiency of the search	III-2
2.3	Special documents to be consulted	III-2
2.4	Search in analogous fields	III-3
2.5	Search on the internet	III-3
3.	The subject of the search	III-3
3.1	Basis for the search	III-3
3.2	Interpretation of claims	III-3
3.3	Amended claims	III-4
3.4	Abandonment of claims	III-4
3.5	Anticipation of amendments to claims	III-5
3.6	Broad claims	III-5
3.7	Independent and dependent claims	III-5
3.8	Search on dependent claims	III-6
3.9	Combination of elements in a claim	III-6
3.10	Different categories	III-7
3.11	Subject-matter excluded from search	III-7
3.12	Lack of unity	III-7

3.13	Technological background	III-7

Chapter IV – Search procedure and strategy **IV-1**

1.	Procedure prior to searching	IV-1
1.1	Analysis of the application	IV-1
1.2	Formal deficiencies	IV-1
1.3	Documents cited in the application	IV-2
1.4	Abstract; official classification; title of the invention; publication	IV-3
2.	Search strategy	IV-3
2.1	Subject of the search; restrictions	IV-3
2.2	Formulating a search strategy	IV-4
2.3	Carrying out the search; types of documents	IV-4
2.4	Reformulation of the subject of the search	IV-6
2.5	Closest prior art and its effects on the search	IV-6
2.6	End of search	IV-7
3.	Procedure after searching	IV-7
3.1	Preparation of the search report	IV-7
3.2	Documents discovered after completion of the search	IV-8
3.3	Errors in the search report	IV-8

Chapter V – Preclassification (routing) and official classification of European patent applications **V-1**

1.	Definitions	V-1
2.	Preclassification (routing)	V-1
3.	Incorrect preclassification	V-2
4.	Official classification of the application	V-2
5.	Classification of late-published search reports	V-3
6.	Classification when the scope of the invention is not clear (e.g. a partial search)	V-3
7.	Classification in cases of a lack of unity of invention	V-3
8.	Verification of official classification	V-3

Chapter VI – The state of the art **VI-1**

1.	General	VI-1
2.	State of the art – oral disclosure, etc.	VI-1
3.	Priority	VI-1
4.	Conflicting applications	VI-1
4.1	Potentially conflicting European and international applications	VI-1
4.2	National earlier rights	VI-1
5.	Date of reference for documents cited in the search report; filing and priority date	VI-2
5.1	Verification of claimed priority date(s)	VI-2
5.2	Intermediate documents	VI-2
5.3	Doubts as to the validity of the priority claim; extension of the search	VI-2

5.4	Documents published after the filing date	VI-3
5.5	Non-prejudicial disclosures	VI-4
6.	Contents of prior-art disclosures	VI-4
6.1	General remark	VI-4
6.2	Citation of documents corresponding to documents not available or not published in one of the official EPO languages	VI-4

Chapter VII – Unity of invention **VII-1**

1.	General remarks	VII-1
1.1	Partial European search report	VII-1
1.2	Invitation to pay further search fees	VII-1
1.3	Documents relevant only to other inventions	VII-1
2.	Procedures in cases of lack of unity	VII-2
2.1	Request for refund of further search fee(s)	VII-2
2.2	Decision with respect to unity of invention	VII-2
2.3	Complete search despite of lack of unity	VII-2
2.4	Supplementary European search	VII-2
3.	Lack of unity and Rule 62a or Rule 63	VII-2

Chapter VIII – Subject-matter to be excluded from the search **VIII-1**

1.	General remarks	VIII-1
2.	Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body	VIII-1
3.	No meaningful search possible	VIII-2
3.1	Invitation to indicate subject-matter for search	VIII-4
3.2	Reply to the invitation under Rule 63(1)	VIII-4
3.3	The content of the extended European search report (EESR)	VIII-5
3.4	Applications to which Rule 63 applies which also lack unity	VIII-5
4.	More than one independent claim per category (Rule 62a)	VIII-6
4.1	Invitation to indicate which independent claim to search	VIII-6
4.2	Reply to the invitation under Rule 62a(1)	VIII-6
4.3	The content of the extended European search report (EESR)	VIII-7
4.4	Cases under Rule 62a where claims fees are not paid	VIII-7
4.5	Applications to which Rule 62a applies which also lack unity	VIII-8
4.6	Treatment of dependent claims under Rule 62a	VIII-9
5.	Invitation under both Rule 62a(1) and Rule 63(1)	VIII-9

Chapter IX – Search documentation **IX-1**

1.	General	IX-1
1.1	Organisation and composition of the documentation available to the Search Divisions	IX-1

1.2	Systematic access systems	IX-1
1.3	Numerical lists	IX-1
2.	Patent documents arranged for systematic access	IX-2
2.1	PCT minimum documentation	IX-2
2.2	Other national patent documents	IX-2
2.3	Unpublished patent applications	IX-3
2.4	Search reports	IX-3
2.5	Arrangements for manual search	IX-3
2.6	Patent family system	IX-3
3.	Non-patent literature arranged for systematic access	IX-4
3.1	Periodicals, records, reports, books, etc.	IX-4
3.2	Arrangements for manual search	IX-5
4.	Non-patent literature arranged for library-type access	IX-5
4.1	Composition	IX-5
4.2	Arrangement and location	IX-5
5.	Search documentation at the various EPO sites	IX-6
5.1	Electronic search documentation	IX-6
5.2	Search documentation in paper form	IX-6
6.	Search documentation in national offices carrying out transferred searches on behalf of the EPO	IX-6
6.1	Electronic search documentation provided by the EPO	IX-6
6.2	Additional search documentation in national patent offices	IX-6

Chapter X – Search report **X-1**

1.	General	X-1
2.	Different types of search reports drawn up by the EPO	X-2
3.	Form and language of the search report	X-2
3.1	Form	X-2
3.2	Language	X-3
4.	Identification of the patent application and type of search report	X-3
5.	Classification of the patent application	X-3
6.	Areas of technology searched	X-4
7.	Title, abstract and figure(s) to be published with the abstract (as indicated on supplemental sheet A)	X-4
8.	Restriction of the subject of the search	X-5
9.	Documents noted in the search	X-6
9.1	Identification of documents in the search report	X-6
9.1.1	Bibliographic elements	X-6
9.1.2	"Corresponding documents"	X-6
9.1.3	Languages of the documents cited	X-9
9.1.4	Supplementary European search report	X-9

9.2	Categories of documents (X, Y, P, A, D, etc.)	X-9
9.3	Relationship between documents and claims	X-12
10.	Authentication and dates	X-12
11.	Copies to be attached to the search report	X-12
11.1	General remarks	X-12
11.2	Electronic version of document cited	X-13
11.3	Patent family members; the "&" sign	X-13
11.4	Reviews or books	X-13
11.5	Summaries, extracts or abstracts	X-13
12.	Transmittal of the search report and search opinion (if applicable)	X-14

Chapter XI – The abstract **XI-1**

1.	Purpose of the abstract	XI-1
2.	Definitive content	XI-1
3.	Content of the abstract	XI-1
4.	Figure accompanying the abstract	XI-2
5.	Checklist	XI-2
6.	Transmittal of the abstract to the applicant	XI-2

Chapter XI – Annex Checklist for considering the abstract (see XI, 5) **XI-3**

Chapter XII – The search opinion **XII-1**

1.	Search opinion is part of the EESR	XII-1
1.1	The search opinion	XII-1
1.2	Position of the Examining Division	XII-1
2.	Basis of the search opinion	XII-1
2.1	Applications containing missing parts of description and/or drawings filed under Rule 56 EPC or Rule 20 PCT	XII-2
2.2	Applications containing claims filed after the accorded date of filing	XII-3
3.	Analysis of the application and content of the search opinion	XII-3
3.1	The examiner's dossier	XII-4
3.2	Reasoned objections	XII-4
3.3	Comments and amendments in response to the search opinion	XII-4
3.4	Extent of first analysis	XII-4
3.5	Contribution to the known art	XII-5
3.6	EPC requirements	XII-5
3.7	Examiner's approach	XII-5
3.8	Making suggestions	XII-6
3.9	Positive opinion	XII-6
4.	Priority claim and the search opinion	XII-6
5.	Matters of doubt in the state of the art	XII-7
6.	Unity in relation to the search opinion	XII-7

7.	The search opinion in cases of a limitation of the search	XII-8
8.	No search opinion is issued	XII-8
9.	Reaction to the extended European search report (EESR)	XII-9

Chapter I

Introduction

1. Purpose of Part B

Part B was drafted for, and applies to, European searches, i.e. searches performed by the EPO for European applications. In addition to these searches the Search Divisions of the EPO are called upon to carry out other types of searches (see II, 4). Searches in the context of the Patent Co-operation Treaty (PCT) are dealt with in the PCT Search and Examination Guidelines.

2. Search Division

Art. 17
Art. 18

The unit within the EPO responsible for carrying out the search and drawing up the search report for an application is a Search Division, which consists normally of one examiner. The examiner responsible for the search on a European application is also normally the first member of the Examining Division for that application. Where the invention is of a nature requiring searching in widely dispersed specialised fields, a special Search Division consisting of two, or possibly three, examiners may be formed, for example, where the "person skilled in the art" in the technical field of the application consists of more than one person (see C-IV, 11.3).

In this Part B, the term "examiner" is used to mean the examiner entrusted with the search within the Search Division which is responsible for drawing up the search report and the search opinion (see XII).

3. Search work

Art. 17
Prot. Centr. I(1) and (3)
Prot. Centr. IV(2)
Prot. Centr. V

European searches are carried out by the Search Divisions of the EPO and may also be entrusted to the central industrial property offices of certain Contracting States. Searches in documents in languages other than the official languages of the EPO may be entrusted to certain of these offices. These guidelines apply to European searches carried out in all these places.

4. The Extended European Search Report (EESR)

Art. 92
Rule 61
Rule 62

The Extended European Search Report (EESR) consists of two components, the European search report (see X) and the search opinion (see XII).

Chapter II

General

1. Search and substantive examination

The procedure through which a European patent application proceeds from the filing of the application to the grant of a patent (or the refusal of the application) comprises two separated basic stages, i.e. the search and substantive examination.

Art. 17
Art. 18

2. Objective of the search

The objective of the search is to discover the state of the art which is relevant for the purpose of determining whether, and if so to what extent, the invention to which the application relates is new and involves an inventive step.

Rule 61(1)

The examination procedure and the preparation of the search opinion depend on the search for the knowledge of the state of the art on which assessment of the patentability of the invention is based. The search must, therefore, be as complete and effective as possible, within the limitations necessarily imposed by issues such as unity of invention and other considerations (see III, 2, VII and VIII).

3. Search documentation

The search is carried out in in-house or external collections of documents or databases, the contents of which are systematically accessible, e.g. by means of words, classification symbols or indexing codes. These are primarily patent documents of various countries, supplemented by a number of articles from periodicals and other non-patent literature (see Chapter IX).

4. Search report

A search report is prepared containing the results of the search, in particular by identifying the documents constituting the relevant state of the art (see X, 9).

Art. 92
Rule 61(1)

The search report serves to provide information on the relevant state of the art to the applicant, to the Examining Divisions of the EPO and, by means of its publication, to the public.

Art. 92
Art. 93(1)

The search report is accompanied by the search opinion (see XII, subject to the exceptions mentioned in XII, 8), which together with the European search report constitutes the Extended European Search Report (EESR).

4.1 European searches

The task of the Search Division is primarily to carry out searches and draw up search reports in relation to European patent applications. In

Art. 17

addition to these usual searches, the Search Divisions of the EPO may be called upon to perform various other types of searches, which are listed in the following paragraphs.

4.2 Additional European searches

At the examination stage of a European patent application an additional search may be necessary. The reasons for such an additional search may be, for example:

(i) amendment of claims so that they embrace matter not covered by the original search (see, however, C-III, 7.10, for claims not searched because of lack of unity and C-III, 7.10.1, for amendments introducing subject-matter from the description resulting in claims defining subject-matter which is not linked by a single general inventive concept to the subject-matter originally searched);

Rule 63
Art. 17(2) PCT

(ii) removal by amendment or rebuttal, during substantive examination, of the deficiencies which resulted in the issuance of an incomplete search or a declaration taking the place of a search report under Rule 63, or a declaration under Art. 17(2)(a) or (b) PCT (see Chapter VIII and C-VI, 8.2);

Rule 64
Rule 62a

(iii) reversal, by the Examining Division, of an opinion of the Search Division with respect to novelty or lack of inventive step (see III, 1.1) or on other issues (see III, 1.2), in particular lack of unity of invention (see Chapter VII), exclusions from the search (see III, 3.11 and Chapter VIII) or Rule 62a; and

(iv) limitations or imperfections in the initial search.

The Examining Division makes use of documents found in such an additional search, where they are considered relevant to the examination of the application. Where a new document is used in the examination procedure, a copy must be communicated to the applicant (Art. 113(1)).

In a similar way, an additional search may become necessary during examination of oppositions against a European patent (see D-VI, 5).

4.3 Supplementary European searches

Art. 153(2), (6) and (7)

An international (PCT) application for which the EPO acts as designated Office or elected Office and which has been accorded an international date of filing is deemed to be a European patent application. Where an international (PCT) search report is already available, this will take the place of the European search report. The Search Division will draw up a supplementary European search report or a declaration replacing it according to Rule 63 unless provided otherwise in decisions of the Administrative Council.

However, the Administrative Council decides under what conditions and to what extent the supplementary European search report is to be dispensed with. The following decisions have been taken: *Art. 153(7)*

(i) a supplementary European search report is not drawn up for international applications for which the EPO was the International Searching Authority;

(ii) a supplementary European search report is not drawn up for international applications for which the Swedish, Austrian or Spanish Patent Office was the International Searching Authority and where the international application was filed before 1 July 2005 (OJ 1/1979, 4; OJ 2/1979, 50; OJ 6-7/1979, 248; OJ 8/1995, 511);

(iii) a supplementary European search report is drawn up and the search fee reduced (OJ 11/2005, 548) for international applications for which the patent office of the USA, Japan, China, Australia, Russia or Korea was the International Searching Authority;

(iv) a supplementary European search report is drawn up and the search fee reduced for international applications for which the Swedish, Austrian or Spanish Patent Office was the International Searching Authority and where the international application was filed on or after 1 July 2005 and also where the International Searching Authority was the patent office of Finland and the international application was filed on or after 1 April 2005 or where the Nordic Patent Institute was the International Searching Authority (see OJ EPO 7/2005, 422; OJ EPO 12/2007, 642; OJ EPO 1/2008, 12).

For the applications mentioned under (iii) and (iv), the supplementary European search is carried out in all the search documentation of the EPO. It is left to the Search Division's judgment whether a limitation as to the search documents is chosen. No precise limits can at present be set to these supplementary European searches since the documentation and search practice of these International Searching Authorities have not been fully harmonised in respect of the EPO. As a general rule, the EPO should avoid any superfluous work and duplication of work and should rely on the efficiency and quality of the international searches to the largest extent possible. The EPO as designated Office requests the International Searching Authority to supply, together with the international search report, copies of the documents cited therein (Art. 20(3) PCT, see also Rule 44.3(a) PCT). When documents are cited that are not in one of the official languages of the EPO and the Search Division needs a translation into one of these languages, it should provide this itself (e.g. a patent family member in an official language of the EPO or, alternatively, an abstract of the document in an official language of the EPO,

see VI, 6.2), unless it is able to obtain it from any other source, e.g. the applicant or the International Searching Authority.

Rule 159(1)(b)
Rule 161

The European grant procedure, including the supplementary European search, is to be based on the application documents as specified by the applicant when the application enters the European phase (Rule 159(1)(b)). Alternatively, if, within a non-extendable period of one month as from notification of a communication pursuant to Rule 161(2) (see A-VII, 7), the applicant has amended the application, the application as amended serves as the basis for the supplementary European search (see also XII, 2). For procedures relating to Euro-PCT applications where no supplementary European search report is prepared by the EPO, see C-VI, 3.5.1.

4.4 International (PCT) searches

For the search practice as regards international (PCT) searches, reference is made to the PCT International Search and Preliminary Examination Guidelines.

4.5 International-type searches

Under the PCT, the EPO, as an International Searching Authority, may be entrusted to carry out "international-type searches" for national patent applications (Art. 15(5) PCT). These searches are by definition similar to international searches, and the same considerations apply, except where unity of invention is lacking; the procedure is then brought into line with the European procedure. This means that in case of a lack of unity in a national application subject to an international-type search, the reasons for the lack of unity are not given and a written opinion of the International Searching Authority will not be issued (Rule 43bis PCT).

4.6 Searches on national applications

Prot. Centr. I(1)(b)

The Search Divisions of the EPO also carry out searches on national applications of certain of its Contracting States. These guidelines are not necessarily fully applicable to these national searches, nor are the ways in which these searches differ from European searches specifically pointed out. However, these national searches are to a large extent identical to, or compatible with, European searches.

Chapter III

Characteristics of the search

1. The objective of the search

1.1 Opinions in relation to the search report

Rule 61(1)

As stated in II, 2, the objective of the search is to discover the relevant state of the art for the purpose of assessing novelty and inventive step. Decisions on novelty and inventive step are the province of the Examining Divisions. However, in the search opinion (if applicable, see XII, 8), the Search Division gives the applicant a reasoned opinion on whether the application and the invention to which it relates meet the requirements of the EPC, to which he can reply in the examination procedure (Art. 113(1) and XII, 9). Opinions on patentability are also implicitly expressed in the search report by the assignment of document categories as defined in X, 9.2, and are subject to review by the Examining Division at the examination stage (see II, 4.2(iii) and XII, 1.2), in particular in the light of the applicant's reply thereto (see XII, 9).

The assessment of patentability at the search stage can have a direct bearing on the execution of the search itself, see: III, 3.8 (search for subject-matter of dependent claims), III, 2.4 (search in analogous technical fields) and IV, 2.6 (stopping the search when only trivial matter remains).

1.2 Opinions on matters relating to the limitation of the search

Occasionally matters of substantive examination other than novelty or inventive step have a direct bearing on the execution of the search and may result in a limitation thereof; here again these opinions are subject to review by the Examining Division (see T 178/84, OJ 5/1989, 157, and T 631/97, OJ 1/2001, 13 and II, 4.2(iii) and XII, 1.2), in particular in the light of the applicant's reply to the search opinion (see XII, 9).

Examples are to be found in chapter VII – Unity of invention and chapter VIII – Subject-matter to be excluded from the search.

2. Scope of the search

2.1 Completeness of the search

The European search is essentially a thorough, high-quality, all-embracing search. Nevertheless, it must be realised that in a search of this kind, 100% completeness cannot always be obtained, because of such factors as the inevitable imperfections of any information retrieval system and its implementation, and may not be economically justified if the cost is to be kept within reasonable bounds. The search should be carried out in such a manner as to reduce to a minimum the possibility of failing to discover complete

anticipations for any claims, or other highly relevant prior art. For less relevant prior art, which often exists with a fair amount of redundancy amongst the documents in the search collection, a lower recall ratio can be accepted (see in this context, however, III, 2.4). For limitations of the subject-matter searched by the EPO, see VIII.

The scope of the international search is defined in Art. 15(4) PCT stipulating that the International Searching Authority must endeavour to discover as much of the relevant prior art as its facilities permit and must, in any case, consult the documentation specified in the PCT Regulations (Rule 34 PCT). It follows from this definition ("as its facilities permit") that the scope of an international search shall be equivalent to a European search. International and European searches shall thus be fully compatible. In accordance therewith, if the EPO carried out the international search, no supplementary European search report need be drawn up and the international search report made by the EPO takes unconditionally the place of the European search report (Art. 153(6) EPC, OJ EPO 1979, 4, see also II, 4.3).

2.2 Effectiveness and efficiency of the search

The effectiveness and efficiency of any search for relevant documents (Rule 61(1)) depend on the degree of order which is available in, or which can be applied to, the collection of documents to be searched, the order allowing the examiner to determine sections of the documentation to be consulted. The basic components for creating order in a collection of documents are words, classification units, indexing codes or bibliographical links between documents by commonly cited documents. The order may have a permanent character, as with indexing words, classification symbols or indexing codes, or it may be created on demand by a search strategy judiciously using the above-mentioned basic components, the outcome of which is a section of the documentation which is likely to contain material pertinent to the invention. The examiner should for reasons of economy exercise his judgement, based on his knowledge of the technology in question and of the available information retrieval systems, to omit sections of the documentation in which the likelihood of finding any documents relevant to the search is negligible, for example documents falling within a period preceding the time when the area of technology in question began to develop. Similarly he need only consult one member of a patent family unless he has good reason to suppose that, in a particular case, there are relevant substantial differences in the content of different members of the same family (see IX, 2.6).

2.3 Special documents to be consulted

Certain categories of documents such as documents of the Scandinavian countries may be of special relevance to the European patent system, though they do not form part of the PCT minimum documentation. All these documents should be consulted for European searches, additional European searches and

international-type searches, and also for national searches unless specifically excluded in the agreement with the State concerned.

2.4 Search in analogous fields

The search is carried out in collections of documents or databases which may contain material in all those technical fields pertinent to the invention. The search strategy should determine the sections of the documentation to be consulted covering all directly relevant technical fields, and may then have to be extended to sections of the documentation covering analogous fields, but the need for this must be judged by the examiner in each individual case, taking into account the outcome of the search in the sections of the documentation initially consulted (see III, 3.2).

The question of which technical fields are, in any given case, to be regarded as analogous has to be considered in the light of what appears to be the essential technical contribution of the invention and not only the specific functions expressly indicated in the application.

The decision to extend the search to fields not mentioned in the application must be left to the judgement of the examiner, who should not put himself in the place of the inventor and try to imagine all the kinds of applications of the invention possible. The overriding principle in determining the extension of the search in analogous fields should be whether it is probable that a reasonable objection of lack of inventive step could be established on the basis of what is likely to be found by the search in these fields (see T 176/84, OJ 2/1986, 50, T 195/84, OJ 5/1986, 121 and C-IV, 11.8).

2.5 Search on the internet

The European search can also cover internet sources, including online technical journals, online databases or other websites. The extent of such internet searches depends on the individual case, but in some technical fields a systematic internet search will regularly be necessary. Especially in fields related to information or software technology, searches bypassing the internet will often not yield the most relevant prior art.

3. The subject of the search

3.1 Basis for the search

The search should be made on the basis of the claims, with due regard to the description and drawings (if any), (Art. 92). The claims determine the extent of the protection which will be conferred by the European patent if granted (Art. 69(1)).

Art. 92
Art. 69(1)
Rule 43(6)

3.2 Interpretation of claims

The search should on the one hand not be restricted to the literal wording of the claims, but on the other hand should not be broadened to include everything that might be derived by a person skilled in the art from a consideration of the description and drawings. The

Prot. Art. 69 EPC

objective of the search is to discover prior art which is relevant to novelty and/or inventive step (see II, 2). The search should be directed to what appear to be the essential features of the invention and take into account any changes in the (objective) technical problem underlying the invention which may occur during the search as a result of the retrieved prior art (see IV, 2.3 and 2.4 and C-IV, 11.5.2). In this regard it should be noted that although explicit references in the claims to features elucidated in the description are only permissible where "absolutely necessary" (Rule 43(6) – see also III, 3.5, and C-III, 4.17), claims containing such references should still be searched if these technical features are unambiguously defined by specific parts of the description.

When interpreting claims for the purpose of the search, the search will also take into consideration prior art incorporating technical features which are well known equivalents to the technical features of the claimed invention, which may undermine inventive step (see C-IV-Annex, 1.1(ii)).

3.3 Amended claims

Rule 137(1)
Rule 159(1)(b)
Rule 161

Where a European application does not derive from an earlier international application, the applicant may not amend the claims before receiving the European search report (Rule 137(1)). Consequently, in these cases, the search is directed to the claims as originally filed, in the European application, or to the set of claims filed according to Rule 57(c) or 58.

However, where a European application derives from an earlier international application, the applicant may have amended the international application in the international phase, either after receipt of the international search report (Art. 19(1) PCT) or during international preliminary examination (Art. 34(2)(b) PCT). The applicant may then specify that he wishes to enter the European phase with these or otherwise amended application documents (including claims) according to Rule 159(1)(b). Furthermore, the applicant is given the opportunity by the EPO to amend the application documents (including the claims) within a set time limit (Rule 161(2), see A-VII, 7). The application as amended serves as the basis for any supplementary European search which has to be performed pursuant to Art. 153(7) (see II, 4.3 and XII, 2).

3.4 Abandonment of claims

Rule 45(3)
Rule 162(4)

For European applications, claims that are deemed to have been abandoned for non-payment of fees must be excluded from the search. This applies both to searches to be carried out in respect of directly-filed European applications and to supplementary European searches to be carried out in respect of Euro-PCT applications entering the European phase (see II, 4.3).

3.5 Anticipation of amendments to claims

In principle, and insofar as possible and reasonable, the search should cover the entire subject-matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended (see, however, VII, 1.3, in case of lack of unity). For example, where an application relating to an electric circuit contains one or more claims only directed to the function and manner of operation, and the description and drawings include an example with a detailed non-trivial transistor circuit, the search should include this circuit.

3.6 Broad claims

Art. 83
Art. 84

No special search effort need be made for searching unduly wide or speculative claims, beyond the extent to which they relate to matter which is sufficiently disclosed in the application (Art. 83), and are supported by the description (Art. 84). If, for example, in an application relating to and describing in detail an automatic telephone exchange, the claims are directed to an automatic communication switching centre, the search should not be extended to automatic telegraph exchanges, data switching centres etc. merely because of the broad wording of the claim, but only if it is probable that such an extended search could produce a document on the basis of which a reasonable objection as regards lack of novelty or inventive step could be established. Likewise, if a claim is directed to a process for manufacturing an "impedance element" but the description and drawings relate only to the manufacture of a resistor element, and give no indication as to how other types of impedance element could be manufactured by the process of the invention, extension of the search to embrace, say, manufacture of capacitors would not normally be justified. If the main claim relates to the chemical treatment of a substrate, whereas it appears from the description or all the examples that the problem to be solved is solely dependent on the nature of natural leather, it is clear that the search should not be extended to the fields of plastics, fabrics or glass. Similarly, if the description and drawings are directed to a lock with a safety cylinder whereas the claims refer to a device allowing the indexation of the angular position of a first element with respect to two other rotating elements, then the search should be limited to locks. In exceptional cases where the lack of disclosure or support is such as to render a meaningful search over the **whole** of the scope of the claim(s) impossible, application of the procedure for an incomplete search or a declaration taking the place of a search report under Rule 63 may be appropriate (see VIII, 3).

3.7 Independent and dependent claims

Rule 43(4)

The search carried out in sections of the documentation to be consulted for the independent claim(s) must include all dependent claims (for cases not complying with Rule 43(2), see VIII, 4). Dependent claims should be interpreted as being restricted by all features of the claim(s) upon which they depend. Therefore, where the subject-matter of an independent claim is novel, that of its

dependent claims will also be novel. When the patentability of the subject-matter of the independent claim is not questioned as a result of the search, there is no need to make a further search or cite documents in respect of the subject-matter of the dependent claims as such (see, however, II, 4.2(iii) and XII, 1.2). For example, in an application relating to cathode ray oscilloscope tubes, in which the independent claim is directed to specific means along the edge of the front of the tube for illuminating the screen and a dependent claim is directed to a specific connection between the front and the main part of the tube, the examiner should, in the sections of the documentation he consults for searching the illumination means, also search for the connecting means whether in combination with the illumination means or not. If, after this search, the patentability of the illuminating means is not questioned, the examiner should not extend his search for the connecting means to further sections of the documentation which are likely to contain material pertinent to or specifically provided for these connections. If in an application dealing with a pharmaceutical composition for treating nail infections the patentability of the subject-matter of the independent claim relating to specific combinations of the active ingredients is not questioned as a result of the search, there is no need to continue the search for dependent claims dealing with the use of a specific volatile organic solvent as a carrier in the composition.

3.8 Search on dependent claims

However, where the patentability of the subject-matter of the independent claim is questioned, it may be necessary for assessing whether the subject-matter of the dependent claim as such is novel and involves an inventive step to continue the search in other sections of the documentation, e.g. in one or more additional classification units. No such special search should be made for features that are trivial or generally known in the art. However, if a handbook or other document showing that a feature is generally known can be found rapidly, it should be cited (see C-IV, 11.8(iii)). When the dependent claim adds a further feature (rather than providing more detail of an element figuring already in the independent claim), the dependent claim is to be considered in combination with the features in the independent claim and should be dealt with accordingly (see C-III, 3.4).

3.9 Combination of elements in a claim

For claims characterised by a combination of elements (e.g. A, B and C) the search should be directed towards the combination. However, when searching sections of the documentation for this purpose, sub-combinations, including the elements individually (e.g. A and B, A and C, B and C, and also A, B and C separately) should be searched in those sections at the same time. A search in additional sections of the documentation either for sub-combinations or for individual elements of the combination should only be performed if this is still necessary for establishing the novelty of the element in order to assess the inventive step of the combination.

3.10 Different categories

When the application contains claims of different categories, all these must be included in the search (for cases not complying with Rule 43(2), see VIII, 4). However, if a product claim clearly seems to be both new and non-obvious, the examiner should make no special effort to search claims for a process which inevitably results in the manufacture of that product or for use of the product (cf. C-III, 3.8 and C-IV, 11.12). When the application contains only claims of one category, it may be desirable to include other categories in the search. For example, generally, i.e. except when the application contains indications to the contrary, one may assume that in a claim directed to a chemical process, the starting products form part of the state of the art and need not be searched; the intermediate products are only searched when they form the subject of one or more claims; but the final products will always have to be searched, except when they are evidently known.

3.11 Subject-matter excluded from search

The examiner may exclude certain subject-matter from his search. *Rule 63*
These exclusions may result from certain subject-matter not *Rule 62a*
complying with the provisions of the EPC relating to exclusions from patentability or to susceptibility to industrial application (see VIII, 1 and 2). They may also arise where the application does not comply with the provisions of the EPC to such an extent that a meaningful search is impossible for some or all of the claims, or for a part of a claim, for other reasons (see VIII, 3) or where the application does not comply with Rule 43(2) (see VIII, 4).

3.12 Lack of unity

Also, when the claims of the application do not relate to one invention *Rule 64*
only, nor to a group of inventions linked so as to form a single general inventive concept, the search will normally be restricted to the invention or the linked group of inventions first mentioned in the claims (see Chapter VII). Restriction of the search for the above reasons will be notified to the applicant in a communication accompanying the partial search report (see VII, 1.2).

3.13 Technological background

In certain circumstances it may be desirable to extend the subject-matter of the search to include the "technological background" of the invention. This would include:

– the preamble to the first claim, i.e. the part preceding the expression "characterised by" or "characterised in that";

– the state of the art which in the introduction of the description of the application is said to be known, but not identified by specific citations;

– the general technological background of the invention (often called "general state of the art").

Chapter IV

Search procedure and strategy

1. Procedure prior to searching

1.1 Analysis of the application

When taking up an application to be searched, the examiner should first consider the application in order to determine the subject of the claimed invention taking account of the guidance given in III, 3. For this purpose he should make a critical analysis of the claims in the light of the description and drawings. He should in particular consider the content of the claims, description and drawings sufficiently to identify the problem underlying the invention, the inventive concept leading to its solution, the features essential to the solution as found in the claims and the results and effects obtained (see, however, III, 3.5). Furthermore, where technical features which are not present in the claims are indicated in the description as essential for the solution of the stated problem, these features should be included in the search (see C-III, 4.3(ii) and T 32/82, OJ 8/1984, 354).

1.2 Formal deficiencies

The search is carried out in parallel with the formalities examination. If the examiner notices any formal shortcomings which have been overlooked by the Receiving Section, he calls these, by means of an internal communication, to the attention of the Receiving Section (or of the Examining Division in the case of an additional search requested by that Division) which takes appropriate action. However, the examiner should not repeat the tasks of the Receiving Section and should not undertake any time-consuming enquiries into these matters. Such deficiencies which the examiner might notice include:

Art. 90(1)
Art. 92
Art. 78
Art. 53(a)
Rules 30 to 34, 40 to 50 and 55 to 58

(i) physical deficiencies of the application (see A-III, 3.2), including:

Art. 90(3)
Rule 57

(a) no paper and/or no electronic sequence listing (Rule 30(1) and Special edition No. 3, OJ EPO 2007, C.1);

(b) incorrect sequence and/or positioning of page numbering and/or failure to use Arabic numerals in page numbering (Rule 49(6));

(c) presence of drawings in the description and/or claims (Rule 49(9));

(d) presence of erasures and/or alterations in the application documents, such that the authenticity of the content and/or the requirements for good reproduction are jeopardised (Rule 49(12));

Art. 53(a)
Rule 48(1)(a) and (b)

(ii) presence of prohibited matter in the application:

(a) which is contrary to "ordre public" (see A-III, 8.1, C-II, 7.2 and C-IV, 4.1 to 4.3); or

(b) constituting disparaging statements (see A-III, 8.2). Note, however, that fair comment as referred to in C-II, 7.3 is permitted;

Rules 31 to 33

(iii) failure to comply with the provisions relating to the deposition of biological material (see A-IV, 4), in particular with regard to the correct identification in the application of the depository institution and accession number of the biological material assigned to the deposited material by the depository institution (Rule 31(1)(c), see G 2/93, OJ 5/1995, 275 and A-IV, 4.2).

(iv) failure to correctly identify the application as a divisional application within the meaning of Art. 76(1) (see A-IV, 1.3.2, Rule 41(2)(e)).

1.3 Documents cited in the application

Documents cited in the application under consideration should be examined if they are cited as the starting point of the invention, as showing the state of the art, or as giving alternative solutions to the problem concerned, or when they are necessary for a correct understanding of the application (see, however, IV, 2.4). However, when such citations clearly relate only to details not directly relevant to the claimed invention, they may be disregarded. In the exceptional case that the application cites a document that is not published or otherwise not accessible to the Search Division and the document appears essential to a correct understanding of the invention to the extent that a meaningful search would not be possible without knowledge of the content of that document, the Search Division should apply the procedure under Rule 63 and invite the applicant to either submit the document or indicate the subject-matter to be searched (see B-VIII, 3). If no copy of the document is received within the time limit according to Rule 63(1) and the applicant is unable to convince the Search Division in a timely response to the Rule 63(1) invitation that the document is not essential to facilitate a meaningful search, an incomplete search report or, where applicable, a declaration replacing the search report under Rule 63 is prepared (see B-VIII, 3.2). This incomplete search report or declaration will be issued giving the following grounds:

(i) the non-availability of the document rendered the invention insufficiently disclosed within the meaning of Art. 83; and

(ii) the insufficient disclosure mentioned in (i) existed to such a degree that a meaningful search was not possible on at least part of the claimed invention (see VIII, 3).

It should also be noted that where the applicant furnishes the document after the search report and the search opinion (if applicable, see XII, 8) have been prepared, an additional search on that subject-matter originally excluded from the search may be carried out due to the correction of the deficiency which led to the incomplete search (see C-VI, 8.2). However, applicants must be aware that such later furnished information can only be taken into account for sufficiency of disclosure pursuant to Art. 83 under certain circumstances (see C-II, 4.17).

1.4 Abstract; official classification; title of the invention; publication

Rule 66
Rule 47
Rule 68(1)

The examiner should then consider the abstract (together with the title of the invention and the figure, if any, of the drawings to be published with the abstract) in relation to the requirements laid down in the Implementing Regulations (see Chapter XI). Since the abstract should relate to the application as filed, the examiner should consider it and determine its definitive content before carrying out the search, in order to avoid being inadvertently influenced by the results of the search. If publication of the application is due before the search report is drawn up (A2 publication), the examiner has to establish the official classification of the application much earlier than he carries out the search (see V, 4); he examines then at the same time the abstract for the purpose of publication. This examination of the abstract does not go beyond ensuring that it relates to the application concerned and that no conflict exists with the title of the invention or with the classification of the application. Information in relation to the abstract, the title of the invention and the figure, if any, of the drawings to be published with the abstract is transmitted to the applicant in the communication accompanying the search report, in the case of an A1 publication. If the search report is published separately (A3 publication), this information is not given in the communication. The examiner also translates the title of the invention into the two other official languages.

2. Search strategy

2.1 Subject of the search; restrictions

Rule 63
Rule 62a

Having determined the subject of the invention as outlined in IV, 1.1, it may be desirable for the examiner to prepare first a search statement, defining the subject of his search as precisely as possible. In many instances one or more of the claims may themselves serve this purpose, but they may have to be generalised in order to cover all aspects and embodiments of the invention. At this time, the considerations relating to subjects excluded from patentability (see VIII, 1 and 2) and to lack of unity of invention (see VII, 1.1) should be borne in mind. The examiner may also have to restrict the search because the requirements of the EPC are not met to such an extent that a meaningful search is impossible (see VIII, 3) or because the application does not comply with Rule 43(2) (see the procedure defined in VIII, 4). Any such restrictions to the search must be

indicated in the search report or declaration taking the place of the search report under Rule 63 or Rule 62a. The declaration should indicate the reasons for any restrictions under Rule 63 (see X, 8(iii)). The declaration or the incomplete search report is considered, for the purposes of subsequent proceedings, as the search report.

2.2 Formulating a search strategy

Next the examiner should start the search process by formulating a search strategy, i.e. a plan consisting of a series of search statements expressing the subject of the search, resulting in sections of the documentation to be consulted for the search. In its initial phase, a search strategy will contain one or more combinations of the basic components mentioned in III, 2.2. The search process should be interactive and iterative in the sense that the examiner should reformulate his initial search statement(s) according to the usefulness of the information retrieved (see III, 1.1; IV, 2.4 and IV, 2.6). When using classification units, the examiner should select the classification units to be consulted for the search, both in all directly relevant fields and in analogous fields. The selection of the classification units in related fields should be limited to:

(i) higher subdivisions allowing searching by abstraction (generalisation) inasmuch as this is justified from a technical viewpoint; and

(ii) parallel subdivisions, bearing in mind the fact that the fields in question will become increasingly unrelated.

When the examiner is in doubt about the appropriate fields in which to conduct his search, he may request advice from the appropriate directorate of Principal Directorate Tools.

Usually various search strategies are possible, and the examiner should exercise his judgement, based on his experience and knowledge of the available search tools, to select the search strategy most appropriate to the case in hand. He should give precedence to search strategies yielding sections of the documentation in which the probability of finding relevant documents is highest. Usually the main technical field of the application will be given precedence, starting with the basic components (see III, 2.2) most relevant to the specific example(s) and preferred embodiments of the claimed invention.

2.3 Carrying out the search; types of documents

The examiner should then carry out the search, directing his attention to documents relevant for novelty and inventive step.

He should also note any documents that may be of importance for other reasons, such as:

(i) conflicting documents (see VI, 4) which are:

(a) published European applications under Art. 54(3) (see C-IV, 7.1 and 7.1.1);

(b) published international applications under Art. 54(3) and Art. 153(3) and (5) (see C-IV, 7.2);

(c) published national applications of EPC Contracting States under Art. 139(2) (see C-IV, 8 and C-III, 8.4);

(d) any document published during the priority interval of the application which may be relevant under Art. 54(2) in case of a non-valid priority date.

When published within the priority interval of the application under search, these applications are cited in the search report as "P" documents (see X, 9.2(iv)); when published after the European or international filing date, they are cited in the search report as "E" documents (see X, 9.2(vi));

(ii) documents putting doubt upon the validity of any priority claimed (see VI, 3 and C-V, 1.4.1), which are cited in the search report as "L" documents (see X, 9.2(viii)(a));

(iii) documents contributing to a better or more correct understanding of the claimed invention, which are cited in the search report as "T" documents (see X, 9.2(v));

(iv) documents illustrating the technological background, which are cited in the search report as "A" documents (see X, 9.2(ii));

(v) European patent applications having the same filing or priority date as the application in respect of which the search is carried out, from the same applicant and relating to the same invention and therefore relevant to the issue of double patenting (see C-IV, 7.4), which are cited in the search report as "L" documents (see X, 9.2(viii)(c));

(vi) documents indicating or establishing the publication date of a document drawn from the internet (see C-IV, 6.2), which are cited in the search report as "L" documents (see X, 9.2(viii)(b)); and

(vii) documents retrieved from the internet which do not have any publication date but which the examiner nonetheless wants to cite to inform the applicant or third parties (cf. C-IV, 6.2.4), which are also cited as "L" documents (see X, 9.2(viii)).

However, he should not spend a significant amount of time in searching for these documents, nor in the consideration of such matters unless there is a special reason for doing so in a particular case (see VI, 5.3 and XII, 4).

The examiner should concentrate his search efforts on the use of search strategies yielding sections of the documentation in which the probability of finding highly relevant documents is greatest, and, in considering whether to extend the search to other less relevant sections of the documentation, he should always take account of the search results already obtained.

2.4 Reformulation of the subject of the search

The examiner should continuously evaluate the results of his search, and if necessary reformulate the subject of the search accordingly. For example, the selection of the classification units to be searched or the order of searching them may also require alteration during the search as a consequence of intermediate results obtained. The examiner should also use his judgement, taking into account results obtained, in deciding at any time during the systematic search whether he should approach the search documentation in some different manner, e.g. by consulting:

(i) documents cited in relevant documents produced by the search, for example cited in the description or search report of a patent document; or

(ii) documents citing a relevant document produced by the search,

or whether he should turn to documentation outside that which is available to the Search Divisions in-house (see Chapter IX). When searching external document collections for material in relation to unpublished subject-matter using other than secure connections, like the Internet, the examiner should be extremely careful when formulating search strategies so as not to unwittingly reveal confidential material – i.e. any part of the unpublished patent application.

2.5 Closest prior art and its effects on the search

It may happen that the examiner does not find any documents published before the earliest priority date which prejudice the novelty or the inventive step of the claimed invention. In such cases, the examiner should, whenever possible, cite in the search report at least that prior art found in the course of search which discloses a solution to the same problem as that underlying the claimed invention (wherein this problem may change depending on the prior art retrieved (C-IV, 11.5.2) and wherein the known solution is technically the closest to the claimed solution ("closest prior art"). Such prior art is to be cited as an "A" document in the search report (see X, 9.2(ii)).

If such a document cannot be found, the examiner should cite as the closest prior art a document which solves a problem closely related to the problem underlying the claimed invention and wherein the solution is technically most similar to that of the application under search.

Where the examiner retrieves documents which are incidentally prejudicial to the novelty of the claimed invention (to be cited as "X") but which do not affect the inventive step thereof after appropriate amendment of the application, and does not retrieve any other documents prejudicing inventive step, the examiner should also proceed as above.

In the case of a European application derived from an international application and being subjected to a supplementary European search after entering the European phase (Art. 153(7) – see II, 4.3), it is possible that the examiner does not uncover any further relevant prior-art documents in the search over and above the documents already cited in the international search report by the International Searching Authority. In such cases, it is permissible to have no further relevant documents in the supplementary European search report (see X, 9.1.4).

2.6 End of search

Reasons of economy dictate that the examiner use his judgement to end his search when the probability of discovering further relevant prior art becomes very low in relation to the effort needed. The search may also be stopped when documents have been found clearly demonstrating lack of novelty in the entire subject-matter of the claimed invention and its elaborations in the description, apart from features which are trivial or common general knowledge in the field under examination, application of which features would not involve inventive step. The search for conflicting applications should, however, always be completed to the extent that these are present in the available documentation.

3. Procedure after searching

3.1 Preparation of the search report

After completion of the search, the examiner should select from the documents retrieved the ones to be cited in the report. These should always include the most relevant documents (which will be specially characterised in the report (see X, 9.2). Less relevant documents should only be cited when they concern aspects or details of the claimed invention not found in the documents already selected for citation. In cases of doubt or borderline cases in relation to novelty or inventive step, the examiner should cite rather more readily in order to give the Examining Division the opportunity to consider the matter more fully (see III, 1.1).

To avoid increasing costs unnecessarily, the examiner should not cite more documents than is necessary and therefore, when there are several documents of equal relevance, the search report should not normally cite more than one of them. In any case, the search report is accompanied by an annex drawn up by computer and listing the patent documents which are available and belong to the same patent family. In selecting from these documents for citation, the examiner should pay regard to language convenience, and preferably cite (or at least note) documents in the language of the application (see X, 9.1.2).

Subsequently, the examiner prepares the search report.

3.2 Documents discovered after completion of the search

It may happen occasionally, that after completion of a search report, the Search Division discovers further relevant documents (e.g. in a later search for a related application). Copies of these documents should be sent with a note to the Receiving Section, which, depending upon the stage of procedure reached, will proceed under one of the following three variants. These documents should be added to the search report up to the time that preparations for its publication are completed. Up to the filing of a request for examination, such later discovered documents should be communicated to the applicant in an addition to the search report and this information will be published. Thereafter, such documents may be used in examination.

3.3 Errors in the search report

When a material error is found to be present in a search report prior to publication thereof, a new search report will be drawn up which supersedes the preceding one. Where the search report has already been sent to the applicant according to Rule 65, but has not yet been published, the error should immediately be notified to the applicant. When a serious error is noted following publication of the search report, a corrigendum is published in the European Patent Bulletin, and the applicant and the Examining Division should be informed accordingly. If the error comprises the transmission of an incorrect document as a citation, the correct document should be sent.

Chapter V

Preclassification (routing) and official classification of European patent applications

1. Definitions

By "preclassification" is meant a first stage of routing, for purposes of internal handling, whereby the subject of the claimed invention (or the invention first claimed, if there is more than one) is broadly identified by means of the appropriate classification symbols. By "official classification" is meant the assigning of the appropriate classification symbols identifying the technical subject of the claimed invention (or of the subjects of each of the claimed inventions, if there is more than one), such identification being as precise and comprehensive as the classification permits. In addition, non-obligatory classification or indexation symbols may be attributed to any additional information contained in the document to be classified, which should be identified according to the Guide to the International Patent Classification ("IPC") published by WIPO (see also the WIPO website). The official classification of the European patent application is performed by the examiner, using the classification symbols contained in the rules of the IPC for the inventions as claimed ("Obligatory Classification"). He can also assign appropriate classification symbols and/or indexing codes to any additional information ("Non-Obligatory Classification") as defined in the Guide to the IPC in force at the time.

2. Preclassification (routing)

In order for an application to be allotted to the competent directorate, a preclassification must be made. The level of classification at this stage should be as general as practicable on the basis of a quick and cursory scrutiny of the document (e.g. the title and independent claim or claims). On the other hand, the level should be specific enough to avoid the need for any intermediate stage of preclassification before allocation to the competent directorate. The most appropriate level in the light of these considerations is usually that of the sub-class. Only rarely, when the sub-class is exceptionally large or heterogeneous and spread over different directorates, is preclassification to a main ("00") or sub-group necessary. This classification should be indicated by the use of the appropriate symbols in a space to be provided on the dossier.

The preclassification required for this first allocation should be made on the basis of the independent claims. If this results in preclassification in more than one sub-class, then whichever of these seems to be the most relevant to the claimed invention (or the invention first claimed, if there is lack of unity of invention) should be

selected. This is the preclassification which should be indicated on the dossier.

In most cases no further classification is required to enable applications to be allotted to the Search Divisions within a directorate, but, where it is necessary, it falls within the authority of the examiner in charge of the field to arrange for such allotment in an expedient manner.

3. Incorrect preclassification

If, on reaching the directorate, an application has been found to be incorrectly preclassified and thus inappropriately allocated, it is reclassified and re-allocated by the directorate receiving it, the indication on the dossier being appropriately amended. Normally this is done by mutual agreement with the directorate to which it is proposed to re-allocate it. However, cases arise over which there is disagreement or uncertainty regarding classification boundaries, or where the directorate dealing with the case is uncertain as to its correct classification, and in such instances the directorate having the case should not spend time in trying to resolve the matter, but should consult the classification specialists in Principal Directorate Tools and, if necessary, refer the case to them.

4. Official classification of the application

The official classification of the European patent application is performed by the examiner as described above in V, 1. Preferably, this should be done when he has studied the content of the application in order to carry out the search. However, if publication of the application is due before the search report is drawn up, it is necessary for the examiner to study the application sufficiently to determine the official classification at this earlier stage (see X, 5).

If the official classification of the application is in more than one sub-class, or more than one main ("00") group within a sub-class, then all such classifications should be assigned. The classification of the invention as claimed should be distinguished from any additional classification and/or indexing code. In addition, where it is necessary to assign more than one symbol for the invention itself, the symbol which in the examiner's opinion most adequately identifies it, or, when this presents difficulties, the symbol which identifies the invention for which most information is given, should be indicated first, e.g. in order to facilitate subsequent allocation of the applications.

The classification should be determined without taking into consideration the probable content of the application after any amendment, since this classification should relate to the disclosure in the published application, i.e. the application as filed. If, however, the examiner's understanding of the invention, or of the content of the application as filed, alters significantly as a result of the search (e.g. as a result of prior art found or because of clarification of apparent obscurities), he should amend the classification accordingly,

if the preparations for publication have not at that stage been completed.

5. Classification of late-published search reports

Where the search report is not available in time for publication of the application, and is therefore published separately, and the examiner finds it necessary to amend the original classification for the reasons given in V, 4, last paragraph, he should state the amended classification on the search report, indicating that it constitutes the official classification in place of that published on the application (which thus becomes merely the "classification for publication"). Such amendment of the classification should not be made unless the examiner is quite certain that it is necessary.

Where a European patent application is classified and published without the European search report (A2 publication), the European search report is prepared and published separately after publication of the application (A3 publication). It may happen that the IPC is amended in the period between publication of the European application (A2 publication) and the separate publication of the search report (A3 publication). In this case, the examiner must use for the search report that version of the IPC which was in force when the application was published.

6. Classification when the scope of the invention is not clear (e.g. a partial search)

When the scope of the invention is not clear, the classification has to be based on what appears to be the invention insofar as this can be understood. It is then necessary to amend it if obscurities are removed by the search, as discussed in V, 4, last paragraph.

7. Classification in cases of a lack of unity of invention

Where objection of lack of unity of invention arises, all inventions must be classified, since all will be disclosed in the published application. Each invention claimed is to be classified as set out in paragraphs V, 4 to 6.

8. Verification of official classification

As a general rule, applications will not be systematically scrutinised after leaving the Search Division in order to verify the correctness of the official classification assigned by the examiner. The Office may, however, institute such sampling check procedures as are deemed necessary to ensure correctness and uniformity in the application of the IPC. It is, of course, for the director to arrange for such checks as he considers necessary, having regard to the experience of his examiners, before the applications leave his directorate.

Chapter VI

The state of the art

1. General

The general considerations relating to the state of the art and patentability, especially with regard to the determination of novelty and inventive step, are set out in C-IV.

2. State of the art – oral disclosure, etc.

According to Rule 33.1(a) and (b) PCT, oral disclosure, use, exhibition, etc. are recognised as prior art only when this is substantiated by a written disclosure. In contrast, according to Art. 54 EPC, a public oral description, use, etc. is considered as prior art. However, the examiner, in carrying out a European search, should cite an oral description, etc. as prior art only if he has available a written confirmation or is otherwise convinced that the facts can be proved. Such references to oral disclosure, prior public use, disclosure by sale, etc. are more usually brought up by opponents in opposition proceedings (see D-V, 3).

3. Priority

If the claimed priority dates cannot be verified at this stage, uncertainty will exist as regards their validity and the search for conflicting applications should be extended so as to cover all published applications with an earliest claimed priority date up to the filing date (not the claimed priority date(s)) of the application under consideration (see IV, 2.3 and XII, 4).

4. Conflicting applications

4.1 Potentially conflicting European and international applications

Generally, where the search is concluded less than eighteen months after the European or international filing date of the application (the filing date according to Art. 80 and not its claimed priority date(s)), it will not be possible at the time of the search to make a complete search for potentially conflicting European and international applications. This search therefore has to be completed at the examination stage by the Examining Division (see C-VI, 8.1). *Art. 54(3)*

4.2 National earlier rights

There may also be national applications of one or more States designated in the European application of which the dates of filing are prior to the filing or priority date of the European application, and which were published as national applications or patents on or after that date. Although such applications are not a bar to the grant of a European patent, but only a ground for revocation in the Contracting State(s) concerned, they may be of importance to the applicant (see C-III, 8.4). Therefore, any of these which are present in the *Art. 139(2)*

documentation are noted and mentioned in the search report for information (see X, 9.2(vi)). However, no special search effort should be made for this purpose (see IV, 2.3).

5. Date of reference for documents cited in the search report; filing and priority date

5.1 Verification of claimed priority date(s)

Art. 80
Rule 40
Art. 90(3)
Art. 54(2)

Where the validity of the priority claim cannot be verified at the search stage (see XII, 4), the basic reference date for the search must be taken as the date of filing of the European application as accorded by the Receiving Section. (For the reference date for the search with respect to conflicting applications, see, however, VI, 3).

5.2 Intermediate documents

The Search Division takes into account documents published between the earliest priority date and the filing date of the application under consideration, and these documents are identified as such in the search report (see X, 9.2(iv)). For identifying these documents when an application has more than one priority date, the oldest date is to be applied. When deciding which documents to select for citing in the search report, the examiner refers to these dates and should preferably choose any published before the date of priority. Thus, for example, where there are two documents, one published before the date of priority and the other after that date but before the date of filing, but otherwise equally relevant, he should choose the former (see IV, 3.1, 2nd paragraph).

5.3 Doubts as to the validity of the priority claim; extension of the search

It is the responsibility of the Examining Division to check whether and to what extent the priority claim is justified. However, where intervening state of the art (see VI, 5.2)) or potential state of the art according to Art. 54(3) is revealed in the search, the Search Division should, if possible, check the validity of the priority claim (see XII, 4, and C-V, 1.2 to 1.5 and 2). Furthermore, documents showing that a priority claim might not be justified (e.g. an earlier application or patent from the same applicant indicating that the application from which priority is claimed may not be the first application for the invention concerned) should be cited in the search report (see X, 9.2(viii)). However, no special search effort should normally be made for this purpose, except when there is a special reason to do so, e.g. when the priority application is a "continuation-in-part" of an earlier application from which no priority is claimed (see IV, 2.3 and C-V, 2.4.4). Sometimes the fact that the country of residence of the applicant is different from the country of the priority application may also be an indication that it is not a first filing, justifying a certain extension of the search.

When the search is extended for this purpose, it should be directed to:

(i) published patent documents filed earlier than the claimed priority date, for example (assuming that the applicant is the same for all applications):

date:	application:	subject-matter:
01.03.98	GB1 filed	A
30.05.98	GB2 filed	A
30.05.99	EP1 filed (claiming priority of GB2)	A
10.09.99	GB1 published	A

During the search for EP1, the examiner retrieved published application GB1. GB1 may prejudice the priority claim of EP1, since it was filed earlier than GB2. Published GB1 should, therefore, be cited in the search report as an "L" document according to X, 9.2(viii)(a); or

(ii) published patent documents which claim priority from an application filed earlier than the priority date of the application being searched, for example (assuming again that the applicant is the same for all applications):

date:	application:	subject-matter:
01.03.98	GB1 filed	A
30.05.98	GB2 filed	A
01.03.99	US1 filed (claiming priority of GB1)	A
30.05.99	EP1 filed (claiming priority of GB2)	A
15.04.00	US1 published	A

The publication US1 was found during the search for EP1. GB1 may prejudice the priority of EP1, since it was filed earlier than GB2. US1, which claims GB1 as priority, should, therefore, be cited in the search report as an "L" document according to X, 9.2(viii)(a).

5.4 Documents published after the filing date

The search does not normally take into consideration documents published after the filing date of the application. However, some extension is necessary for specific purposes, as is apparent from VI, 2 to 4, and VI, 5.3.

Certain other situations may occur in which a document published after the filing date is relevant; examples are a later document containing the principle or theory underlying the invention, which may be useful for a better understanding of the invention, or a later document showing that the reasoning or the facts underlying the invention are incorrect (see Art. 84 and C-III, 6.3). The search should not be extended for this purpose, but documents of this nature known to the examiner could be selected for citation in the report (see X, 9.2(v)).

5.5 Non-prejudicial disclosures

Art. 55(1)(a) and (b)
Rule 25

Disclosures of the invention should not be taken into consideration if they occurred no earlier than six months preceding the filing date of the European patent application (see G 3/98 and G 2/99, OJ 2/2001, 51) and if they were due to an evident abuse in relation to the applicant or his legal predecessor, or due to display at an official, or officially recognised, international exhibition. The Search Division should, nevertheless, cite in the search report any documents it has reason to believe come within one of the categories mentioned in X, 9.2(viii). In this case too the reference date for the search will be the filing date of the application (see VI, 5.1 and XII, 4). Since the matter of abuse will generally only be raised after transmission of the search report and search opinion (if applicable, see XII, 8), and disclosure at an exhibition involves the question of identity between the displayed and claimed invention, both matters are investigated by the Examining Division.

6. Contents of prior-art disclosures

6.1 General remark

As a general rule, the Search Division selects for citation only documents which are present in the search documentation or which it has access to in some other manner. In that way, no doubt exists about the contents of the documents cited, since the examiner generally has physically inspected each document cited.

6.2 Citation of documents corresponding to documents not available or not published in one of the official EPO languages

Under certain circumstances a document whose contents have not been verified may be cited, provided there is justification for the assumption that there is identity of content with another document which the examiner has inspected; both documents should then be mentioned in the search report in the manner indicated at the end of X, 9.1.2. For example, instead of the document published before the filing date in a non-EPO language and selected for citation, the examiner may have inspected a corresponding document (e.g. another member of the same patent family, or a translation of an article) in an official EPO language and possibly published after the filing date. Also it may be assumed that, in the absence of explicit indications to the contrary, the contents of an abstract are contained in the original document. Further, it should be assumed that the

contents of a report of an oral presentation are in agreement with that presentation.

Before citing documents in a language with which he is not familiar, the examiner should make sure that the document is relevant (e.g. through translation by a colleague, through a corresponding document or abstract in a familiar language, or through a drawing or chemical formula in the document or by consulting database indexes relating to the technical content of that document (see X, 9.1.3)).

Chapter VII

Unity of invention

1. General remarks

1.1 Partial European search report

Rule 64

If the Search Division considers that the European application does not comply with the requirement of unity of invention (see C-III, 7), it must search it, and draw up the partial European search report under Rule 64(1), for those parts of the application which relate to the invention (or group of inventions forming unity) first mentioned in the claims. The partial European search report is supplemented with a specification of the separate inventions.

With regard to the search opinion in cases of a lack of unity of invention, see XII, 6.

When determining which invention is the invention or unitary group of inventions first mentioned in the claims, the examiner takes account of the content of the dependent claims, disregarding trivial claims (see III, 3.8).

1.2 Invitation to pay further search fees

Rule 64(1)
Point 6.1 AAD

The Search Division will inform the applicant of the lack of unity of invention in a communication accompanying the partial search report and indicate that a further search fee must be paid for each invention other than the one first mentioned in the claims, if the search is to cover these inventions as well. The payment of these fees must take place within a period of two months (Rule 64(1)). If the automatic debiting procedure is being used for the application, the applicant must inform the EPO within this period if he does not want all or any of the further inventions to be searched. Otherwise all the further search fees due will be debited automatically on the last day of the period. Searches relating to inventions for which further search fees have been paid within the fixed period receive preferential treatment from the Search Division. The search report is to be drawn up for all those parts of the patent application which relate to inventions in respect of which search fees have been paid. The search report identifies the separate inventions and indicates the subject-matter and corresponding claims (or parts of claims – see Rule 44(2)) for which a search has been made.

1.3 Documents relevant only to other inventions

Whilst documents relevant only to other inventions may be retrieved during the search on the invention first mentioned in the claims, these are not necessarily included in the partial European search report. Such documents must, however, be cited in the partial search report if they form the basis for a lack of unity a posteriori (see C-III, 7.6 and 7.8).

2. Procedures in cases of lack of unity

2.1 Request for refund of further search fee(s)

Rule 64(2)

At the examination stage the applicant may contest the allegation of non-unity and request a refund of one or more of the further fee(s) paid. If the Examining Division finds this to be justified, the fee(s) in question will be refunded (see, however, XII, 1.2).

2.2 Decision with respect to unity of invention

From the preceding paragraph it is clear that the decision with respect to unity of invention rests with the Examining Division (see III, 1.1). Consequently, the criteria to be applied in this respect by the Search Division should not be different from those applied by the Examining Division.

In particular, the Search Division should not raise an objection of lack of unity merely because the inventions claimed are classified in separate classification units, or merely for the purpose of restricting the search to certain sections of the documentation, for example, certain classification units (see, however, V, 7).

2.3 Complete search despite of lack of unity

Exceptionally, in cases of lack of unity, especially "a posteriori", the examiner is able to make a complete search and prepare a search opinion (where applicable - see XII, 8) for all inventions with negligible additional work and cost, in particular when the inventions are conceptually very close. In those cases, the search for the further invention(s) is completed together with that for the invention first mentioned in the claims. All results should then be included in a single search report, which raises the objection of lack of unity and identifies the different inventions. It further indicates that the Search Division did not invite the applicant to pay further search fee(s) because all claims could be searched without effort justifying such a fee. However, the search opinion (if applicable, see XII, 8) still raises the issue of unity of invention (see XII, 6).

2.4 Supplementary European search

Art. 153(7)
Rule 164(1)

When in a supplementary European search following an international (PCT) search a problem of unity of invention arises, the supplementary European search report will be based on the invention or group of inventions first mentioned in the claims serving as basis for the supplementary European search, independently of the findings of the International Searching Authority as regards unity of invention.

3. Lack of unity and Rule 62a or Rule 63

The procedures for dealing with cases which lack unity and where Rule 63 or Rule 62a applies are dealt with in VIII, 3.4 and 4.5 respectively.

Chapter VIII

Subject-matter to be excluded from the search

1. General remarks

In relation to searches carried out for European patent applications, the subject-matter listed in Rule 39.1 PCT may be considered under the EPC either not to be susceptible of industrial application (Art. 57) or, to the extent to which the European patent application relates to that subject-matter as such, to be excluded from patentability under Art. 52(2) and (3), or to constitute an exception to patentability under Art. 53(b) and (c). The claims are not searched in as far as they relate to such subject-matter (for the procedure for limiting the search according to Rule 63 see VIII, 3.1 to 3.4). For the specific case of compositions for use in methods of treatment of the human or animal body by surgery or therapy, or diagnostic methods practised on the human or animal body, see VIII, 2, below.

Art. 52(2) and (3)
Art. 53
Art. 57
Rule 63

While a decision on these matters rests with the Examining Division, opinions on these matters are formed by the Search Division for the purpose of drafting the search opinion (if applicable, see XII, 8) and also in considering possible limitations of the search and therefore whether or not to apply the procedure provided for under Rule 63(1) (see VIII, 3.1 to 3.4). The Search Division has thus to consider the requirements for patentability other than novelty and inventive step, as set out in C-IV, 2 to 5.

Art. 52

The above-mentioned situations may also occur for only some of the claims or for part of a claim. In these cases, this will be indicated in the invitation according to Rule 63(1) and in any subsequent incomplete search report or the declaration taking the place of the search report under Rule 63(2).

Rule 63

2. Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body

With regard to methods for treatment of the human or animal body by surgery or therapy, or diagnostic methods practised on the human or animal body (exceptions to patentability according to Art. 53(c)), it should be noted that according to Art. 54(4) products, in particular substances or compositions, for use in any of these methods, are not excluded from patentability, provided that the use of the product for **any** such method is not comprised in the state of the art (see also C-IV, 4.8). Art. 54(5) provides for the possibility of obtaining further purpose-related product protection for any further and more specific novel and inventive use in a method according to Art. 53(c). It should be noted that a claim in the form "Use of a substance or composition X for the manufacture of a medicament for therapeutic application Z"

Art. 53(c)
Art. 54(4) and (5)

("Swiss-type" claim) may be allowable for either a first or any further "subsequent" such application (see C-IV, 4.8).

Even if a claim is drafted as a method of medical treatment and is for this reason not directed to patentable subject-matter, a meaningful search may be possible if the determining technical feature is the effect of the substance, which can be searched, and as such the procedure under Rule 63 (see VIII, 3.1 to 3.4) would not be necessary. If, however, specific method features are present (e.g. dosing instructions for the user, combination of pharmaceutical with physical treatment), a meaningful search may not be possible. In cases of doubt the Search Division should issue an invitation under Rule 63(1) (see VIII, 3.1). However, regardless of whether such claims are searched or not, the applicant's attention should be drawn in the search opinion (if applicable, see XII, 8) to the fact that such subject-matter is excluded from patentability (see XII, 3).

3. No meaningful search possible

Rule 63

An invitation under Rule 63(1) and subsequent limitation of the search under Rule 63(2) may also result from the application not meeting the relevant requirements of the EPC to such an extent that a meaningful search of the claims, or of some of the claims, or of part of a claim, is impossible. In such cases, the Search Division should apply the procedure under Rule 63 (see VIII, 3.1 to 3.4).

What is or is not "meaningful" is a question of fact for the Search Division to determine. Its finding may change in the light of any reply from the applicant to the invitation under Rule 63(1) (see VIII, 3.2). The exercise of the Search Division's discretion will depend upon the facts of the case. There are clearly cases where a search is rendered de facto impossible by the failure to meet the prescribed requirements of the EPC. But these are not the only circumstances under which Rule 63 may be invoked. The word "meaningful" should be construed reasonably.

On the one hand, the word "meaningful" should not be construed in such a way that Rule 63 is invoked simply because a search is difficult. On the other hand, it may be the case that a given claim could, theoretically, be searched completely, but that nevertheless, the Search Division comes to the conclusion, under a proper consideration of the relevant provisions of the EPC, that it would not be meaningful to do so, in the sense that it would not serve any useful purpose to do so having regard, for example, to any possible future prosecution of the application.

In other cases, it may be that the results of the search themselves would be quite meaningless.

A number of non-limiting examples will illustrate where Rule 63 may find application:

(i) claims lacking support; insufficient disclosure

One example would be the case of a broad or speculative claim supported by only a limited disclosure covering a small part of the scope of the claim. This could be the case if the broadness of the claim is such as to render a meaningful search over the whole of the claim impossible, and where a meaningful search could only be performed on the basis of the narrower, disclosed invention. This may mean a search of the specific examples. In such a case, it will often be de facto impossible to do a complete search of the whole of the claim at all, because of the broad drafting style. In other cases, a search of the whole of the claim would serve no useful purpose, as the claim would not be defensible in any subsequent examination phase. Accordingly, the procedure under Rule 63(1) may be applied (see VIII, 3.1 to 3.4). Here, the requirements underlying the application of Rule 63 would be those of sufficiency of disclosure and support set out in Art. 83 and 84 (see C-II, 4.9, 4.10; C-III, 6).

(ii) claims lacking conciseness

An example would be where there are so many claims, or so many possibilities within a claim, that it becomes unduly burdensome to determine the matter for which protection is sought (however, for the case of multiple independent claims in the same category see VIII, 4). A complete search (or any search at all) may de facto be impossible, or alternatively may serve no useful purpose as the claim or claim set would be indefensible in any subsequent examination phase. Again, the application of Rule 63 and the issuing of a subsequent incomplete search report (according to the procedures defined in VIII, 3.1 to 3.3) or a declaration of no search may be appropriate, on the grounds that the lack of conciseness of the claim(s) is such as to render a meaningful search impossible (see Art. 84; C-III, 5).

(iii) claims lacking clarity

An example would be where the applicant's choice of parameter to define his invention renders a meaningful comparison with the prior art impossible, perhaps because the prior art has not employed the same parameter, or has employed no parameter at all. In such a case, the parameter chosen by the applicant may lack clarity (see Art. 84; C-III, 4.11). It may be that the lack of clarity of the parameter is such as to render a meaningful search of the claims or of a claim or of a part of a claim impossible, because the results of

any search would be meaningless, the choice of parameter rendering a sensible comparison of the claimed invention with the prior art impossible. If so, the application of Rule 63 and the issuing of a subsequent incomplete search report (or, in exceptional cases, no search at all) under Rule 63(2) (according to the procedures defined in VIII, 3.1 to 3.3) may be appropriate, the search possibly being restricted to the worked examples, as far as they can be understood, or to the way in which the desired parameter is obtained (any response from the applicant to the invitation under Rule 63(1) being taken into account in determining the subject-matter to be searched to the extent indicated in VIII, 3.2).

These examples are not exhaustive. The basic principle is that there should be clarity and openness both for the applicant and for third parties as to what has and what has not been searched.

The treatment of these Rule 63 cases in subsequent examination proceedings is dealt with in C-VI, 5.6.

3.1 Invitation to indicate subject-matter for search

Rule 63(1)(2)

If the EPO considers that the application does not comply with the EPC to such an extent that it is impossible to carry out a meaningful search into the state of the art on the basis of all or some of the subject-matter claimed (see VIII, 1, 2 and 3), it will invite the applicant to file, within a period of two months, a statement indicating the subject-matter to be searched. The invitation will also give the reasons behind this finding and may additionally indicate the claimed subject-matter on which the Search Division considers it feasible to base a meaningful search.

3.2 Reply to the invitation under Rule 63(1)

Rule 63(2)

If the applicant replies in time to the invitation under Rule 63(1), indicating the subject-matter to be searched, and if a meaningful search based on the subject-matter that he has indicated is deemed possible by the Search Division, a search will be conducted on that subject-matter. If the applicant does not reply in time to the invitation under Rule 63(1), the Search Division will determine what to search. In either case a partial search report will be drawn up accordingly, or in exceptional cases a declaration replacing the search report. This limitation of the search has consequences in examination (see C-VI, 5.6).

If the applicant replies to the invitation under Rule 63(1) but in his reply indicates subject-matter which it is still not possible to search in full, the Search Division will determine the subject-matter to search, but will do so in a way which is consistent with the applicant's response, to the extent that this is possible, or in exceptional cases may determine that no meaningful search is possible at all.

If the applicant replies in time to the invitation under Rule 63(1), he may, instead of indicating the subject-matter to be searched, simply argue why he believes that it is possible to carry out a meaningful search on all of the subject-matter claimed. If the Search Division is convinced by the applicant's argumentation, a full search report will be issued and the consequences of a limitation of the search which apply in examination will not ensue. If the Search Division is not convinced, or is only partially convinced, it will issue a partial search report and will determine which subject-matter to search or, in exceptional cases, will issue a declaration replacing the search report.

3.3 The content of the extended European search report (EESR)

The two components of the EESR, the search report (or the declaration replacing it) and the search opinion, will indicate the reasons why it was not considered possible to conduct a meaningful search in respect of some or all of the claimed subject-matter according to Rule 63 and will indicate the subject-matter which was searched, if any, as determined according to the procedures given in VIII, 3.2. Furthermore, the search opinion will also invite the applicant to limit his claims to subject-matter which has been searched (in order to comply with Rule 63(3)). The documents cited in the search report and referred to in the search opinion will relate only to this subject-matter. In the event that the subject-matter subject to the search complies with the requirements of the EPC (in particular in that it is novel, inventive and industrially applicable, but also satisfies the other requirements of the EPC such as clarity under Art. 84), the search opinion will still be negative, because the claims do not comply with the requirements of the EPC in respect of their full scope.

Furthermore, if in response to the invitation under Rule 63(1) the applicant disputes the finding that a meaningful search is not possible (see VIII, 3.2), but the Search Division is not convinced by the applicant's argumentation, it will indicate why this is the case in the search opinion, as appropriate.

3.4 Applications to which Rule 63 applies which also lack unity

Cases will arise where the application does not comply with the EPC to such an extent that it is impossible to carry out a meaningful search into the state of the art on the basis of some of the subject-matter claimed (see VIII, 1, 2 and 3) and where the application also lacks unity of invention according to Art. 82 and Rule 44. It may be appropriate to raise only the issue of unity of invention and send an invitation under Rule 64(1) (see VII, 1.1 and 1.2), for example where a large number of claims which results in a severe lack of conciseness is resolved by splitting up the claims into different inventions.

It may, however, be necessary to apply the procedures under both Rule 64(1) (invitation to pay additional search fees for inventions

other than that first mentioned in the claims) and Rule 63(1). In this case, the EPO will first send the applicant an invitation according to Rule 63(1), requesting the applicant to indicate the subject-matter to be searched. In cases where the lack of unity is already apparent before any clarification is received from the applicant, this invitation would also identify the first invention mentioned in the claims and the claims which relate to this invention, either in full or in part, and would invite the applicant to clarify what to search in respect of this invention first mentioned in the claims.

After expiry of the time limit according to Rule 63(1), the subject-matter, if any, to be searched in respect of the first invention will be determined according to the procedures specified in VIII, 3.2. A partial search report (or exceptionally a declaration replacing it) will then be prepared on the invention first mentioned in the claims. This will be sent to the applicant along with an invitation to pay additional search fees under Rule 64(1) in respect of the other inventions. Where appropriate, this invitation under Rule 64(1) may also include an invitation according to Rule 63(1), inviting the applicant to clarify the subject-matter to be searched in respect of any additional inventions for which the applicant subsequently pays additional search fees.

Rule 164(1)

For Euro-PCT supplementary European search reports, where these exceptional conditions apply, the procedure will be as above, with the exception that instead of a Rule 64 invitation being sent, the applicant is sent a partial supplementary European search report drawn up on those parts of the application which relate to the invention, or group of inventions within the meaning of Art. 82, first mentioned in the claims. The subject-matter to be searched in respect of the invention, or group of inventions within the meaning of Art. 82, first mentioned in the claims is determined as explained in VIII, 3.2.

4. More than one independent claim per category (Rule 62a)

4.1 Invitation to indicate which independent claim to search

Rule 62a(1)

If the European Patent Office considers that the claims as filed do not comply with Rule 43(2) (see C-III, 3.2), it will invite the applicant to indicate, within a period of two months, claims complying with Rule 43(2) on the basis of which the search is to be carried out.

4.2 Reply to the invitation under Rule 62a(1)

If the applicant replies to the invitation under Rule 62a(1), indicating an independent claim in a particular category which he wishes the EPO to search, the EPO will conduct the search based on this claim. If the applicant fails to provide such an indication in due time, the search will be carried out on the basis of the first claim in each category. In either case a search report will be drawn up accordingly. This limitation of the search has consequences in examination (see C-VI 5.6).

In reply to this invitation, the applicant may also indicate more than one independent claim in the same category for search, where these fall within the exceptions provided for in Rule 43(2) (see C-III, 3.2). However, if the applicant does so, but the EPO finds that the claims indicated do not fall within the exceptions provided for in Rule 43(2), only the independent claim with the lowest number indicated by the applicant will be searched. For example, if an application contains independent product claims 1, 10 and 15, an invitation under Rule 62a(1) is sent and the applicant contends in his reply that independent product claims 10 and 15 fall within the exceptions provided for in Rule 43(2) and indicates that these two claims are to be searched, but the Search Division does not agree, then only claim 10 will be searched.

In any timely response to the invitation under Rule 62a(1), the applicant may, instead of indicating the independent claim or claims to be searched, simply argue why he believes that the claims comply with Rule 43(2) (i.e. why the plurality of independent claims in the same category fall within one or more of the exceptions provided for in Rule 43(2)). If the Search Division is convinced by the applicant's argumentation, a search report will be issued on the basis of all the claims, and the consequences of a limitation of the search which apply in examination will not ensue. If the Search Division is not convinced, it will issue a search report for which the search will be conducted based on the first independent claim in that category.

4.3 The content of the extended European search report (EESR)

The search opinion will invite the applicant to limit the application to claims which have been searched (Rule 62a(2)). Furthermore, if in response to the invitation under Rule 62a(1) the applicant disputes the finding under Rule 43(2) (see VIII, 4.2), but the Search Division is not convinced by the applicant's argumentation, it will indicate why this is the case in the search opinion, as appropriate.

4.4 Cases under Rule 62a where claims fees are not paid

If an independent claim has been deemed to be abandoned under Rule 45(3) or Rule 162(4) as a result of the non-payment of claims fees (see A-III, 9), the applicant cannot indicate this claim for search in response to the invitation under Rule 62a(1), because no search is conducted on such a claim (see B-III, 3.4). The indication of such a claim by the applicant in response to the invitation under Rule 62a(1) will be ignored by the EPO, which will then apply Rule 62a(1), last sentence, and will search the first independent claim in the category in question for which claims fees *have* been paid.

If all independent claims in the category in question have been deemed to be abandoned for failure to pay claims fees, no invitation under Rule 62a(1) will be sent in respect of these claims and none of them will be subject to a search.

4.5 Applications to which Rule 62a applies which also lack unity

Cases will arise where the application does not comply with Rule 43(2) (see VIII, 4.1 and C-III, 3.2) and the application also lacks unity of invention according to Art. 82 and Rule 44. It may be appropriate to raise only the issue of unity of invention and send an invitation under Rule 64(1) (see VII, 1.1 and 1.2).

It may, however, be necessary to apply the procedures under both Rule 64(1) (invitation to pay additional search fees for inventions other that the first mentioned in the claims) and Rule 62a(1). In this case, the EPO will first send the applicant an invitation according to Rule 62a(1), requesting him to indicate the independent claims to be searched.

In cases where the lack of unity is already apparent when the invitation under Rule 62a(1) is sent, it will also identify the first invention mentioned in the claims and the claims which relate to this invention, either in full or in part, and will invite the applicant to indicate which claims to search in respect of this invention first mentioned in the claims. After expiry of the time limit according to Rule 62a(1), the claims to be searched in respect of the first invention will be determined according to the procedures specified in VIII, 4.2. A partial search report will then be prepared on the invention first mentioned in the claims. This will be sent to the applicant along with an invitation to pay additional search fees under Rule 64(1) in respect of the other inventions. Where appropriate, this invitation under Rule 64(1) may also include an invitation according to Rule 62a(1), requesting the applicant to clarify the claims to be searched in respect of any additional inventions for which he subsequently pays additional search fees.

Conversely, it may also happen that after an invitation is sent according to Rule 62a(1) in respect of all claims, the claims which satisfy Rule 43(2) and which are subject to a search (as determined according to the procedures given in VIII, 4.2) are subject to an objection of lack of unity *a posteriori*. In such cases, an invitation to pay additional fees under Rule 64(1) will then be sent, the invitation being based only on the subject-matter of the claims determined by the applicant's response (or failure to respond) to the invitation under Rule 62a(1).

Rule 164(1)

For Euro-PCT supplementary European search reports, where these exceptional conditions apply, the procedure will be as above, with the exception that instead of being sent a Rule 64 invitation, the applicant is sent a partial supplementary European search report drawn up on those parts of the application which relate to the invention, or group of inventions within the meaning of Art. 82, first mentioned in the claims.

4.6 Treatment of dependent claims under Rule 62a

Claims depending either directly or indirectly via other dependent claims on an independent claim excluded from the search in accordance with Rule 62a(1) (see VIII, 4.2) are likewise excluded from the search. Conversely, if a dependent claim depends on more than one previous claim, not all of which were searched, that dependent claim will be searched only in as far as it depends on a claim or claims which *were* searched in accordance with Rule 62a(1).

5. Invitation under both Rule 62a(1) and Rule 63(1)

In certain cases it may be appropriate to send an invitation according to both Rule 63 (see VIII, 3.1) and Rule 62a(1) (see VIII, 4.1). This may be necessary, for example, in cases where clarifying which claim or claims to search under Rule 62a will not necessarily help to clarify what subject-matter to search because the application contains several independent claims in the same category, none or only some of which can be subject to a meaningful search in respect of their entire scope. In such cases invitations under both Rule 62a(1) and Rule 63(1) will be sent in a single communication. This single communication gives rise to the same two-month time limit for reply under both rules. In such cases, applicants wishing to respond to both invitations should do so simultaneously.

In response to this invitation under Rule 62a(1) and Rule 63(1), the applicant must not indicate independent claims (in response to the invitation under Rule 62a(1)) and subject-matter (in response to the invitation under Rule 63(1)) which are inconsistent with each other. If the applicant provides inconsistent indications, the Search Division may, depending on the circumstances, either (i) elect to search the claims indicated by the applicant according to Rule 62a(1), where necessary limiting the subject-matter searched in respect of those claims according to Rule 63(2) mutatis mutandis or (ii) elect to search the subject-matter indicated by the applicant according to Rule 63(1) and as defined in the first independent claim of a particular category which is consistent with that subject-matter according to Rule 62a(1), last sentence, mutatis mutandis.

Although sent in the same communication, the invitations under Rule 62a(1) and Rule 63(1) are still legally separate. Consequently, the applicant may also reply to only one of the invitations and not to the other. If he replies only to the Rule 62a(1) invitation, option (i) of the previous paragraph applies. If he replies only to the Rule 63(1) invitation, option (ii) of the previous paragraph applies.

Chapter IX

Search documentation

1. General

1.1 Organisation and composition of the documentation available to the Search Divisions

The basic part of the search documentation consists of a collection of patent documents systematically accessible in a manner suitable for searching. Additionally, periodicals and other publications of technical literature are put at the disposal of the examiners. This non-patent literature is accessible through in-house or external databases, some of which are arranged in the library in a manner suitable for consultation; parts thereof, such as particularly relevant articles, are selected and made available for direct access by incorporating these, or copies thereof, into the systematic documentation. The systematically accessible part of the search documentation includes the minimum documentation required for an International Searching Authority under Rules 34 and 36.1(ii) PCT and extends somewhat beyond these minimum requirements.

Furthermore, the Search Divisions at Berlin have access to the documentation of the Technical Information Centre Berlin of the German Patent and Trademark Office. This documentation is located in the same building and consists mainly of a collection of numerically arranged patent documents and of patent gazettes, a restricted collection of systematically arranged patent documents (primarily intended for use by the public), and a library collection of technical and juridical works and periodicals.

1.2 Systematic access systems

All examiners have at their disposal computer facilities for searching the search documentation. These allow, amongst other things, the use of the internal classification of the EPO (ECLA), which is based on the International Patent Classification (IPC) but comprises finer internal subdivisions. Searches can also be performed using other classification systems and/or words.

In The Hague and Berlin, in many technical fields, the systematically accessible search documentation is also arranged in paper form in a "pigeon-hole" filing system (practising multiple classification and filing where necessary) using the internal classification of the EPO.

1.3 Numerical lists

The EPO operates a computerised patent family system for documents in the search files published since 1968, which is linked with a class-inventory system (for older documents, written or typed lists are available). The family system is updated in co-operation with the national Offices on a basis of exchange of new input data. From

these systems, examiners can obtain the identification of corresponding patents of other countries ("family members") and the classification given to a given patent document.

2. Patent documents arranged for systematic access

2.1 PCT minimum documentation

The systematically accessible search documentation includes the national patent documents belonging to the PCT minimum documentation as specified in Rule 34.1(b)(i) and (c) PCT:

(i) the patents and/or published patent applications, published in or after 1920 by France, the former Reichspatentamt of Germany, Switzerland (in the French and German languages only), the United Kingdom, the Federal Republic of Germany, and the United States of America;

(ii) the utility certificates, and/or published applications therefor, issued by France;

(iii) the patents and/or published patent applications in which no priority is claimed, published by Austria, Australia and Canada after 1970, as selected and made available by these countries;

(iv) the abstracts in English of the patents and/or published patent applications issued by Japan, the former Soviet Union and the Russian Federation, and the inventors' certificates issued by the former Soviet Union and the Russian Federation, for which abstracts in the English language are generally available, are included.

Also included are published international (PCT) and regional (e.g. European) patent applications, patents, and inventors' certificates (Rule 34.1(b)(ii) PCT).

2.2 Other national patent documents

The search files furthermore include the following national patent documents:

(i) patents published by France, Germany or the United Kingdom before 1920;

(ii) patents and applications for patents published by the Netherlands (from 1912);

(iii) patents published by Belgium since 1926 and Luxembourg since 1946.

Note: a small part of these, published in the French or German language, and not claiming priority, is analogous to the part of the PCT minimum documentation referred to in IX, 2.1(iii) above.

2.3 Unpublished patent applications

Since the completion of the search for conflicting applications that are not published at the time of the initial search is entrusted to the Examining Divisions, the documents which can be cited in the search report do not include unpublished patent applications (see VI, 4.1).

2.4 Search reports

The official European and international (PCT) search reports are normally published together with the European and international applications and are included in the search files together with these applications. The official search reports relating to national applications, as well as unofficial search reports, are also included in these files to the extent that they are available to the public. Search reports that are not normally or not yet accessible to the public in the form of a published document are nevertheless available to the examiners included in the manual search files separately from the state of the art documents, and searching thereof is not compulsory for all applications.

2.5 Arrangements for manual search

The manual search files consist of paper copy documents held loosely in folders which are kept in pigeon-hole filing cabinets; these cabinets are located in storage rooms close to the examiners' rooms to which the folders are taken when needed for search, or in the examiners' rooms themselves.

In order to reduce the bulk of the manual search files and the amount of classification work, whenever an application is republished as such or as a granted patent, normally only one of these documents is included in the manual search files.

2.6 Patent family system

The EPO keeps a patent family system based on application data and priority data of the patent documents stored in databases of the EPO. When viewing patent documents on screen, normally only one representative document of a patent family is displayed, but links to the other members of its patent family are provided.

The practice of not including all members of a patent family in the manual search files (as accepted by WIPO) is followed extensively. With respect to patent documents published after 1968 this is done using the patent family system; for older documents this is done mainly in the context of reclassification projects, with the possibility of updating the family information in the databases accordingly. During manual searches, the examiners can make use of the patent family system to obtain the identification of other family members, which may then be consulted via the image databases or, if necessary, in the numerical files.

As regards new acquisitions, the selection of the family member to be classified and incorporated in the manual search files is as follows:

(i) all published European applications and international applications designating the EPO are incorporated in the manual search files;

(ii) the family member which is received first at the appropriate directorate, or the one of which the bibliographic data are first available at that department for inclusion in the computer file (when this is not an application as in (i) above), is incorporated in the manual search files;

(iii) whenever a choice is available because of substantially simultaneous arrival, preference is given to documents published in the English, French or German language;

(iv) whenever the first family member included in the manual search files is not in an official language, and a further family member belonging to the minimum documentation is received, that document is also included in the manual search files (in particular the first one of these if more than one is received);

(v) by way of exception, e.g. in complex technical fields, an additional family member may also be included in the manual search files when the information therein is more complete or presented in a more convenient way (e.g. US patents).

The selection of the documents incorporated in the manual search files under the family system as operated in the past, followed slightly different rules in some respects; for these documents the former situation is maintained in principle; nevertheless, whenever there is a reason to review the contents of a field, e.g. in case of reclassification, the opportunity is used to adapt the contents of the manual files to the above situation to the extent that this is practicable.

3. Non-patent literature arranged for systematic access

3.1 Periodicals, records, reports, books, etc.

The systematically accessible search documentation includes the relevant articles from the list of periodicals belonging to the minimum documentation under the PCT as established by the competent WIPO body and from other periodicals where deemed useful by the examiners. In principle, copies of the articles selected as relevant for search purposes are added to the search databases with a fictitious country code "XP", scanned for inclusion in the electronic "BNS" collection and included in the manual search files, where appropriate.

The EPO also subscribes to many further periodicals including abstract journals. Furthermore, records of conference proceedings,

reports, books, etc. covering the three official languages of the EPO and the various technically important geographical areas are obtained. Individual items are selected for inclusion in the online and manual search documentation insofar as they constitute useful additions to the state of the art as mainly reflected in the systematically accessible patent documents; such items are mainly primary articles from periodicals or conference proceedings and reports.

3.2 Arrangements for manual search

Whenever copies of non-patent literature items are included in the search files, they are stored together with the patent documents with the same classification, usually in separate folders (see IX, 2.5). Since experience shows that the importance of many of these non-patent items for purposes of search decreases strongly after a few years (e.g. five years), those that have lost interest can be removed. The periodicals and other non-patent items themselves are stored in library manner and will be kept somewhat longer (e.g. 10 years) for the purpose of later consultation and copying. These items are stored together with non-patent literature kept for other purposes as indicated in IX, 5.

4. Non-patent literature arranged for library-type access

4.1 Composition

In addition to the non-patent literature mainly serving search purposes (see IX, 3), the non-patent literature arranged for library type access also comprises such literature serving primarily as sources of information and education of the examiners both as regards general and background technical information and as regards new technical developments. The EPO subscribes to more than 1000 periodicals, and has about 20 000 technical publications. Furthermore, the collection includes many reports, pamphlets, etc. Internet-based document delivery services of publishing companies are made available to examiners in the form of an Electronic Virtual Library (EVL), which can be used from the examiner's desktop computer.

4.2 Arrangement and location

The technical library of the EPO is strongly decentralised, e.g. to the level of directorates or even individual examiners in exceptional cases. One or more library and reading rooms are present in the building on most floors where examiners are located, with copying facilities close at hand. Documents are normally not to be removed from the library rooms for study, but are to be studied in the library rooms, and then if necessary to be copied for further study or use. An online catalogue is available giving a complete inventory by patent classification and giving the location of the items.

5. Search documentation at the various EPO sites

5.1 Electronic search documentation

The electronic search documentation accessible from all sites of the EPO is the same.

5.2 Search documentation in paper form

The search documentation of the Berlin sub-office in paper form shows the following main differences with respect to that at The Hague: it includes the utility models of the Federal Republic of Germany and the patent documents of Austria and the German Democratic Republic, but includes the patent documents of Belgium and Luxembourg only as from 1978 and does not include the patent documents of the Netherlands.

The maintenance of this documentation in paper form is discontinued for those technical fields where low use is made, either as a result of the increased use of electronic tools or of a concentration of the technical fields in which searches are performed (active fields).

The available non-patent literature in the Berlin sub-office at present contains subscriptions to 360 periodicals including the PCT minimum documentation list of periodicals, as well as about 21 000 books.

6. Search documentation in national offices carrying out transferred searches on behalf of the EPO

6.1 Electronic search documentation provided by the EPO

The EPO provides the national offices of its member states with access to its electronic search documentation as described in IX, 1.3 to 2.3.

For other documentation of the EPO, if delivered by commercial database providers, access can be limited, depending on the conditions of data delivery agreed between the EPO and the data provider. However, separate agreements may exist between national offices and data providers.

6.2 Additional search documentation in national patent offices

Some national patent offices have at their disposal a national documentation collection in paper or electronic form, e.g. in languages other than the official languages of the EPO. This documentation can also be used, where appropriate, for carrying out searches on behalf of the EPO.

Chapter X

Search report

1. General

The results of the search will be recorded in a search report. A number of different possible limitations of the scope of the search report exist. These are:

(i) where claims are deemed abandoned for non-payment of claims fees (Rule 45(3), see III, 3.4);

(ii) a declaration replacing the search report according to Rule 63 (see Chapter VIII);

(iii) an incomplete search report according to Rule 63 and/or Rule 62a see Chapter VIII);

(iv) a partial European search report due to a finding of a lack of unity according to Rule 64(1); and

(v) a supplementary European search report according to Art. 153(7) may be incomplete for the reasons given in (i) or (iii) or may be replaced by a declaration according to (ii) (in the case of unpaid claims fees for a supplementary European search, Rule 162(4) applies).

The search reports of types (i) - (iii), (and (v) (insofar as only (i) - (iii) apply) are transmitted to the applicant, published and serve as a basis for the examination by the Examining Division. A partial search report according to Rule 64(1) (case (iv) above), however, is only transmitted to the applicant, but is made available for inspection in the public part of the examination file according to Art. 128(4).

Rule 62(1)

Subject to the exceptions mentioned in XII, 8, European search reports and supplementary European search reports are accompanied by a search opinion, where the Search Division gives an opinion on whether the application and the invention to which it relates seem to satisfy the requirements of the EPC (see XII, 1.1). Together, the European search report or supplementary European search report and the search opinion constitute the extended European search report (EESR).

The Search Division is responsible for drawing up the European search report. It is also responsible for drafting international search reports and search reports on behalf of the industrial property offices of certain Contracting States (see X, 2 and II, 4.4 to 4.6).

This chapter contains the information which is necessary to enable the examiner to correctly prepare the search report.

A search report must contain no matter, in particular no expressions of opinion, reasoning, arguments or explanations, other than that required by the form or referred to in III, 1.1 and 1.2, or X, 9.2(viii). However, this does not apply to the search opinion (see XII, 3).

2. Different types of search reports drawn up by the EPO

The EPO will draw up the following types of search reports:

(i) European search reports (see II, 4.1);

(ii) supplementary European search reports concerning PCT applications (see II, 4.3);

(iii) international search reports under the PCT (see II, 4.4);

(iv) international-type search reports (see II, 4.5);

(v) search reports drawn up on behalf of national offices (see II, 4.6); and

(vi) search reports further to special work.

Further, in the examination procedure, accounts containing the results of additional searches are drawn up when necessary and are not published (see II, 4.2). However, the documents cited therein may be used in the examination procedure (see C-VI, 8.2).

This chapter sets out the requirements for search reports of types (i) to (iv) only, although it is the intention that all search reports drawn up by the EPO are as similar as possible.

3. Form and language of the search report

3.1 Form

The standard search report is prepared by the examiner and contains a main page to be used for all searches for recording the important features of the search, such as:

(i) the application number;

(ii) the classification of the application;

(iii) the fields searched;

(iv) the relevant documents revealed by the search; and

(v) the name of the examiner who executed the search,

as well as supplemental sheet A and, in certain cases, also supplemental sheet B.

Supplemental sheet A is to be used for indicating approval or modifications of the title, the abstract as submitted by the applicant, and the figure to be published with the abstract and for giving the translation of the title into the two other official languages (see X, 7).

Supplemental sheet B is to be completed where there are restrictions on the search, i.e. when claims incurring fees are not searched due to non-payment of claims fees (see III, 3.4), when unity of invention is lacking (see Chapter VII), when a meaningful search is not possible such that the search report is an incomplete one or is completely replaced by a declaration according to Rule 63 (see VIII, 3) or when the search is limited according to Rule 62a (see VIII, 4).

Dates appearing in the report should be expressed according to the WIPO standard ST. 2.

3.2 Language

The search report or the declaration accompanying or replacing it according to Rule 63 should be drawn up in the language of the proceedings. *Art. 14(3)* *Rule 61(5)*

4. Identification of the patent application and type of search report

On the main page and supplemental sheets, the European patent application is identified by its filing number.

The type of the search report is indicated in the report.

In case of a joint publication of the application and the search report, the main page of the report is marked A1 (WIPO Standard ST. 16). If publication of the application is due before the search, the main page is marked A2 (WIPO Standard ST. 16). The subsequent search report is established on a new main page which is marked A3 (WIPO Standard ST. 16). Where the search report is a supplementary European search report in respect of an international application, this search report is established on a new main page marked A4 (WIPO Standard ST. 16). *Art. 153(7)*

5. Classification of the patent application

The main page of the report gives the official classification symbol(s) for the European patent application in accordance with V, 4.

If the application is to be published before the search report is prepared (A2 publication, see X, 4), the examiner prepares supplemental sheet A before the publication of the application. In such cases, supplemental sheet A will contain all of the requisite information indicated in X, 7, and also the official classification of the application (in cases where the application lacks unity, see V, 7).

When subsequently the search report is established (A3 publication, see X, 4), the official classification of the application is repeated on

the separately published search report. Where the examiner has modified the official classification (i.e. the official classification as given in the A2 published application differs from that given on the later published A3 search report – see V, 4), it is this amended classification which will appear on the later published A3 search report (see V, 5).

6. Areas of technology searched

Although the EPC does not require the European search report to identify the areas of technology searched, this information is included in the report in the form of a list of IPC symbols up to the sub-class level.

Where the search report is entirely or partly based on a previous search made for an application relating to a cognate subject, the sections of the documentation consulted for this previous search are also identified in the report as having been consulted for the application in question. This is done by indicating the appropriate IPC symbols.

7. Title, abstract and figure(s) to be published with the abstract (as indicated on supplemental sheet A)

Supplemental sheet A is prepared by the examiner before publication of the application, regardless of whether this is with the search report (A1 publication) or without it (A2 publication). The information contained in supplemental sheet A is needed for the publication of the application.

On supplemental sheet A, the examiner indicates:

Rule 47(1)
Rule 66

(i) approval or amendment of the text of the abstract , the content of which is communicated to the applicant according to Rule 66 (see Chapter XI and A-III, 10);

In exceptional cases, the examiner may change the abstract after the search has been carried out. However, if this is done after the application has been published A2, supplemental sheet A is not reissued;

Rule 41(2)(b)

(ii) approval or amendment of the title of the invention (see A-III, 7);

Rule 47(4)

(iii) approval, modification or abolition of the selection of the figure which is to accompany the abstract (see XI, 3(vi) and XI, 4); and

Art. 14(7)(a)

(iv) the translation of the title of the European application into the two other official languages.

The European Patent Bulletin is published in all three official languages of the EPO according to Art. 14(7)(a) and contains the

entries made in the Register of European Patents, which, according to Rule 143(1)(c), must contain the title of the invention. Consequently, the title is required in all three official languages of the EPC.

The above applies equally to applications published with the search report (A1 publication) and those published without it (A2 publication). In the case of an A2 publication, supplemental sheet A further contains the official classification of the application (see X, 5). In case of an A1 publication, the official classification appears only on the search report (Rule 61(6)).

Supplemental sheet A also indicates the nature of the publication to which it relates (A1 or A2).

In the case of a supplementary European search report in respect of an international application, supplemental sheet A should be marked A4. The examiner does not determine the title, abstract or figure to be published with the abstract, since these have already been determined by the International Searching Authority according to Rules 37.2, 38.2(a) and 8.2 PCT, respectively.

8. Restriction of the subject of the search

In the following cases, the search report, the declaration replacing it, or the incomplete or partial search report will indicate whether the subject of the search was restricted and which claims have or have not been searched:

(i) claims above the number of fifteen for which no additional fee has been paid (see III, 3.4). The claims not searched are identified. This only applies to European and supplementary European search reports; *Rule 45(1) and (3)* *Rule 162(1) and (4)*

(ii) lack of unity of invention (see VII). The different inventions must be mentioned by indicating their subject-matter and the claims relating thereto (in part or in full; see Rule 44(2). For the partial search report (see VII, 1.1), an indication is made that it has been established for the invention first mentioned in the claims. This applies to a priori lack of unity and to a posteriori lack of unity. For the search report which will be drawn up for all those inventions in respect of which search fees have been paid, the different inventions (and corresponding claims in full or in part) which have been searched are indicated in the search report; *Rule 64(1)*

Rule 63
Art. 52(2)
Art. 53

(iii) claims in respect of which a meaningful search cannot or only an incomplete search can be carried out (see VIII). A declaration is made either:

(a) that a meaningful search has not been possible on the basis of all claims (this declaration replaces the search report); or

(b) that a meaningful search has not been possible for one or more of the claims in part or in full. In this case, the claims concerned are mentioned in the declaration accompanying the incomplete search report.

In both cases (a) and (b), the reasons for not carrying out or restricting the search should be indicated (for example: subject-matter not patentable; insufficiently clear claims);

Rule 62a

(iv) claims in respect of which a search was not carried out due to non-compliance with Rule 43(2) (see VIII, 4.2).

9. Documents noted in the search

9.1 Identification of documents in the search report

9.1.1 Bibliographic elements

All documents cited in the search report must be identified unambiguously by indicating the necessary bibliographic elements. All citations in the search report should comply with WIPO Standard ST. 14 (Recommendation for the inclusion of references cited in patent documents), WIPO Standard ST. 3 (Two-letter codes) and ST. 16 (Standard code for identification of different kinds of patent documents). This does not exclude deviations in those special cases where strict adherence, whilst not necessary for the clear and easy identification of a document, would require considerable extra cost and effort.

9.1.2 "Corresponding documents"

The examiner will often be confronted by the existence of "corresponding" documents (see VI, 6.2), that is to say documents which have the same or substantially the same technical content. These usually fall into one of two groups, namely patent documents from a patent family and abstracts:

(i) patent documents in the same patent family

These are patent documents from the same country or from different countries, and which share at least one claimed priority.

If a cited patent document belongs to a patent family, the examiner need not cite all the members of the family which are known or accessible to him, since these are already mentioned in the annex to

the search report. However, he may mention one or more members in addition to the one cited (see IV, 3.1). Such documents should be identified by the Office of origin, type and number of document, and preceded by the sign ampersand (&). There are a number of possible reasons why the examiner may wish to draw attention in the search report to more than one document in the same patent family, including the following:

(a) one document of the patent family is published before the earliest priority date of the application, but is published in a non-EPO language, whereas a different member of the same patent family is published in an EPO language (see Art. 14(1)), but after the earliest priority date of the application.

Example:

A European application claims a priority of 3 September 1999. In the search on this application, a relevant document – WO 99 12395 A – is found. This document is published in Japanese on 11 March 1999 – in time to constitute prior art according to Art. 54(2). There also exists the European family member published in an English translation according to Art. 153(4) on 1 March 2000 – too late to constitute prior art according to Art. 54(2), but cited in the search report as an "&" document of the Japanese-language WO publication and sent to the applicant (see X, 11.3). It will be used in examination of the application to interpret the content of the Japanese language WO publication (see C-IV, 5.4). In the search report, these documents would be cited as follows (for the mentioning of the claims to which the cited documents relate, here claims 1-10, see X, 9.3):

X	WO 99 12395 A (SEKI SHUNICHI; KIGUCHI HIROSHI (JP); SEIKO EPOSON CORP (JP)) 11 March 1999 (1999-03-11) * figure 1 * & EP 0 982 974 (SEIKO EPSON CORP) 1 March 2000 (2000-03-01) * figure 1 * * claim 1 *	1-10

(b) different documents in the same patent family each containing relevant technical subject-matter not present in the other family members;

(c) where a family member is cited in the application in a non-EPO language and there exists another family

member in an EPO language, where these are both published before the earliest priority date.

Example:

Y	WO9001867 A (WIDEGREN LARS (SE)) 8 March 1990 (1990-03-08) * claim 1 *	1-10
D,Y	& SE461824 B (WIDEGREN LARS (SE)) 2 April 1990 (1990-04-02)	1-10

The fact that the applicant has already cited the relevant SE document in the application, which is a family member of the relevant WO document, means that the applicant has already satisfied the requirement that he mention in the description the state of the art (Rule 42(1)(b)). It is of value to the Examining Division that this be made known in the search report (see C-II, 4.3).

(ii) abstracts of documents (see VI, 6.2)

These are provided by one of a number of database providers (for example Chemical Abstracts, Derwent or Patent Abstracts of Japan) and may relate to many different types of disclosure such as patent documents, journal articles, PhD theses, books etc. The abstract provides a summary of the most important aspects of the technical content of the original document. Most abstracts cited are in the English language. In all cases where an abstract is cited in the search report, the examiner must input the original document to which the abstract relates after the "&" sign.

Example:

Y	PATENT ABSTRACTS OF JAPAN vol. 002, no 148 (C-030) 9 December 1978 (1978-12-09) & JP 53 113730 A (TOSHIBA CORP) 4 October 1978 (1978-10-04) * abstract *	1-10

The examiner may choose to cite the abstract (in which case the original document must be cited as an "&" document) rather than cite the original document for one of a number of reasons. These reasons include: the original document is not easily available to the examiner

(for example, retrieval of PhD theses); or the original document is in a non-EPO language and no other corresponding document exists (for example, a Japanese patent document with no family members, or a journal article in Russian).

9.1.3 Languages of the documents cited

Frequently, members of the same patent family are published in a number of different languages. Consequently, the examiner has a choice regarding the language of the document which is cited in the search report. If the relevant technical content does not differ between the various family members and they are all published before the earliest priority date of the application, then all of the members of the family are of equal relevance to the application. In such cases, the examiner should choose the document to be cited by virtue of its language of publication and according to the following list, the most preferred language being given first:

(1) an official language of the EPO (i.e. English, French or German (Art. 14(1));

(2) an official language of a Contracting State of the EPC according to Art. 14(4) (see A-VIII, 1.1). Such documents can usually be read by a colleague if the examiner in question is not familiar with this language (see VI, 6.2);

(3) a language other than any of those of the Contracting States of the EPC.

In the cases (2) and (3), the examiner might consider citing an abstract in an official language of the EPO, instead of the original document.

9.1.4 Supplementary European search report

In the case of a supplementary European search report according to Art. 153(7), it is also permissible under certain circumstances to have no documents at all cited on the supplementary European search report (see IV, 2.5). In such cases, the expression "No further relevant documents disclosed" will appear in the search report. However, in such cases, the search opinion (if applicable, see XII, 8) will give an opinion on the patentability of the claimed invention over the state of the art cited in the International Search Report (XII, 1.1).

9.2 Categories of documents (X, Y, P, A, D, etc.)

All documents cited in the search report are identified by placing a particular letter in the first column of the citation sheets. Where needed, combinations of different categories are possible. The following letters are used:

(i) particularly relevant documents

Art. 52(1)
Art. 54
Art. 56

Where a document cited in the European search report is particularly relevant, it should be indicated by the letter "X" or "Y". Category "X" is applicable where a document is such that **when taken alone**, a claimed invention cannot be considered novel or cannot be considered to involve an inventive step.

Art. 52(1)
Art. 56

Category "Y" is applicable where a document is such that a claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other documents of the same category, such combination being obvious to a person skilled in the art. However, if a document (a so-called "primary document") explicitly refers to another document as providing more detailed information on certain features (see C-IV, 7.1) and the combination of these documents is considered particularly relevant, the primary document should be indicated by the letter "X", i.e. not "Y", and the document referred to should be indicated as "X" or "L" as appropriate;

(ii) documents defining the state of the art and not prejudicing novelty or inventive step

Where a document cited in the European search report represents state of the art not prejudicial to the novelty or inventive step of the claimed invention, it should be indicated by the letter "A" (see, however, III, 1.1);

(iii) documents which refer to a non-written disclosure

Rule 61(4)

Where a document cited in the search report refers to a non-written disclosure, the letter "O" should be entered (see VI, 2). Examples of such disclosures include conference proceedings. In cases where the oral disclosure took place at an officially recognised exhibition (Art. 55(1)(b)), see VI, 5.5. The document category "O" is always accompanied by a symbol indicating the relevance of the document according to (i) or (ii), for example: "O, X"; "O, Y"; or "O, A";

(iv) intermediate documents

Rule 61(3)

Documents published on dates falling between the date of filing of the application being examined and the date of priority claimed, or the earliest priority if there is more than one (see VI, 5.2 and XII, 4), should be denoted by the letter "P". The letter "P" should also be given to a document published on the very day of the earliest date of priority of the patent application under consideration. The document category "P" is always accompanied by a symbol indicating the relevance of the document according to (i) or (ii), for example: "P, X"; "P, Y"; or "P, A";

(v) documents relating to the theory or principle underlying the invention

Where a document cited in the search report may be useful for a better understanding of the principle or theory underlying the invention, or is cited to show that the reasoning or the facts underlying the invention are incorrect, it should be indicated by the letter "T";

(vi) potentially conflicting patent documents

Any patent document bearing a filing or priority date earlier than the filing date of the application searched (not the priority date – see VI, 3 and XII, 4) but published later than that date and the content of which would constitute prior art relevant to novelty (Art. 54(1)) should be indicated by the letter "E". Where the patent document and the application searched have the same date (see C-IV, 7.4), the patent document should also be identified by the letter "E". An exception is made for patent documents based on the claimed priority under consideration; these documents should not be cited; *Art. 54(3)* *Art. 139(2)*

(vii) documents cited in the application

When the search report cites documents already mentioned in the description of the patent application for which the search is carried out, these should be denoted by the letter "D" (see IV, 1.3); *Rule 42(1)(b)*

(viii) documents cited for other reasons

Where in the search report any document is cited for reasons (in particular as evidence – see XII, 5) other than those referred to in the foregoing paragraphs, for example: *Art. 117(1)(c)*

(a) a document which may throw doubt on a priority claim (see VI, 5.3);

(b) a document which establishes the publication date of another citation (see XII, 5); or

(c) a document relevant to the issue of double patenting (see IV, 2.3(v), and C-IV, 7.4),

such document should be indicated by the letter "L". Brief reasons for citing the document should be given. The citation of documents of this type need not be linked to any of the claims. However, where the evidence which they provide relates only to certain claims (for example the "L" document cited in the search report may invalidate the priority claim in respect of

certain claims only), then the citation of the document should be linked to those claims, in the manner indicated in X, 9.3.

9.3 Relationship between documents and claims

Rule 61(2)

Each document cited in the search report should be accompanied by an indication of the claims to which it relates, unless the document is indicated by category letter "L" (see X, 9.2(viii)). One and the same document may be indicated by different categories with respect to different claims, wherein each category is associated with particular claims. For example:

X	WO9001867 A (WIDEGREN LARS (SE)) 8 March 1990 (1990-03-08)	1
Y	* column 3, line 27 - line 43; figure 1 *	2-5
A	* figure 2 *	6-10

The above example means that the cited document discloses subject-matter which prejudices the novelty or inventive step of the subject-matter of claim 1 and the inventive step of the subject-matter of claims 2 to 5, when combined with another document cited in the search report, and that it represents non-prejudicial state of the art for the subject-matter of claims 6 to 10. The passages or figures are not necessarily relevant to the claims and the category indicated on the same line.

Furthermore, each independent claim should be mentioned in the search report at least once in relation to at least one document published before the earliest priority date (unless the independent claim in question is excluded from the search by virtue of a restriction of the subject of the search mentioned in X, 8) (see IV, 2.5).

10. Authentication and dates

The date on which the search report was drawn up is indicated in the report. This date should be that of the drafting of the report by the examiner who carried out the search.

The name of the examiner must appear on the search report.

11. Copies to be attached to the search report

11.1 General remarks

Rule 65

The search report is sent to the applicant and transmitted to the Examining Division. In both cases, the report must be accompanied by copies of all documents cited (see also IV, 3.3), except those documents appearing in the search report after the "&" symbol, which are not designated for copying and communication to the applicant (see X, 11.3).

These cited documents are used to assess the patentability of the claimed invention (see XII, 3) both in the search opinion (if applicable, see XII, 8) and in the examination procedure.

11.2 Electronic version of document cited

In the case of a patent document, a complete copy is supplied even if the patent is bulky.

In cases where part or all of the document is published only by electronic means (see Rule 68(2) and OJ 7/2000, 367), an electronic version of at least those parts of the document not available in paper form will be made available to the applicant. This must be done in such a way that the applicant is provided with the whole document either in a combination of paper and electronic forms or in electronic form only.

11.3 Patent family members; the "&" sign

In the case of patent families, only a copy of the member of the family actually cited is normally supplied. The other members are mentioned in an annex systematically produced by the computer for information only (see X, 9.1.2). However, in certain circumstances one or more further patent documents in the same patent family may be mentioned on the search report after the "&" sign (see X, 9.1.2(i)). In these cases, the examiner may designate that a patent document appearing after the "&" sign is also copied and forwarded to the applicant (this document will then also be included in the examination file and may be referred to in the search opinion, if applicable, see XII, 8).

11.4 Reviews or books

In the case of a review or a book, copies should be made of the title page and the relevant pages of the publication concerned.

11.5 Summaries, extracts or abstracts

Where a document cited is a summary, extract or abstract of another document, published separately, a copy of the summary, extract or abstract is forwarded to the applicant along with the report.

If, however, the Search Division considers that the entire document is required, that document must be cited and a copy must be attached to the report (see X, 9.1.2(ii)). In the case of a reference obtained by an online search for which neither the printed version from the database (e.g. COMPDX, PAPERCHEM2 and NTIS) nor the original article is available at the EPO at the time of drafting the search report, the print-out is added to the file in lieu of the original. This may also be done where the printed form of the abstract is available, but where there is no difference in the relevant technical content between the abstract derived from the database print-out and the printed version thereof.

12. Transmittal of the search report and search opinion (if applicable)

Rule 65
Rule 61(1)

The EPO forwards the search report, the search opinion (if applicable, see XII, 8) and copies of all cited documents to the applicant, see X, 11.1), including those documents appearing after the "&" sign and designated to be copied and sent to the applicant (see X, 11.3).

Chapter XI

The abstract

1. Purpose of the abstract

The application must contain an abstract. The purpose of the abstract is to give brief technical information about the disclosure as contained in the description, claims and any drawings. *Rule 57(d)* *Rule 47(5)*

2. Definitive content

The abstract is initially supplied by the applicant. The examiner has the task of determining its definitive content, which will normally be published with the application. In doing this, he should consider the abstract in relation to the application as filed (see IV, 1.4). If the search report is published later than the application, the abstract, published with the application will be the one resulting from the examination referred to in IV, 1.4, third sentence. *Rule 66* *Rule 68*

In determining the definitive content, the examiner should take into consideration that the abstract is merely for use as technical information and in particular must not be used for the purpose of interpreting the scope of the protection sought. The abstract should be so drafted that it constitutes an efficient instrument for purposes of searching in the particular technical field and should in particular make it possible to assess whether there is need for consulting the European patent application itself. *Art. 85* *Rule 47(5)*

3. Content of the abstract

The abstract must:

(i) indicate the title of the invention *Rule 47(1)*

(ii) indicate the technical field to which the invention pertains; *Rule 47(2)*

(iii) contain a concise summary of the disclosure as contained in the description, claims and drawings, which must be so drafted as to allow a clear understanding of the technical problem, the gist of the solution of that problem through the invention and the principal use of the invention and, where applicable, it should contain the chemical formula which, among those contained in the application, best characterises the invention; *Rule 47(2)*

(iv) **not** contain statements on the alleged merits or value of the invention or its speculative application; *Rule 47(2)*

(v) preferably not contain more than one hundred and fifty words; and *Rule 47(3)*

(vi) be accompanied by an indication of the figure or exceptionally more than one figure of the drawings which should accompany *Rule 47(4)*

the abstract. Each main feature mentioned in the abstract and illustrated by a drawing, should be followed by a reference sign in parenthesis.

4. Figure accompanying the abstract

Rule 47(4)

The examiner should consider not only the text of the abstract but also the selection of the figures for publication with it. He should alter the text to the extent that this may be necessary in order to meet the requirements set out in XI, 3. He will select a different figure, or figures, of the drawings if he considers that they better characterise the inventions.

The examiner may prevent the publication of any drawing with the abstract, where none of the drawings present in the application is useful for the understanding of the abstract. This can be done even when the applicant has requested that a particular drawing or drawings be published with the abstract according to Rule 47(4).

In determining the content of the abstract, the examiner should concentrate on conciseness and clarity, and refrain from introducing alterations merely for the purpose of embellishing the language (see X, 7).

5. Checklist

In considering the abstract, the examiner should check it against the General Guidelines for the Preparation of Abstracts of Patent Documents, using the checklist contained WIPO Standard ST. 12, the relevant parts of which are annexed to this Chapter.

6. Transmittal of the abstract to the applicant

Rule 66

The content of the abstract is transmitted to the applicant together with the search report (see X, 7(i)).

Chapter XI – Annex
Checklist for considering the abstract (see XI, 5)

In the following checklist, the abstractor should, after having studied the disclosure to be abstracted, place a check in the second column after the applicable terms listed in the first column. The requirements listed in the third column corresponding to the checked items of the first column should be borne in mind by the abstractor as he prepares his abstract. Finally, the abstractor may compare his finished abstract with the checked requirements and place a corresponding checkmark in the fourth column if he is satisfied that the requirements have been met.

If the invention is a(n)	Check here	The abstract should deal with:	If so, check here
Article		its identity, use; construction, organization, method of manufacture	
Chemical compound		its identity (structure if appropriate); method of preparation, properties, uses	
Mixture		its nature, properties, use; essential ingredients (identity, function); proportion of ingredients, if significant; preparation	
Machine, apparatus, system		its nature, use; construction, organization; operation	
Process or operation		its nature and characterizing features; material and conditions employed; product, if significant; nature of and relationship between the steps, if more than one	
If the disclosure involves alternatives		the abstract should deal with the preferred alternative and identify the others if this can be done succinctly; if this cannot be done, it should mention that they exist and whether they differ substantially from the preferred alternative	

Total number of words less than 250:…..... in range 50-150: ……...

Ref: Standards – ST. 12/A, April 1994

Original: Handbook on Industrial Property Information and Documentation, Publication N° 208(E), 1998, WIPO, Geneva (CH).

Chapter XII

The search opinion

1. Search opinion is part of the EESR

The extended European search report (EESR) is made up of two components: *Rule 62(1)*

(i) the European search report or the supplementary European search report (see Chapter X)

(ii) the search opinion

1.1 The search opinion

For European applications filed as of 1 July 2005 and international applications filed as of that date entering the European phase, European search reports and supplementary European search reports will be accompanied by an opinion on whether the application and the invention to which it relates seem to meet the requirements of the EPC.

The above applies except in the cases referred to in XII, 8.

The findings of the search opinion must be consistent with the document categories assigned in the search report and must also be consistent with any other issues raised in the search report, such as lack of unity of invention or limitation of the search.

1.2 Position of the Examining Division

The Examining Division will consider both the objections raised in the search opinion and the applicant's response thereto (see XII, 9) when examining the application further. It may change the position adopted in the search opinion after receiving arguments, amendments and other submissions from the applicant in response to the search opinion or subsequently in examination proceedings. The position may also alter, irrespective of the applicant's submissions, where the top-up search could not be completed when the search was performed and Art. 54(3) state of the art is found in a top-up search by the Examining Division or further state of the art is brought to the attention of the Examining Division by the applicant or by means of observations according to Art. 115 (see also IV, 3.2, C-VI, 8.2 and 8.3).

The Examining Division may also reverse the findings of the search opinion for reasons other than those above (see III, 1.1), however, such cases should be exceptional.

2. Basis of the search opinion

Where the application is a European application not derived from an International application, the applicant cannot amend his application *Art. 123(1)* *Rule 137(1)*

before the search report has been communicated to him. Consequently, in these cases, the search opinion will always relate to the application documents as originally filed. Furthermore, any reply filed by the applicant in response to an invitation according to Rule 63(1) (see B-VIII, 3.4) will also be taken into consideration when drawing up the search opinion.

Rule 161(2)
Rule 159(1)(b)
Art. 19 PCT
Art. 34(2)(b) PCT

However, where the application under consideration derives from an International application and is subject to a supplementary European search according to Art. 153(7) (see II, 4.3), the applicant will have had the opportunity to amend his application both in the International phase and also upon entry into the European phase. The search opinion will then be based on the application documents constituting the latest filed request from the applicant (this may involve the cancellation of amendments previously filed and consequent reversion in part or in full to an earlier set of application documents). The supplementary European search report is also based on these application documents (see II, 4.3 and III, 3.3).

Where the search opinion and supplementary European search report are based on such amendments but Rule 137(4) has not been satisfied (see C-VI, 5.7), a communication according to Rule 137(4) (see C-VI, 5.7.1) cannot be sent at this stage (before preparation of the search opinion) because the application is not yet under the responsibility of the Examining Division (see C-VI, 1.1). However, once the Examining Division has assumed responsibility for the application, it may send such a communication, provided that the amendments in question have not been withdrawn or superseded (see C-VI, 5.7.1) and only where the application is of one of the types mentioned in C-VI, 5.7.4.

2.1 Applications containing missing parts of description and/or drawings filed under Rule 56 EPC or Rule 20 PCT

If the Receiving Section decided not to re-date the application under Rule 56(2) or (5), but the search examiner is of the opinion that the subsequently filed missing parts are not "completely contained" in the priority document and/or the requirements of Rule 56(3) are not fulfilled, he should carry out the search also taking into account prior art which might become relevant for assessing novelty and inventive step of the subject-matter claimed if the application were re-dated pursuant to Rule 56(2) or (5). The search opinion must include a warning that the application seems not to fulfil the requirements laid down in Rule 56 for maintaining the accorded date of filing, a statement of reasons as to why this is the case and an indication that a formal decision as to whether to re-date the application will be taken at a later stage by the Examining Division. If appropriate, the search opinion may also include comments about the effect of re-dating on the priority claim and/or the status of the prior art documents cited in the search report.

The procedure for a Euro-PCT application is similar to that set out above. If when carrying out a supplementary European search the examiner finds that the subsequently filed missing parts are not "completely contained" in the priority document, despite the fact that the Receiving Office did not re-date the application under Rule 20.5(d) PCT, the search opinion must include a warning that the application seems not to comply with the requirements of Rule 20.6 PCT (Rule 82ter.1(c) PCT), a statement of reasons as to why this is the case and an indication that a formal decision as to whether to re-date the application will be taken at a later stage by the examining division.

However, if the application has been re-dated by the Receiving Section or receiving Office, but the search examiner has reasons to believe that the application meets the requirements of Rule 56(3) (or Rule 20.6 PCT), he must indicate in the search opinion that decisions given by the Receiving Section (or the receiving Office) may be reconsidered at a later stage by the Examining Division, except where the latter is bound by a decision of the Board of Appeal.

2.2 Applications containing claims filed after the accorded date of filing

Where the application documents contain one or more claims filed after the accorded date of filing (Rules 40(1), 57(c) and 58), the search examiner is required to examine whether or not the one or more claims fulfil the requirements of Art. 123(2) in the light of the technical content of the application documents filed at the accorded date of filing. If the claims do not meet the requirements of Art. 123(2), the search (if possible) will be based on the embodiments disclosed in the application documents as filed. This should be indicated in the search opinion together with a reasoned explanation as to why the search is incomplete. In extreme cases a declaration of no search under Rule 63 may need to be issued (see VIII, 3.1 to 3.4 for details of the procedure).

Where the search opinion and search report are based on late-filed claims but Rule 137(4) has not been satisfied (see C-VI, 5.7), a communication according to Rule 137(4) (see C-VI, 5.7.1) cannot be sent at this stage (before preparation of the search opinion) because the application is not yet under the responsibility of the Examining Division (see C-VI, 1.1). However, once the Examining Division has assumed responsibility for the application, it may send such a communication, provided that the late-filed claims have not been superseded (see C-VI, 5.7.1) and only where the application is of one of the types mentioned in C-VI, 5.7.4.

3. Analysis of the application and content of the search opinion

Where it is held that the application and/or the invention to which it relates does not satisfy the requirements of the EPC, then corresponding objections are raised in the search opinion.

The search opinion should, as a general rule, cover all objections to the application (but see XII, 3.4). These objections may relate to substantive matters (e.g. the subject-matter of the application is not patentable) or to formal matters (e.g. failure to comply with one or more of the requirements specified in Rules 41 to 43, 46, 48, 49 and 50) or to both.

Art. 53(c) Where claims relating to a method of treatment of the human or animal body or methods of diagnosis practiced on the human or animal body have been searched because their reformulation into an allowable format can be envisaged at the time of the search (see VIII, 2), the search opinion should, nonetheless, object to these claims as relating to subject-matter which is excluded from patentability.

3.1 The examiner's dossier

Rule 62 The examiner's first step is to study the description, drawings (if any) and the claims of the application. In carrying out his task, the examiner will have access to the documents making up the European application and a complete history of the proceedings up to the start of search. However, the priority documents together with any translations may not yet be available at this stage (see XII, 4).

3.2 Reasoned objections

For each objection the search opinion should indicate the part of the application which is deficient and the requirement of the EPC which is not met, either by referring to specific Articles or Rules, or by other clear indication; it should also give the reason for any objection where this is not immediately apparent. For example, where prior art is cited and only part of a cited document is relevant, the particular passage relied upon should be identified. If the cited prior art is such as to demonstrate lack of novelty or inventive step in the independent claim or claims, and if, consequently, there is lack of unity between dependent claims (see C-III, 7.8), the applicant should be informed of this situation (see C-VI, 5.2(i)). Substantive matters should normally be set out first. The search opinion should be drafted in such a manner as to facilitate later examination of the amended application and, in particular, to avoid the need for extensive rereading (see C-VI, 4.2).

3.3 Comments and amendments in response to the search opinion

Subject to certain exceptions, the applicant is required to respond to the search opinion (see XII, 9).

3.4 Extent of first analysis

It is emphasised that the first sentence of XII, 3 only sets out the general rule. There may be cases in which the application is generally deficient. In these cases the examiner should not carry out a detailed analysis, but should send a search opinion to the applicant informing him of this fact, mentioning the major deficiencies and saying that

when the application enters the examination stage, further examination will be deferred until these have been removed by amendment. There may be other cases in which, although a meaningful analysis is possible, a fundamental objection arises, e.g. it is clear that certain claims lack novelty and that the statement of claim will have to be drastically recast, or there are substantial amendments (International applications entering the European phase - see XII, 2) which are not allowable either because they introduce new matter not present in the application as filed (Art. 123(2)), or they introduce other deficiencies (e.g. the amendment makes the claims unclear - Art. 84). In such cases, it may be more appropriate to deal with this objection before making a detailed analysis; if, e.g. the claims need recasting, it may be pointless to raise objections to the clarity of some dependent claims or to a passage in the description which may have to be amended or even deleted in examination proceedings as a consequence. However, if there are other major objections these should be dealt with. Generally, the examiner should seek to make the maximum impact in the search opinion with the broad aim of facilitating as efficient a decision making process as possible in later examination proceedings.

3.5 Contribution to the known art

Rule 42(1)(c)

When analysing the application, the examiner should concentrate on trying to understand what contribution the invention as defined in the claims adds to the known art. This should normally be sufficiently clear from the application as filed. If it is not, an objection should be raised in the search opinion (see C-II, 4.5); but the examiner should not raise an objection of this kind unless he is convinced it is necessary, since to do so might result in the applicant introducing additional subject-matter and thus offending against Art. 123(2) (see C-VI, 5.3 to C-VI, 5.3.11).

3.6 EPC requirements

Although the examiner must bear in mind all the requirements of the EPC, the requirements which are most likely to require attention in the majority of cases are, in particular: sufficiency of disclosure (see C-II, 4); clarity and support in the description, especially of the independent claims (see C-III, 4 and 6); novelty (see C-IV, 9); and inventive step (see C-IV, 11).

3.7 Examiner's approach

The examiner should not require or suggest amendments merely because he thinks they will improve the wording of the description or claims. A pedantic approach is undesirable; what is important is that the meaning of the description and claims should be clear. Also, while any serious inconsistencies between the claims and the description as filed should be objected to (see C-III, 4.3), if the claims appear to require substantial amendment, adaptation of the description to the amended claims is better left until the final form of at least the main claims has been settled in examination proceedings.

3.8 Making suggestions

It must be emphasised that it is not part of the duty of an examiner to require the applicant to amend the application in a particular way to meet an objection, since the drafting of the application is the applicant's responsibility and he should be free to amend in any way he chooses provided that the amendment removes the deficiency and otherwise satisfies the requirements of the EPC. However, it may sometimes be useful if the examiner suggests at least in general terms an acceptable form of amendment, but if he does so he should make it clear that the suggestion is merely for the assistance of the applicant and that other forms of amendment will be considered in examination proceedings.

3.9 Positive opinion

After the analysis referred to in XII, 3.1 to XII, 3.8 has been made, the Search Division may come to the conclusion that the application and the invention to which it relates both satisfy the requirements of the EPC. In this case the search opinion contains a statement giving a general positive opinion on the application documents. However, where it is not possible to conclude the search for all potentially conflicting applications according to Art. 54(3) at the time of the search (see VI, 4.1), a top-up search will have to be carried out in the examination procedure. (see C-VI, 8.1) and subsequently objections according to Art. 54(3) will be raised if appropriate.

Where minor amendments of the application documents would be necessary for the application to proceed to grant, a positive search opinion can still be issued. Thereafter, subject to no prior art according to Art. 54(3) being found in any subsequent top-up search, the Rule 71(3) communication can then be issued in examination proceedings, with those minor amendments being made by the Examining Division according to C-VI, 14.1.

In the above cases, the applicant is not required to respond to the search opinion (see XII, 9).

4. Priority claim and the search opinion

When it is not possible to check the validity of the priority claim at the search stage, because:

(i) the search is carried out before the date on which the priority document must be supplied (up to 16 months from the earliest claimed priority - Rule 53(1)

(ii) a translation of the priority document is required but not available to the Search Division at the time of drafting the search opinion (Rule 53(3) and C-V, 3.4)

then, for the purposes of drafting the search opinion, the priority claim will usually be assumed to be valid.

However, if an assessment of the validity of the priority claim is necessary as a result of intermediate prior art or potential state of the art according to Art. 54(3), and evidence is already available undermining the validity of the priority claim, then this should be brought up in the search opinion. For example, where the priority document is available at the time of drafting the search opinion and technical features of the claims are not present in the priority document, this may even be possible where a translation is required, but the examiner is familiar with the language of the priority document (see also VI, 5.3).

5. Matters of doubt in the state of the art

Since decisions with respect to novelty are not the responsibility of the Search Divisions but of the Examining Divisions (see III, 1.1), the Search Divisions should not discard documents because of doubt as regards for example the exact date of publication or public availability, or the exact contents of an oral disclosure, exhibition, etc. to which such documents may refer. The Search Division should try to remove any doubt that may exist but should nevertheless always cite the documents concerned in the search report. Additional documents providing evidence in the matters in doubt may be cited (see X, 9.2(viii)).

Any indication in a document of the date of its publication should be accepted as correct unless sound reasons for contesting this are given, e.g. by the Search Division, showing earlier publication, or in examination proceedings by the applicant, showing later publication. If the indicated date of publication is insufficiently precise (e.g. because only a month or year is given) to establish whether publication was before the reference date for the search, the Search Division should endeavour to establish the exact date with sufficient precision for the purpose. A date of receipt at the EPO stamped on the document, or a reference in another document, which must then be cited (see X, 9.2(viii)), may be of assistance in this respect. In the preparation of the search opinion and during substantive examination, the public availability of a document may be investigated (see C-IV, 6.1).

6. Unity in relation to the search opinion

Where the Search Division finds that the claimed invention does not meet the requirement of unity of invention (Art. 82 and Rule 44(1) and (2)), the Search Division sends the applicant an invitation to pay additional search fees and the partial search report relating to the invention or unitary group of inventions first mentioned in the claims (see VII, 1.1, 1.2 and 1.3 and Rule 64(1)). The invitation and partial search report are not accompanied by a search opinion.

After the time limit for payment of the additional search fees has expired, (Rule 64(1)) the applicant is sent a search report relating to the invention or unitary group of inventions first mentioned in the claims and all other claimed inventions or unitary groups of inventions

in respect of which additional search fees have been paid. This is accompanied by a search opinion containing:

(i) the reasoning behind the lack of unity

(ii) an opinion on the first invention or unitary group of inventions mentioned in the claims

(iii) an opinion on all inventions or unitary groups of inventions in respect of which additional search fees have been paid

The above applies only to European search reports. For supplementary European search reports on Euro-PCT applications lacking unity of invention, a partial search report is issued directly on the invention first mentioned in the claims only (Rule 164(1) - see VII, 2.4).

7. The search opinion in cases of a limitation of the search

Any argumentation and objections presented in the search opinion must be consistent with limitations of the search and the reasons therefor. This applies to limitations for reasons of non-patentability (e.g. business methods - Art. 52(2)(c), see VIII, 1), for reasons of severe deficiencies prejudicing a meaningful search (Rule 63, see VIII, 3) or due to a contravention of Rule 43(2) (Rule 62a, see VIII, 4). In these cases, the search opinion will also contain the information indicated in VIII, 3.3 and 4.3.

8. No search opinion is issued

Where the applicant has filed the request for examination according to Rule 70(1) before the search report has been communicated to him and has waived the right to receive the communication under Rule 70(2) (see C-VI, 1.1.2), the despatch of the search report to the applicant causes the application to enter the competence of the Examining Division (Art. 18(1) and Rule 10(2)).

In this case, where the application contains deficiencies, the Examining Division will issue a communication according to Art. 94(3) in place of the search opinion. Failure to respond to this communication results in deemed withdrawal of the application according to Art. 94(4) (see C-VI, 3.7).

If the application is ready for grant, the procedure is as follows:

(i) Where the search for conflicting applications according to Art. 54(3) was complete:

The Examining Division will issue a communication according to Rule 71(3)

(ii) Where the search for conflicting applications according to Art. 54(3) was not complete:

The applicant is informed that the application is in order for grant, on condition that no state of the art according to Art. 54(3) is found to exist when the top-up search is completed (see XII, 3.9). This is purely for information and no response from the applicant is required.

9. Reaction to the extended European search report (EESR)

The applicant is required to respond to the search opinion within the time limit for filing the request for examination provided for under Rule 70(1) (see C-VI, 1.1). *Rule 70a(1)*

If, however, the applicant filed the request for examination before the search report and the search opinion were transmitted to him (according to Art. 94(1) this also requires payment of the examination fee), he is sent a communication according to Rule 70(2) requesting him to indicate whether he wishes to proceed further with the application within a period to be specified (see C-VI, 1.1.1). In these cases, the applicant must respond to the search opinion within the time period set under Rule 70(2). This always applies to Euro-PCT applications subject to preparation of the supplementary European search report and search opinion (see II, 4.3 and A-VII, 5.3), except where the applicant has waived the communication according to Rule 70(2) (see C-VI, 1.1.2), in which case the procedure under XII, 8 applies. *Rule 70a(2)*

Failure to respond to the search opinion within the applicable period results in the application being deemed to be withdrawn, and the applicant is notified accordingly. In response to this communication of a loss of rights, the applicant can request further processing in accordance with Art. 121 and Rule 135. *Rule 70a(3)* *Rule 112(1)*

There is, however, no requirement for the applicant to respond to the European or supplementary European search report where this was drawn up before 1 April 2010, where it is not accompanied by a search opinion (see XII, 1.1 for applications for which a search opinion is prepared) or where the search opinion was positive (see XII, 3.9). However, in these cases, the applicant *may* still respond to the search report according to Rule 137(2) if he so wishes. In such cases, the applicant is encouraged to respond to the search report before the application enters the examination stage (see C-VI, 1.1).

The applicant responds to the search opinion by filing amended application documents according to Rule 137(2) (see C-VI, 3.2) (where amended claims are filed before publication, see A-VI, 1.3, paragraph 2) and/or by filing his observations on the objections raised in the search opinion, either in addition to, or in place of, such amendments. Such amendments and/or observations will only be examined by the Examining Division if the application enters the

examination stage. Likewise, telephone conversations and personal interviews can only take place after the application has entered the examination stage. The examiner must not consent to these earlier.

Procedural requests, such as a request for a personal interview (see T 861/03) or for oral proceedings, do not constitute a valid reply where these are made without comment on any of the objections raised in the search opinion. In cases where such a request is the only response to the search opinion on expiry of the applicable time limit, the application is deemed to be withdrawn according to Rule 70a(3).

For applications for which a search opinion was prepared but where the search report was drawn up before 1 April 2010, if the applicant does not reply to the search opinion and the application enters the examination stage (see C-VI, 1.1 and C-VI, 1.1.1), a communication referring to the search opinion and setting a time limit for reply will be issued by the Examining Division as the first communication under Art. 94(3) (see C-VI, 3.5). Failure to respond to this communication in due time will result in the application being deemed withdrawn according to Art. 94(4).

Where the applicant files amendments in response to the search opinion, if Rule 137(4) is not complied with (see C-VI, 5.7), a communication according to Rule 137(4) (see C-VI, 5.7.1) may be sent in respect of these amendments only after the application has passed to the responsibility of the Examining Division (see C-VI, 1.1) and only where the application is of one of the types mentioned in C-VI, 5.7.4.

Part C

Guidelines for Substantive Examination

CONTENTS

Chapter I – Introduction **I-1**

1.	General remark	I-1
2.	Work of an examiner	I-1
3.	Overview	I-1

Chapter II – Content of a European patent application (other than claims) **II-1**

1.	General	II-1
2.	Abstract	II-1
3.	Request for grant – the title	II-1
4.	Description	II-2
4.1	General remarks	II-2
4.2	Technical field	II-2
4.3	Background art	II-2
4.4	Irrelevant matter	II-3
4.5	Technical problem and its solution	II-4
4.6	Rule 42(1)(c) vs. Art. 52(1)	II-4
4.7	Drawings	II-4
4.8	Reference signs	II-5
4.9	Sufficiency of disclosure	II-5
4.10	Art. 83 vs. Art. 123(2)	II-6
4.11	Insufficient disclosure	II-6
4.12	Industrial application	II-7
4.13	Manner and order of presentation	II-7
4.14	Terminology	II-7
4.15	Computer programs	II-8
4.16	Physical values, units	II-8
4.17	Proper names, trademarks and trade names	II-8
4.18	Registered trademarks	II-9
4.19	Reference documents	II-9
5.	Drawings	II-10
5.1	Form and content	II-10
5.2	Printing quality	II-10
5.3	Photographs	II-11
6.	Inventions relating to biological material	II-11
6.1	Biological material	II-11
6.2	Public availability of biological material	II-11
6.3	Deposit of biological material	II-12
7.	Prohibited matter	II-14
7.1	Categories	II-14
7.2	Matter contrary to "ordre public" or morality	II-14
7.3	Disparaging statements	II-14

7.4	Irrelevant matter	II-14
7.5	Omission of matter from publication	II-15

CHAPTER II – Annex Units recognised in international practice and complying with Rule 49(11) (see II, 4.16) II-17

1.	SI units and their decimal multiples and submultiples	II-17
1.1	SI base units	II-17
1.1.1	Special name and symbol of the SI unit of temperature for expressing Celsius temperature	II-18
1.2	Other SI units	II-19
1.2.1	Supplementary SI units	II-19
1.2.2	Derived SI units	II-19
1.2.3	Derived SI units having names and symbols	II-19
1.3	Prefixes and their symbols used to designate certain decimal multiples and submultiples	II-20
1.4	Special authorised names and symbols of decimal multiples and submultiples of SI units	II-21
2.	Units which are defined on the basis of SI units but are not decimal multiples or submultiples thereof	II-21
3.	Units used with the SI, and whose values in SI are obtained experimentally	II-21
4.	Units and names of units permitted in specialised fields only	II-22
5.	Compound units	II-22

Chapter III – Claims III-1

1.	General	III-1
2.	Form and content of claims	III-1
2.1	Technical features	III-1
2.2	Two-part form	III-1
2.3	Two-part form unsuitable	III-2
2.3.1	No two-part form	III-3
2.3.2	Two-part form "wherever appropriate"	III-3
2.4	Formulae and tables	III-3
3.	Kinds of claim	III-3
3.1	Categories	III-3
3.2	Number of independent claims	III-3
3.3	Objection under Rule 43(2) or Rule 137(5)	III-4
3.4	Independent and dependent claims	III-5
3.5	Arrangement of claims	III-6
3.6	Subject-matter of a dependent claim	III-6
3.7	Alternatives in a claim	III-6
3.8	Independent claims containing a reference to another claim	III-6
4.	Clarity and interpretation of claims	III-7
4.1	Clarity	III-7
4.2	Interpretation	III-7

4.3	Inconsistencies	III-8
4.4	General statements, "spirit" of invention	III-9
4.5	Essential features	III-9
4.6	Relative terms	III-9
4.7	Terms like "about" and "approximately"	III-10
4.8	Trademarks	III-10
4.9	Optional features	III-10
4.10	Result to be achieved	III-10
4.11	Parameters	III-11
4.12	Product-by-process claim	III-11
4.13	"Apparatus for ...", "Method for ...", etc.	III-12
4.14	Definition by reference to use or another entity	III-12
4.15	The expression "in"	III-13
4.16	Use claims	III-14
4.17	References to the description or drawings	III-14
4.18	Method of and means for measuring parameters referred to in claims	III-15
4.19	Reference signs	III-15
4.20	Negative limitations (e.g. disclaimers)	III-16
4.21	"Comprising" vs. "consisting"	III-16
4.22	Functional definition of a pathological condition	III-17
5.	Conciseness, number of claims	III-17
6.	Support in description	III-17
6.1	General remarks	III-17
6.2	Extent of generalisation	III-18
6.3	Objection of lack of support	III-18
6.4	Lack of support vs. insufficient disclosure	III-19
6.5	Definition in terms of function	III-20
6.6	Support for dependent claims	III-20
7.	Unity of invention	III-20
7.1	General remarks	III-20
7.2	Special technical features	III-20
7.3	Intermediate and final products	III-22
7.4	Alternatives	III-23
7.4.1	Markush grouping	III-23
7.5	Individual features in a claim	III-24
7.6	Lack of unity "a priori" or "a posteriori"	III-24
7.7	Examiner's approach	III-24
7.8	Dependent claims	III-24
7.9	Lack of unity during search	III-25
7.10	Lack of unity during substantive examination	III-25
7.10.1	Amended claims	III-26
7.11	Euro-PCT applications	III-26
7.11.1	International applications without supplementary search	III-26
7.11.2	International applications with supplementary search	III-27
7.11.3	International preliminary examination report (IPER)	III-27
7.11.4	Restricted IPER	III-28

8.	Different texts of the patent application in respect of different Contracting States (see also D-VII, 4)	III-28
8.1	Different text in respect of the state of the art according to Art. 54(3)	III-28
8.2	Different text where a partial transfer of right has taken place pursuant to Art. 61	III-29
8.3	Different text where a reservation has been entered in accordance with Art. 167(2)(a) EPC 1973	III-29
8.4	Different text where national rights of earlier date exist	III-29
8.5	Calculation of claims fees	III-30

Chapter IV – Patentability **IV-1**

1.	General	IV-1
1.1	Basic requirements	IV-1
1.2	Further requirements	IV-1
1.3	Technical progress, advantageous effects	IV-1
2.	Inventions	IV-2
2.1	Exclusions	IV-2
2.2	Examination practice	IV-2
2.3	List of exclusions	IV-2
2.3.1	Discoveries	IV-2
2.3.2	Scientific theories	IV-3
2.3.3	Mathematical methods	IV-3
2.3.4	Aesthetic creations	IV-3
2.3.5	Schemes, rules and methods for performing mental acts, playing games or doing business	IV-4
2.3.6	Programs for computers	IV-4
2.3.7	Presentations of information	IV-5
3.	Biotechnological inventions	IV-6
3.1	General remarks and definitions	IV-6
3.2	Patentable biotechnological inventions	IV-6
4.	Exceptions to patentability	IV-8
4.1	Matter contrary to "ordre public" or morality	IV-8
4.2	Prohibited matter	IV-8
4.3	Offensive and non-offensive use	IV-8
4.4	Economic effects	IV-9
4.5	Biotechnological inventions	IV-9
4.6	Plant and animal varieties, processes for the production of plants or animals	IV-10
4.6.1	Plant varieties	IV-10
4.6.2	Processes for the production of plants or animals	IV-10
4.7	Microbiological processes	IV-11
4.7.1	General remarks	IV-11
4.7.2	Repeatability of results of microbiological processes	IV-11
4.8	Surgery, therapy and diagnostic methods	IV-11
4.8.1	Limitations of exception under Art. 53(c)	IV-13
5.	Industrial application	IV-15

5.1	General remarks	IV-15
5.2	Method of testing	IV-16
5.3	Industrial application vs. exclusion under Art. 52(2)	IV-16
5.4	Sequences and partial sequences of genes	IV-16
6.	State of the art	IV-17
6.1	General remarks and definition	IV-17
6.2	Internet disclosures	IV-18
6.2.1	Establishing the publication date	IV-18
6.2.2	Standard of proof	IV-19
6.2.3	Burden of proof	IV-19
6.2.3.1	Technical journals	IV-20
6.2.3.2	Other "print equivalent" publications	IV-20
6.2.3.3	Non-traditional publications	IV-21
6.2.4	Disclosures which have no date or an unreliable date	IV-21
6.2.5	Problematic cases	IV-22
6.2.6	Technical details and general remarks	IV-23
6.3	Enabling disclosures	IV-23
6.4	Date of filing or priority date as effective date	IV-24
6.5	Documents in a non-official language	IV-24
7.	Conflict with other European applications	IV-25
7.1	State of the art pursuant to Art. 54(3)	IV-25
7.1.1	Requirements	IV-25
7.2	Euro-PCT applications	IV-26
7.3	Commonly designated States	IV-26
7.4	Double patenting	IV-26
8.	Conflict with national rights of earlier date	IV-26
9.	Novelty	IV-27
9.1	State of the art pursuant to Art. 54(2)	IV-27
9.2	Implicit features or well-known equivalents	IV-27
9.3	Relevant date of a prior document	IV-28
9.4	Enabling disclosure of a prior document	IV-28
9.5	Generic disclosure and specific examples	IV-28
9.6	Implicit disclosure and parameters	IV-28
9.7	Examination of novelty	IV-29
9.8	Selection inventions	IV-29
10.	Non-prejudicial disclosures	IV-31
10.1	General	IV-31
10.2	Time limit	IV-31
10.3	Evident abuse	IV-32
10.4	International exhibition	IV-32
11.	Inventive step	IV-32
11.1	General	IV-32
11.2	State of the art; date of filing	IV-32
11.3	Person skilled in the art	IV-32

11.4	Obviousness	IV-33
11.5	Problem-and-solution approach	IV-33
11.5.1	Determination of the closest prior art	IV-34
11.5.2	Formulation of the objective technical problem	IV-34
11.5.3	Could-would approach	IV-35
11.6	Combining pieces of prior art	IV-36
11.7	Combination vs. juxtaposition or aggregation	IV-37
11.8	"Ex post facto" analysis	IV-37
11.9	Origin of an invention	IV-38
11.10	Secondary indicators	IV-38
11.10.1	Predictable disadvantage; non-functional modification; arbitrary choice	IV-38
11.10.2	Unexpected technical effect; bonus effect	IV-39
11.10.3	Long-felt need; commercial success	IV-39
11.11	Arguments and evidence submitted by the applicant	IV-39
11.12	Selection inventions	IV-40
11.13	Dependent claims; claims in different categories	IV-40
11.14	Examples	IV-41

CHAPTER IV – Annex Examples relating to the requirement of inventive step – indicators (see IV, 11.13) **IV-43**

1.	Application of known measures?	IV-43
1.1	Inventions involving the application of known measures in an obvious way and in respect of which an inventive step is therefore to be ruled out:	IV-43
1.2	Inventions involving the application of known measures in a non-obvious way and in respect of which an inventive step is therefore to be recognised:	IV-44
2.	Obvious combination of features?	IV-44
2.1	Obvious and consequently non-inventive combination of features:	IV-44
2.2	Not obvious and consequently inventive combination of features:	IV-44
3.	Obvious selection?	IV-45
3.1	Obvious and consequently non-inventive selection among a number of known possibilities:	IV-45
3.2	Not obvious and consequently inventive selection among a number of known possibilities:	IV-46
4.	Overcoming a technical prejudice?	IV-47

Chapter V – Priority **V-1**

1.	The right to priority	V-1
1.1	Filing date as effective date	V-1
1.2	Priority date as effective date	V-1
1.3	Validly claiming priority	V-1
1.4	First application	V-2
1.4.1	Subsequent application considered as first application	V-2
1.5	Multiple priorities	V-3
2.	Determining priority dates	V-3

2.1	Examining the validity of a right to priority	V-3
2.2	The same invention	V-4
2.3	Priority claim not valid	V-5
2.4	Some examples of determining priority dates	V-5
2.4.1	Intermediate publication of the contents of the priority application	V-5
2.4.2	Intermediate publication of another European application	V-6
2.4.3	Multiple priorities claimed for different inventions in the application with an intermediate publication of one of the inventions	V-6
2.4.4	A situation in which it has to be checked whether the application from which priority is actually claimed is the "first application" in the sense of Art. 87(1)	V-6

3.	Claiming priority	V-7
3.1	General remarks	V-7
3.2	Declaration of priority	V-7
3.3	Certified copy of the previous application (priority document)	V-7
3.4	Translation of the previous application	V-8
3.5	Abandonment of priority claim	V-9
3.6	Re-establishment of rights in respect of the priority period	V-9

Chapter VI – Examination procedure **VI-1**

1.	The start of examination	VI-1
1.1	Request for examination	VI-1
1.1.1	Confirmation of early request for examination	VI-2
1.1.2	Acceleration of examination procedure	VI-2
1.1.3	Euro-PCT applications	VI-2
1.1.4	Invention to be examined	VI-3
1.2	Allocation of the application	VI-3
1.3	Examining Division	VI-3
1.4	Designation fee(s), extension fees	VI-4

2.	Examination procedure in general	VI-4
2.1	Purpose of examination	VI-4
2.2	Topping-up search	VI-5
2.3	Communication with the applicant	VI-5
2.3.1	Requesting information from the applicant	VI-5
2.4	Re-examination, refusal, appeal, interlocutory revision	VI-5
2.5	Communication under Rule 71(3)	VI-6
2.6	Grant of a patent	VI-6
2.7	Application deemed withdrawn	VI-6
2.8	Amendments	VI-6
2.9	Examination stages	VI-6

3.	The first stage of examination	VI-7
3.1	Missing drawings or parts of the description filed under Rule 56 or claims filed after accordance of a date of filing	VI-7
3.2	Response to the search opinion, PACE	VI-7
3.3	Amendments by the applicant following the EESR and made of his own volition	VI-8
3.4	Unity of invention	VI-8
3.5	First communication	VI-9

3.5.1	Euro-PCT applications and reply to the WO-ISA/IPER	VI-10
3.6	Reasoned objections	VI-12
3.7	Invitation to file comments and amendments	VI-13
4.	Examination of replies	VI-13
4.1	General procedure	VI-13
4.2	Extent of examination of replies	VI-13
4.3	Further action upon examination of replies	VI-14
4.4	Later stages of examination	VI-14
4.5	Decision according to the state of the file	VI-15
4.6	Examination of amendments	VI-15
4.7	Admissibility of amendments made by the applicant	VI-15
4.8	Examples of inadmissible amendments	VI-17
4.9	Amendments filed in reply to a communication under Rule 71(3)	VI-17
4.10	Further requests for amendment after approval	VI-19
4.11	Resumption of the examination proceedings	VI-19
5.	Amendments	VI-19
5.1	Making amendments	VI-19
5.2	Allowability of amendments	VI-19
5.3	Additional subject-matter	VI-21
5.3.1	Basic principle; priority document	VI-21
5.3.2	Examples	VI-22
5.3.3	Clarification of a technical effect	VI-23
5.3.4	Introduction of further examples and new effects	VI-23
5.3.5	Evidence	VI-23
5.3.6	Supplementary technical information	VI-23
5.3.7	Revision of stated technical problem	VI-24
5.3.8	Reference document	VI-24
5.3.9	Alteration, excision or addition of text	VI-25
5.3.10	Replacement or removal of a feature from a claim	VI-25
5.3.11	Disclaimers not disclosed in the application as filed	VI-25
5.4	Correction of errors	VI-26
5.5	Plural forms of amendment	VI-27
5.6	Rule 62a and/or Rule 63 cases	VI-28
5.7	Indication of amendments and their basis under Rule 137(4)	VI-28
5.7.1	Rule 137(4) communication and response thereto	VI-29
5.7.2	Amendments withdrawn or superseded in the Rule 137(4) period	VI-30
5.7.3	Rule 137(4) and oral proceedings	VI-31
5.7.4	Transitional provisions relating to Rule 137(4)	VI-31
6.	Discussion with the applicant	VI-32
6.1	General remark	VI-32
6.2	Telephone conversation, personal interview	VI-32
7.	Work within the Examining Division	VI-33
7.1	General remarks	VI-33
7.2	Recommendation to grant	VI-33
7.3	Recommendation to refuse	VI-34
7.4	Tasks of the other members of the Examining Division	VI-34

7.5	Further communication with the applicant	VI-34
7.6	Refusal	VI-35
7.7	Decision	VI-35
7.8	Enlargement of the Examining Division; consultation of a legally qualified examiner	VI-35
8.	Search-related issues in examination	VI-36
8.1	Search for conflicting European applications	VI-36
8.2	Additional searches during examination	VI-36
8.3	Search at the examination stage	VI-37
8.4	Citing documents not mentioned in the search report	VI-37
9.	Special applications	VI-37
9.1	Divisional applications (see also A-IV, 1)	VI-37
9.1.1	General remarks	VI-37
9.1.2	Voluntary and mandatory division	VI-37
9.1.3	Time limit; abandonment of subject-matter	VI-38
9.1.4	Examination of a divisional application	VI-38
9.1.5	Description and drawings	VI-39
9.1.6	Claims	VI-39
9.2	Applications resulting from a decision under Art. 61	VI-40
9.2.1	General remarks	VI-40
9.2.2	Original application no longer pending	VI-40
9.2.3	Partial entitlement	VI-40
9.2.4	Entitlement for certain designated States only	VI-41
9.3	Applications where a reservation has been entered in accordance with Art. 167(2)(a) EPC 1973	VI-41
9.4	International applications (Euro-PCT applications)	VI-41
10.	Time limits for response to communications from the examiner	VI-42
10.1	General considerations	VI-42
10.2	Special circumstances	VI-42
11.	Examination of observations by third parties	VI-42
12.	Oral proceedings	VI-42
13.	Taking of evidence	VI-42
13.1	General remark	VI-42
13.2	Producing evidence	VI-42
13.3	Written evidence	VI-43
14.	The final stage of examination	VI-43
14.1	Communication under Rule 71(3)	VI-43
14.2	Grant of a patent	VI-44
14.3	Application deemed withdrawn	VI-45
14.4	Amendments filed in reply to a communication under Rule 71(3)	VI-45
14.4.1	Exceptions to the requirement of Rule 71(4)	VI-47
14.5	Resumption of the examination procedure	VI-48
14.6	Further processing	VI-48

14.7	Refund of fees	VI-48
14.8	Publication of the patent specification	VI-48
14.9	Withdrawal before publication of the patent specification	VI-48
14.10	Certificate	VI-49
14.11	European Patent Bulletin	VI-49

Chapter I

Introduction

1. General remark

In this Part C of the Guidelines the term "examiner" is used to mean the examiner entrusted with substantive examination forming part of the Examining Division, which is responsible for the final decision. *Art. 18*

2. Work of an examiner

The attitude of the examiner is very important. He should always try to be constructive and helpful. While it would of course be quite wrong for an examiner to overlook any major deficiency in an application, he should have a sense of proportion and not pursue unimportant objections. He should bear in mind that, subject to the requirements of the EPC, the drafting of the description and claims of a European application is the responsibility of the applicant or his authorised representative.

The attention of the examiner is particularly directed to the instruction in paragraph 4.3 of the General Part of the Guidelines. This applies not only in relation to other departments of the EPO. It also means, for example, that the other members of an Examining Division should not attempt to repeat the work of the primary examiner (see VI, 7.4).

3. Overview

In the remainder of Part C of the Guidelines, an attempt has been made to deal with the requirements of the application in Chapters I-V and to concentrate matters of procedure in Chapter VI. However, it has not always proved practicable to draw a clear line between these two aspects of the work.

Chapter II

Content of a European patent application (other than claims)

1. General

The requirements for a European patent application are set out in Art. 78. The application must contain: *Art. 78*

(i) a request for the grant of a European patent; *Art. 78(1)(a)*

(ii) a description of the invention; *Art. 78(1)(b)*

(iii) one or more claims; *Art. 78(1)(c)*

(iv) any drawings referred to in the description or the claims; and *Art. 78(1)(d)*

(v) an abstract. *Art. 78(1)(e)*

This Chapter deals with all these requirements, insofar as they are the concern of the examiner, with the exception of item (iii) which is the subject of Chapter III. Item (v) is dealt with first.

2. Abstract

The general considerations relating to the abstract are set out in B-XI. *Art. 85*
The abstract relates to the application as filed and published and its final form for publication is determined by the Search Division. It is not necessary to bring it into conformity with the content of the published patent even if this should differ in substance from that of the application, since the patent specification does not contain an abstract. The examiner should therefore not seek any amendment of the abstract. He should, however, note that the abstract has no legal effect on the application containing it; for instance, it cannot be used to interpret the scope of protection or to justify the addition to the description of new subject-matter. *Art. 98*

3. Request for grant – the title

The items making up this request are dealt with in A-III, 4. They do not normally concern the examiner, with the exception of the title.

The title should clearly and concisely state the technical designation of the invention and should exclude all fancy names. While any obvious failures to meet these requirements are likely to be noted during the formalities examination, the examiner should review the title in the light of his reading of the description and claims and any amendments thereto, to make sure that the title, as well as being concise, gives a clear and adequate indication of the subject of the invention. Thus, if amendments are made which change the categories of claims, the *Rule 41(2)(b)*

examiner should check whether a corresponding amendment is needed in the title.

4. Description

4.1 General remarks

Art. 83
Rule 42

The application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

The "person skilled in the art" for this purpose is considered to be the ordinary practitioner aware not only of the teaching of the application itself and the references therein, but also of what was common general knowledge in the art at the date of filing the application. He is assumed to have had at his disposal the means and the capacity for routine work and experimentation, which are normal for the technical field in question. As "common general knowledge" can generally be considered the information contained in basic handbooks, monographs and textbooks on the subject in question (see T 171/84, OJ 4/1986, 95). As an exception, it can also be the information contained in patent specifications or scientific publications, if the invention lies in a field of research which is so new that the relevant technical knowledge is not yet available from textbooks (see T 51/87, OJ 3/1991, 177). Sufficiency of disclosure must be assessed on the basis of the application as a whole, including the description, claims and drawings, if any. The provisions relating to the content of the description are set out in Rule 42. The purpose of the provisions of Art. 83 and Rule 42 is:

(i) to ensure that the application contains sufficient technical information to enable a skilled person to put the invention as claimed into practice; and

(ii) to enable the reader to understand the contribution to the art which the invention as claimed has made.

4.2 Technical field

Rule 42(1)(a)

The invention should be placed in its setting by specifying the technical field to which it relates.

4.3 Background art

Rule 42(1)(b)
Art. 123(2)

The description should also mention any background art of which the applicant is aware, and which can be regarded as useful for understanding the invention and its relationship to the prior art; identification of documents reflecting such art, especially patent specifications, should preferably be included. This applies in particular to the background art corresponding to the first or "prior art" portion of the independent claim or claims (see III, 2.2).

The insertion into the statement of prior art of references to documents identified subsequently, for example by the search report, should be required, where necessary, to put the invention into proper perspective

(T 11/82, OJ 12/1983, 479). For instance, while the originally filed description of prior art may give the impression that the inventor has developed the invention from a certain point, the cited documents may show that certain stages in, or aspects of, this alleged development were already known. In such a case the examiner should require a reference to these documents and a brief summary of the relevant contents. The subsequent inclusion of such a summary in the description does not contravene Art. 123(2). The latter merely lays down that, if the application is amended, for example by limiting it in the light of additional information on the background art, its subject-matter must not extend beyond the content of the application as filed. But the subject-matter of the European patent application within the meaning of Art. 123(2) is to be understood – starting off from the prior art – as comprising those features which, in the framework of the disclosure required by Art. 83, relate to the invention (see also VI, 5.3).

References to the prior art introduced after filing must be purely factual. Any alleged advantages of the invention must be adjusted if necessary in the light of the prior art.

New statements of advantage are permissible provided that they do not introduce into the description matter which could not have been deduced from the application as originally filed (see VI, 5.3.4).

If the relevant prior art consists of another European patent application falling within the terms of Art. 54(3), this relevant prior document belongs to the state of the art for all Contracting States. This is the case even if the two applications do not share any commonly designated State, or the designation of commonly designated States has been dropped. (see IV, 8). The fact that this document falls under Art. 54(3) must be explicitly acknowledged. Thus the public is informed that the document is not relevant to the question of inventive step (see IV, 11.2). According to Rule 165, the above also applies to international applications designating EP, for which the filing fee pursuant to Rule 159(1)(c) has been validly paid and, where applicable, the translation into one of the official languages has been filed (Art. 153(3) and (4)) (see IV, 7.2). *Art. 54(3)*

For transitional provisions concerning the applicability of Art. 54(4) EPC 1973, see III, 8.1. *Art. 54(4) EPC 1973*

4.4 Irrelevant matter

Since the reader is presumed to have the general technical background knowledge appropriate to the art, the examiner should not require the applicant to insert anything in the nature of a treatise or research report or explanatory matter which is obtainable from textbooks or is otherwise well-known. Likewise the examiner should not require a detailed description of the content of cited prior documents. It is sufficient that the reason for the inclusion of the reference is indicated, unless in a particular case a more detailed *Rule 48(1)(c)*

description is necessary for a full understanding of the invention of the application (see also II, 4.19 and III, 2.3.1).

A list of several reference documents relating to the same feature or aspect of the prior art is not required; only the most appropriate need be referred to. On the other hand, the examiner should not insist upon the excision of any such unnecessary matter, except when it is very extensive (see II, 7.4).

4.5 Technical problem and its solution

Rule 42(1)(c)
Rule 48(1)(b)

The invention as claimed should be disclosed in such a way that the technical problem, or problems, with which it deals can be appreciated and the solution can be understood. To meet this requirement, only such details should be included as are necessary for elucidating the invention.

In cases where the subject-matter of a dependent claim can be understood either by the wording of the claim itself or by the description of a way of performing the invention, no additional explanation of this subject-matter will be necessary. A mention in the description that a particular embodiment of the invention is set out in the dependent claim will then be sufficient.

When there is doubt, however, as to whether certain details are necessary, the examiner should not insist on their excision. It is not necessary, moreover, that the invention be presented explicitly in problem-and-solution form. Any advantageous effects which the applicant considers the invention to have in relation to the prior art should be stated, but this should not be done in such a way as to disparage any particular prior product or process. Furthermore, neither the prior art nor the applicant's invention should be referred to in a manner likely to mislead. This might be done e.g. by an ambiguous presentation which gives the impression that the prior art had solved less of the problem than was actually the case. Fair comment as referred to in II, 7.3 is, however, permitted. Regarding amendment to, or addition of, a statement of problem, see VI, 5.3.7.

4.6 Rule 42(1)(c) vs. Art. 52(1)

Rule 42(1)(c)

If it is decided that an independent claim defines a patentable invention within the meaning of Art. 52(1), it must be possible to derive a technical problem from the application. In this case the requirement of Rule 42(1)(c) is fulfilled (see T 26/81, OJ 6/1982, 211).

4.7 Drawings

Rule 42(1)(d)

If drawings are included they should first be briefly described, in a manner such as: "Figure 1 is a plan view of the transformer housing; Figure 2 is a side elevation of the housing; Figure 3 is an end elevation looking in the direction of the arrow X of Figure 2; Figure 4 is a cross-section taken through AA of Figure 1." When it is necessary to refer in the description to elements of the drawings, the name of the element should be referred to as well as its number, i.e. the reference

should not be in the form: "3 is connected to 5 via 4" but, "resistor 3 is connected to capacitor 5 via switch 4".

4.8 Reference signs

Rule 46(2)(i)

The description and drawings should be consistent with one another, especially in the matter of reference numbers and other signs, and each number or sign must be explained. However, where as a result of amendments to the description whole passages are deleted, it may be tedious to delete all superfluous references from the drawings and in such a case the examiner should not pursue an objection under Rule 46(2)(i), as to consistency, too rigorously. The reverse situation should never occur, i.e. all reference numbers or signs used in the description or claims must also appear on the drawings.

4.9 Sufficiency of disclosure

Rule 42(1)(e)
Art. 83

A detailed description of at least one way of carrying out the invention must be given. Since the application is addressed to the person skilled in the art, it is neither necessary nor desirable that details of well-known ancillary features should be given, but the description must disclose any feature essential for carrying out the invention in sufficient detail to render it apparent to the skilled person how to put the invention into practice. A single example may suffice, but where the claims cover a broad field, the application should not usually be regarded as satisfying the requirements of Art. 83 unless the description gives a number of examples or describes alternative embodiments or variations extending over the area protected by the claims. However, regard must be had to the facts of the particular case. There are some instances where even a very broad field is sufficiently exemplified by a limited number of examples or even one example (see also III, 6.3). In these latter cases the application must contain, in addition to the examples, sufficient information to allow the person skilled in the art, using his common general knowledge, to perform the invention over the whole area claimed without undue burden and without needing inventive skill (see T 727/95, OJ 1/2001, 1). If the Examining Division is able to make out a reasoned case that the application lacks sufficient disclosure, the onus of establishing that the invention may be performed and repeated over substantially the whole of the claimed range lies with the applicant (see VI, 2.3).

Art. 83
Rule 42(1)(c) and (e)

For the requirements of Art. 83 and of Rule 42(1)(c) and (e) to be fully satisfied, it is necessary that the invention is described not only in terms of its structure but also in terms of its function, unless the functions of the various parts are immediately apparent. Indeed in some technical fields (e.g. computers), a clear description of function may be much more appropriate than an over-detailed description of structure.

Rule 63

In cases where it is found that an application is sufficiently disclosed according to Art. 83 only in respect of a part of the claimed subject-matter, this may have led to the issuing of a partial European or supplementary European search report according to Rule 63 (see

B-VIII, 3.1 and 3.2). In such cases, in the absence of appropriate amendment, an objection under Rule 63(3) will also arise (see VI, 5.6).

4.10 Art. 83 vs. Art. 123(2)

Art. 83
Art. 123(2)

It is the responsibility of the applicant to ensure that he supplies, on filing his application, a sufficient disclosure, i.e. one that meets the requirements of Art. 83 in respect of the invention as claimed in all of the claims. If the claims define the invention, or a feature thereof, in terms of parameters (see III, 4.11), the application as filed must include a clear description of the methods used to determine the parameter values, unless a person skilled in the art would know what method to use or unless all methods would yield the same result (see III, 4.18). If the disclosure is seriously insufficient, such a deficiency cannot be cured subsequently by adding further examples or features without offending against Art. 123(2), which requires that amendments may not result in the introduction of subject-matter which extends beyond the content of the application as filed (see VI, 5.3). Therefore, in such circumstances, the application must normally be refused. If, however, the deficiency arises only in respect of some embodiments of the invention and not others, it could be remedied by restricting the claims to correspond to the sufficiently described embodiments only, the description of the remaining embodiments being deleted.

4.11 Insufficient disclosure

Art. 83

Occasionally applications are filed in which there is a fundamental insufficiency in the invention in the sense that it cannot be carried out by a person skilled in the art; there is then a failure to satisfy the requirements of Art. 83 which is essentially irreparable. Two instances deserve special mention. The first is where the successful performance of the invention is dependent on chance. That is to say, the skilled person, in following the instructions for carrying out the invention, finds either that the alleged results of the invention are unrepeatable or that success in obtaining these results is achieved in a totally unreliable way. An example where this may arise is a microbiological process involving mutations. Such a case should be distinguished from one where repeated success is assured even though accompanied by a proportion of failures, as can arise e.g. in the manufacture of small magnetic cores or electronic components. In this latter case, provided the satisfactory parts can be readily sorted by a non-destructive testing procedure, no objection arises under Art. 83. The second instance is where successful performance of the invention is inherently impossible because it would be contrary to well-established physical laws – this applies e.g. to a perpetual motion machine. If the claims for such a machine are directed to its function, and not merely to its structure, an objection arises not only under Art. 83 but also under Art. 52(1) in that the invention is not "susceptible of industrial application" (see IV, 5.1).

4.12 Industrial application

The description should indicate explicitly the way in which the invention is capable of exploitation in industry, if this is not obvious from the description or from the nature of the invention. The expression "capable of exploitation in industry" means the same as "susceptible of industrial application", and indeed identical expressions are used in the French and German texts of the EPC. In view of the broad meaning given to the latter expression by Art. 57 (see IV, 5.1), it is to be expected that, in most cases, the way in which the invention can be exploited in industry will be self-evident, so that no more explicit description on this point will be required; but there may be a few instances, e.g. in relation to methods of testing, where the manner of industrial exploitation is not apparent and must therefore be explicitly indicated.

Rule 42(1)(f)
Art. 52(1)
Art. 57

Also, in relation to certain biotechnological inventions, i.e. sequences and partial sequences of genes, the industrial application is not self-evident. The industrial application of such sequences must be disclosed in the patent application (see IV, 5.4).

Rule 29(3)

4.13 Manner and order of presentation

The manner and order of presentation of the description should be that specified in Rule 42(1), i.e. as set out above, unless, because of the nature of the invention, a different manner or a different order would afford a better understanding and a more economic presentation. Since the responsibility for clearly and completely describing the invention lies with the applicant, the examiner should not object to the presentation unless satisfied that such an objection would be a proper exercise of his discretion.

Rule 42(2)

Some departure from the requirements of Rule 42(1) is acceptable, provided the description is clear and orderly and all the requisite information is present. For example, the requirements of Rule 42(1)(c) may be waived where the invention is based on a fortuitous discovery, the practical application of which is recognised as being useful, or where the invention breaks entirely new ground. Also, certain technically simple inventions may be fully comprehensible with the minimum of description and only slight reference to prior art.

4.14 Terminology

Although the description should be clear and straightforward with avoidance of unnecessary technical jargon, the use of recognised terms of art is acceptable, and will often be desirable. Little-known or specially-formulated technical terms may be allowed provided that they are adequately defined and that there is no generally recognised equivalent. This discretion may be extended to foreign terms when there is no equivalent in the language of the proceedings. Terms already having an established meaning should not be allowed to be used to mean something different if this is likely to cause confusion. There may, however, be circumstances where a term may legitimately

Rule 49(11)

be borrowed from an analogous art. Terminology and signs must be consistent throughout the application.

4.15 Computer programs

In the particular case of inventions in the computer field, program listings in programming languages cannot be relied on as the sole disclosure of the invention. The description, as in other technical fields, should be written substantially in normal language, possibly accompanied by flow diagrams or other aids to understanding, so that the invention may be understood by a person skilled in the art who is deemed not to be a specialist in any specific programming language, but does have general programming skills. Short excerpts from programs written in commonly used programming languages can be accepted if they serve to illustrate an embodiment of the invention.

4.16 Physical values, units

When the properties of a material are referred to, the relevant units should be specified if quantitative considerations are involved. If this is done by reference to a published standard (e.g. a standard of sieve sizes) and such standard is referred to by a set of initials or similar abbreviation, it should be adequately identified in the description.

Rule 49(10)

Physical values must be expressed in the units recognised in international practice, which is generally in the metric system, using SI units and the other units referred to in Chapter I of the Annex to EEC Directive 80/181/EEC of 20 December 1979, as amended by EEC Directives 85/1/EEC of 18 December 1984, 89/617/EEC of 27 November 1989 and 1999/103/EC of 24 January 2000 (see the Annex to this Chapter). Any values not meeting this requirement must also be expressed in the units recognised in international practice. Values in the inch/pound system, in general, do not meet the criterion "recognised in international practice".

As Rule 49(10) indicates, for mathematical formulae the symbols in general use must be employed. For chemical formulae, the symbols, atomic weights and molecular formulae in general use must be employed.

In general, use should be made of the technical terms, signs and symbols generally accepted in the field in question.

4.17 Proper names, trademarks and trade names

The use of proper names, trademarks or trade names or similar words to refer to materials or articles is undesirable insofar as such words merely denote origin or where they may relate to a range of different products. If such a word is used, then, where it is necessary in order to satisfy the requirements of Art. 83, the product must be sufficiently identified, without reliance upon the word, to enable the invention to be carried out by the skilled person at the date of filing. However, where such words have become internationally accepted as standard descriptive terms and have acquired a precise meaning (e.g. "Bowden"

cable, "Belleville" washer, "Panhard" rod, "teflon" layer, "caterpillar" belt) they may be allowed without further identification of the product to which they relate.

4.18 Registered trademarks

It is the applicant's responsibility to ensure that registered trademarks are acknowledged as such in the description.

4.19 Reference documents

References in European patent applications to other documents may relate either to the background art or to part of the disclosure of the invention.

Where the reference document relates to the background art, it may be in the application as originally filed or introduced at a later date (see II, 4.3 and 4.4).

Where the reference document relates directly to the disclosure of the invention (e.g. details of one of the components of a claimed apparatus), then the examiner should first consider whether knowing what is in the reference document is in fact essential for carrying out the invention as meant by Art. 83: *Art. 65*

If not essential, the usual expression "which is hereby incorporated by reference", or any expression of the same kind, should be deleted from the description.

If matter in the document referred to is essential to satisfy the requirements of Art. 83, the examiner should require the deletion of the above-mentioned expression and that, instead, the matter is expressly incorporated into the description, because the patent specification should, regarding the essential features of the invention, be self-contained, i.e. capable of being understood without reference to any other document. One should also bear in mind that reference documents are not part of the text to be translated pursuant to Art. 65.

Such incorporation of essential matter or essential features is, however, subject to the following restrictions:

(i) it must not contravene Art. 123(2) (see also T 689/90, OJ 10/1993, 616) in the sense that the description of the invention as originally filed leaves a skilled reader in no doubt that:

   (a) protection is or may be sought for such features;

   (b) such features contribute to solving the technical problem underlying the invention;

   (c) such features at least implicitly clearly belong to the description of the invention contained in the application

(Art. 78(1)(b)) and thus to the content of the application as filed (Art. 123(2)); and

(d) such features are precisely defined and identifiable within the total technical information in the reference document.

(ii) if the reference document was not available to the public on the date of filing of the application, it can only be considered if (see T 737/90, not published in OJ):

(a) a copy of the document was available to the EPO on or before the date of filing of the application; and

(b) the document was made available to the public no later than on the date of publication of the application under Art. 93 (e.g. by being present in the application dossier and therefore made public under Art. 128(4)).

It may be that the Search Division has requested the applicant to furnish the document referred to, in order to be able to carry out a meaningful search (see B-IV, 1.3).

If, for the disclosure of the invention, a document is referred to in an application as originally filed, the relevant content of the reference document is to be considered as forming part of the content of the application for the purpose of citing the application under Art. 54(3) against later applications. For reference documents not available to the public before the filing date of the application this applies only if conditions (ii)(a) and (ii)(b) above are fulfilled.

Because of this effect under Art. 54(3), it is very important that, where a reference is directed only to a particular part of the document referred to, that part should be clearly identified in the reference.

5. Drawings

5.1 Form and content

Rule 46
Rule 46(2)(j)

The requirements relating to the form and content of drawings are set down in Rule 46. Most of these are formal (see A-X), but the examiner may sometimes need to consider the requirements of Rule 46(2)(f), (h), (i) and (j). Of these, the only question likely to cause difficulty is whether the textual matter included on the drawings is absolutely indispensable. In the case of circuit diagrams, block schematics and flow sheets, identifying catchwords for functional integers of complex systems (e.g. "magnetic core store", "speed integrator") may be regarded as indispensable from a practical point of view if they are necessary to enable a diagram to be interpreted rapidly and clearly.

5.2 Printing quality

The examiner has also to check whether the drawings in the printing copy ("Druckexemplar") are suitable for printing. If necessary, a copy

of the original drawings must be prepared as the printing copy. If, however, the quality of the original drawings is also insufficient, then the examiner must request the applicant to present drawings of sufficient quality for printing. He should, however, beware of any extension of subject-matter (Art. 123(2)).

5.3 Photographs

The EPC makes no express provision for photographs. They are nevertheless allowed where it is impossible to present in a drawing what is to be shown and provided that they are in black and white, directly reproducible and fulfil the applicable requirements for drawings (e.g. paper size, margins, etc.). Colour photographs are not accepted. In case of photographs of insufficient original quality for printing, the examiner should not request filing of better photographs, as the risk of infringing Art. 123(2) is obvious. In that case, the insufficient quality is accepted for reproduction.

6. Inventions relating to biological material

6.1 Biological material

Rule 26(3)
Rule 31(1)

Applications relating to biological material are subject to the special provisions set out in Rule 31. In accordance with Rule 26(3), the term "biological material" means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system. If an invention involves the use of or concerns biological material which is not available to the public and which cannot be described in the European patent application in such a manner as to enable the invention to be carried out by a person skilled in the art, the disclosure is not considered to have satisfied the requirements of Art. 83 unless the requirements of Rule 31(1), Rule 31(2), first and second sentences, and Rule 33(1), first sentence, have been met.

6.2 Public availability of biological material

The examiner must form an opinion as to whether or not the biological material is available to the public. There are several possibilities. The biological material may be known to be readily available to those skilled in the art, e.g. baker's yeast or Bacillus natto, which is commercially available, it may be a standard preserved strain, or other biological material which the examiner knows to have been preserved in a recognised depository and to be available to the public. Alternatively, the applicant may have given in the description sufficient information as to the identifying characteristics of the biological material and as to the prior availability in a depositary institution recognised for the purposes of Rule 33(6) to satisfy the examiner. In any of these cases no further action is called for. If, however, the applicant has given no or insufficient information on public availability and the biological material is a particular strain not falling within the known categories such as those already mentioned, then the examiner must assume that the biological material is not available to the public. He must also examine whether the biological material could be described in the European patent application in such a manner as to

enable the invention to be carried out by a person skilled in the art (see, in particular, II, 4.11 and IV, 4.7).

6.3 Deposit of biological material

If the biological material is not available to the public and if it cannot be described in the application in such a manner as to enable the invention to be carried out by a person skilled in the art, the examiner must check:

Rule 31(1) and (2)

(i) whether the application as filed gives such relevant information as is available to the applicant on the characteristics of the biological material. The relevant information under this provision concerns the classification of the biological material and significant differences from known biological material. For this purpose, the applicant must, to the extent available to him, indicate morphological and biochemical characteristics and the proposed taxonomic description.

The information on the biological material in question which is generally known to the skilled person on the date of filing is as a rule presumed to be available to the applicant and must therefore be provided by him. If necessary, it has to be provided through experiments in accordance with the relevant standard literature.

For characterising bacteria, for example, the relevant standard work would be R.E. Buchanan, N.E. Gibbons: Bergey's Manual of Determinative Bacteriology.

Against this background, information should then be given on every further specific morphological or physiological characteristic relevant for recognition and propagation of the biological material, e.g. suitable media (composition of ingredients), in particular where the latter are modified.

Abbreviations for biological material or media are often less well known than the applicant assumes and should therefore be avoided or written in full at least once.

If biological material is deposited that cannot replicate itself but must be replicated in a biological system (e.g. viruses, bacteriophages, plasmids, vectors or free DNA or RNA), the above-mentioned information is also required for such biological system. If, for example, other biological material is required, such as host cells or helper viruses, that cannot be sufficiently described or is not available to the public, this material must also be deposited and characterised accordingly. In addition, the process for producing the biological material within this biological system must be indicated.

In many cases the above required information will already have been given to the depositary institution (see Rule 6.1(a)(iii) and 6.1(b) Budapest Treaty) and need only be incorporated into the application;

(ii) whether the name of the depositary institution and the accession number of the deposit were supplied at the date of filing. If the name of the depositary institution and the accession number of the deposit were submitted later, it should be checked whether they were filed within the relevant period under Rule 31(2). If that is the case, it should then further be checked whether on the filing date any reference was supplied which enables the deposit to be related to the later filed accession number. Normally the identification reference which the depositor himself gave to his deposit is used in the application documents. The relevant document for later filing the data pursuant to Rule 31(1)(c) could be a letter containing the name of the depositary institution, the accession number and the above-mentioned identification reference or, alternatively, the deposit receipt, which contains all these data (see also G 2/93, OJ 5/1995, 275 and A-IV, 4.2); and

(iii) whether the deposit was made by a person other than the applicant and, if so, whether the name and the address of the depositor are stated in the application or were supplied within the relevant period under Rule 31(2). In such a case, the examiner must also check whether the document fulfilling the requirements mentioned in Rule 31(1)(d) was submitted to the EPO within the same time limit.

The examiner, in addition to the checks referred to under (i) to (iii) above, asks for the deposit receipt issued by the depositary institution (see Rule 7.1 Budapest Treaty) or for equivalent proof of the deposit of a biological material if such proof has not been filed before (see (ii) above and A-IV, 4.2). This is to provide evidence for the indications made by the applicant pursuant to Rule 31(1)(c).

If this deposit receipt has already been filed within the relevant time period according to Rule 31(2), this document on its own is regarded as submission of the information according to Rule 31(1)(c).

In addition, the depositary institution named must be one of the recognised institutions listed in the Official Journal of the EPO. An up-to-date list is regularly published in the Official Journal. *Rule 33(6)*

If any of these requirements is not satisfied, the biological material in question cannot be considered as having been disclosed pursuant to Art. 83 by way of reference to the deposit.

Moreover, there are two situations in which the applicant can file information concerning the deposit which is required under Rule 31(1)(c), and where applicable also under Rule 31(1)(d), in a document filed after the accorded filing date and within the relevant time limit for filing that document, but after the expiry of one of the time limits under Rule 31(2)(a)-(c). As in the preceding paragraph, the consequence of the information being filed after the relevant time limit under Rule 31(2) is that the biological material is deemed not to have *Rule 31* *Rule 40(1)(c)* *Rule 56(2) and (3)*

been disclosed pursuant to Art. 83 by way of reference to the deposit. These situations are those in which the information concerning the deposit is contained in either:

(i) a previously filed application to which reference is made under Rule 40(1)(c), the copy of that application being filed within either the two-month period under Rule 40(3) or that under Rule 55; or

(ii) missing parts of the description filed later, within the two-month period under Rule 56(2), when the requirements of Rule 56(3) are satisfied, so that the application is not re-dated.

7. Prohibited matter

7.1 Categories

Rule 48

There are three categories of specifically prohibited matter, these being defined in sub-paragraphs (a) to (c) of Rule 48(1) (see also IV, 4).

7.2 Matter contrary to "ordre public" or morality

Rule 48(1)(a)

It should be noted that the omission, from the publication of the application, is mandatory for the first category. Examples of the kind of matter coming within this category are: incitement to riot or to acts of disorder; incitement to criminal acts; racial, religious or similar discriminatory propaganda; and grossly obscene matter.

7.3 Disparaging statements

Rule 48(1)(b)

It is necessary to discriminate in the second category between libellous or similarly disparaging statements, which are not allowed, and fair comment, e.g. in relation to obvious or generally recognised disadvantages, or disadvantages stated to have been found and substantiated by the applicant, which, if relevant, is permitted.

7.4 Irrelevant matter

Rule 48(1)(c)

The third category is irrelevant matter. It should be noted, however, that such matter is specifically prohibited under Rule 48(1)(c) only if it is "obviously irrelevant or unnecessary", for instance, if it has no bearing on the subject-matter of the invention or its background of relevant prior art (see also II, 4.4). The matter to be removed may already be obviously irrelevant or unnecessary in the original description. It may, however, be matter which has become obviously irrelevant or unnecessary only in the course of the examination proceedings, e.g. owing to a limitation of the claims of the patent to one of originally several alternatives. When matter is removed from the description, it must not be incorporated into the patent specification by reference to the corresponding matter in the published application or in any other document (see also II, 4.19).

7.5 Omission of matter from publication

Generally, the Receiving Section will deal with matter falling under category 1(a) and may have dealt with matter obviously falling within category 1(b), but if any such matter has not been so recognised and has therefore not been omitted from the publication of the application, it should be required to be removed during examination of the application together with any other prohibited matter. The applicant should be informed of the category under which matter is required to be removed.

CHAPTER II – Annex
Units recognised in international practice and complying with Rule 49(11) (see II, 4.16)*

LIST OF CONTENTS

1.	SI units and their decimal multiples and submultiples
1.1	SI base units
1.1.1	Special name and symbol of the SI unit of temperature for expressing Celsius temperature
1.2	Other SI units
1.2.1	Supplementary SI units
1.2.2	Derived SI units
1.2.3	Derived SI units having names and symbols
1.3	Prefixes and their symbols used to designate certain decimal multiples and submultiples
1.4	Special authorised names and symbols of decimal multiples and submultiples of SI units
2.	Units which are defined on the basis of SI units but are not decimal multiples or submultiples thereof
3.	Units used with the SI, whose values in SI are obtained experimentally
4.	Units and names of units permitted in specialised fields only
5.	Compound units

1. SI units and their decimal multiples and submultiples

1.1 SI base units

Quantity	Unit	
	Name	Symbol
Length	metre	m
Mass	kilogram	kg
Time	second	s
Electric current	ampere	A
Thermodynamic temperature	kelvin	K
Amount of substance	mole	mol
Luminous intensity	candela	cd

Definitions of SI base units:

* Based on Chapter I of the Annex to EEC Directive 80/181/EEC of 20.12.1979, as amended by EEC Directives 85/1/EEC of 18.12.1984, 89/617/EEC of 27.11.1989 and 1999/103/EC of 24.01.2000.

– Unit of length
The metre is the length of the path travelled in a vacuum by light during 1/299792458 seconds.

– Unit of mass
The kilogram is the unit of mass; it is equal to the mass of the international prototype of the kilogram.

– Unit of time
The second is the duration of 9 192 631 770 periods of the radiation corresponding to the transition between the two hyperfine levels of the ground state of the caesium 133 atom.

– Unit of electric current
The ampere is that constant current which if maintained in two straight parallel conductors of infinite length, of negligible circular cross-section and placed one metre apart in a vacuum, would produce between these conductors a force equal to 2×10^{-7} newton per metre of length.

– Unit of thermodynamic temperature
The kelvin, unit of thermodynamic temperature, is the fraction 1/273.16 of the thermodynamic temperature of the triple point of water.

– Unit of amount of substance
The mole is the amount of substance of a system which contains as many elementary entities as there are atoms in 0.012 kg of carbon 12. When the mole is used, the elementary entities must be specified and may be atoms, molecules, ions, electrons, other particles or specified groups of such particles.

– Unit of luminous intensity
The candela is the luminous intensity, in a given direction, of a source that emits monochromatic rays with a frequency of 540×10^{12} hertz and that has a radiant intensity in that direction of 1/683 watt per steradian.

1.1.1 Special name and symbol of the SI unit of temperature for expressing Celsius temperature

Quantity	Unit	
	Name	Symbol
Celsius temperature	degree Celsius	° C

Celsius temperature t is defined as the difference $t = T - T_o$ between the two thermodynamic temperatures T and T_o where $T_o = 273.15$ K. An interval of or difference in temperature may be expressed either in kelvins or in degrees Celsius. The unit of 'degree Celsius' is equal to the unit 'kelvin'.

1.2 Other SI units

1.2.1 Supplementary SI units

Quantity	Unit	
	Name	Symbol
Plane angle	radian	rad
Solid angle	steradian	sr

Definitions of supplementary SI units:

– Plane angle unit
The radian is the plane angle between two radii of a circle which cut off on the circumference an arc equal in length to the radius.

– Solid angle unit
The steradian is the solid angle of a cone which, having its vertex in the centre of a sphere, cuts off on the surface of the sphere an area equal to that of a square with sides equal to the radius of the sphere.

1.2.2 Derived SI units

Units derived coherently from SI base units and supplementary SI units are given as algebraic expressions in the form of products of powers of the SI base units and/or supplementary SI units with a numerical factor equal to 1.

1.2.3 Derived SI units having names and symbols

Quantity	Unit		Expression	
	Name	Symbol	In other SI units	In terms of base or supplementary SI units
Frequency	hertz	Hz		s^{-1}
Force	newton	N		$m.kg.s^{-2}$
Pressure, stress	pascal	Pa	$N.m^{-2}$	$m^{-1}.kg.s^{-2}$
Energy, work; quantity of heat	joule	J	N.m	$m^2.kg.s^{-2}$
Power(1), radiant flux	watt	W	$J.s^{-1}$	$m^2.kg.s^{-3}$
Quantity of electricity, electric charge	coulomb	C		s.A
Electric potential, potential difference, electromotive force	volt	V	$W.A^{-1}$	$m^2.kg.s^{-3}.A^{-1}$
Electric resistance	ohm	Ω	$V.A^{-1}$	$m^2.kg.s^{-3}.A^{-2}$
Conductance	siemens	S		$m^{-2}.kg^{-1}.s^3.A^2$
Capacitance	farad	F	$A.V^{-1}$	$m^{-2}.kg^{-1}.s^4.A^2$
Magnetic flux	weber	Wb	$C.V^{-1}$	$m^2.kg.s^{-2}.A^{-1}$
Magnetic flux density	tesla	T		$kg.s^{-2}.A^{-1}$
Inductance	henry	H	V.s	$m^2.kg.s^{-2}.A^{-2}$
Luminous flux	lumen	lm	$Wb.m^{-2}$	cd.sr

Quantity	Unit		Expression	
	Name	Symbol	In other SI units	In terms of base or supplementary SI units
Illuminance	lux	lx	$Wb.A^{-1}$	$m^{-2}.cd.sr$
Activity (of a radionuclide)	becquerel	Bq	$lm.m^{-2}$	s^{-1}
Absorbed dose, specific energy imparted, kerma, absorbed dose index	gray	Gy	$J.kg^{-1}$	$m^2.s^{-2}$
Dose equivalent	sievert	Sv	$J.kg^{-1}$	$m^2.s^{-2}$

(1) Special names for the unit of power: the name volt-ampere (symbol 'VA') is used to express the apparent power of alternating electric current, and var (symbol 'var') is used to express reactive electric power.

Units derived from SI base units or supplementary units may be expressed in terms of the units listed in this annex.

In particular, derived SI units may be expressed by the special names and symbols given in the above table. For example, the SI unit of dynamic viscosity may be expressed as $m^{-1}.kg.s^{-1}$ or $N.s.m^{-2}$ or Pa.s.

1.3 Prefixes and their symbols used to designate certain decimal multiples and submultiples

Factor	Prefix	Symbol	Factor	Prefix	Symbol
10^{24}	yotta	Y	10^{-1}	deci	d
10^{21}	zetta	Z	10^{-2}	centi	c
10^{18}	exa	E	10^{-3}	milli	m
10^{15}	peta	P	10^{-6}	micro	µ
10^{12}	tera	T	10^{-9}	nano	n
10^{9}	giga	G	10^{-12}	pico	p
10^{6}	mega	M	10^{-15}	femto	f
10^{3}	kilo	k	10^{-18}	atto	a
10^{2}	hecto	h	10^{-21}	zepto	z
10^{1}	deca	da	10^{-24}	yocto	y

The names and symbols of the decimal multiples and submultiples of the unit of mass are formed by attaching prefixes to the word 'gram' and their symbols to the symbol 'g'.

Where a derived unit is expressed as a fraction, its decimal multiples and submultiples may be designated by attaching a prefix to units in the numerator or the denominator, or in both these parts.

Compound prefixes, that is to say prefixes formed by the juxtaposition of several of the above prefixes, may not be used.

1.4 Special authorised names and symbols of decimal multiples and submultiples of SI units

Quantity	Unit		
	Name	Symbol	Value
Volume	litre	l or L[(1)]	1 l = 1 dm^3 = 10^{-3} m^3
Mass	tonne	t	1 t = 1 Mg = 10^3 kg
Pressure, stress	bar	bar	1 bar = 10^5 Pa

(1) The two symbols 'l' and 'L' may be used for the litre unit.

The prefixes and their symbols listed in 1.3 may be used in conjunction with the units and symbols contained in this table.

2. Units which are defined on the basis of SI units but are not decimal multiples or submultiples thereof

Quantity	Unit		
	Name	Symbol	Value
Plane angle	revolution[(a)]		1 revolution = 2 π rad
	grade or gon	gon	1 gon = π / 200 rad
	degree	°	1° = π / 180 rad
	minute of angle	'	1' = π / 10 800 rad
	second of angle	"	1" = π / 648 000 rad
Time	minute	min	1 min = 60 s
	hour	h	1 h = 3 600 s
	day	d	1 d = 86 400 s

(a) No international symbol exists

The prefixes listed in 1.3 may only be used in conjunction with the names 'grade' or 'gon' and the symbols only with the symbol 'gon'.

3. Units used with the SI, and whose values in SI are obtained experimentally

The unified atomic mass unit is 1/12 of the mass of an atom of the nuclide ^{12}C.

The electronvolt is the kinetic energy acquired by an electron passing through a potential difference of 1 volt in a vacuum.

Quantity	Unit		
	Name	Symbol	Value
Mass	unified atomic mass unit	U	1 u ≈ 1,6605655 x 10^{-27} kg
Energy	electronvolt	eV	1eV ≈ 1,6021892 x 10^{-19} J

The value of these units, expressed in SI units, is not known exactly.

The prefixes and their symbols listed in 1.3 may be used in conjunction with these two units and with their symbols.

4. Units and names of units permitted in specialised fields only

Quantity	Unit		
	Name	Symbol	Value
Vergency of optical systems	Dioptre		1 dioptre = 1 m^{-1}
Mass of precious stones	metric carat		1 metric carat = 2 x 10^{-4} kg
Area of farmland and building land	are	a	1 a = 10^2 m^2
Mass per unit length of textile yarns and threads	tex	tex	1 tex = 10^{-6} $kg.m^{-1}$
Blood pressure and pressure of other body fluids	millimetre of mercury	mm Hg	1 mm Hg = 133,322 Pa
Effective cross-sectional area	Barn	b	1b = 10^{-28} m^2

The prefixes and their symbols listed in 1.3 may be used in conjunction with the above units and symbols, with the exception of the millimetre of mercury and its symbol. The multiple of 10^2 a is, however, called a "hectare".

5. Compound units

Combinations of the units listed in this annex form compound units.

Chapter III

Claims

1. General

The application must contain "one or more claims". *Art. 78(1)(c)*

These must: *Art. 84*

(i) "define the matter for which protection is sought";

(ii) "be clear and concise"; and

(iii) "be supported by the description".

Since the extent of the protection conferred by a European patent or application is determined by the claims (interpreted with the help of the description and the drawings), clarity of claim is of the utmost importance (see also III, 4). *Art. 69(1)*

2. Form and content of claims

2.1 Technical features

The claims must be drafted in terms of the "technical features of the invention". This means that claims should not contain any statements relating, for example, to commercial advantages or other non-technical matters, but statements of purpose should be allowed if they assist in defining the invention. *Rule 43(1)*

It is not necessary that every feature should be expressed in terms of a structural limitation. Functional features may be included provided that a skilled person would have no difficulty in providing some means of performing this function without exercising inventive skill (see III, 6.5). For the specific case of a functional definition of a pathological condition, see III, 4.22.

Claims to the use of the invention, in the sense of the technical application thereof, are allowable.

2.2 Two-part form

Rule 43(1)(a) and (b) define the two-part form which a claim should have "wherever appropriate". The first part should contain a statement indicating "the designation of the subject-matter of the invention" i.e. the general technical class of apparatus, process, etc. to which the invention relates, followed by a statement of "those technical features which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art". This statement of prior-art features is applicable only to independent claims and not to dependent claims (see III, 3.4). It is clear from the wording of Rule 43 that it is necessary only to refer to those prior-art features which are *Rule 43(1)*

relevant to the invention. For example, if the invention relates to a photographic camera but the inventive step relates entirely to the shutter, it would be sufficient for the first part of the claim to read: "A photographic camera including a focal plane shutter" and there is no need to refer also to the other known features of a camera such as the lens and view-finder. The second part or "characterising portion" should state the features which the invention adds to the prior art, i.e. the technical features for which, in combination with the features stated in sub-paragraph (a) (the first part), protection is sought.

If a single document in the state of the art according to Art. 54(2), e.g. cited in the search report, reveals that one or more features in the second part of the claim were already known in combination with all the features in the first part of the claim and in that combination have the same effect as they have in the full combination according to the invention, the examiner should require that such feature or features be transferred to the first part. Where, however, a claim relates to a novel combination, and where the division of the features of the claim between the prior-art part and the characterising part could be made in more than one way without inaccuracy, the applicant should not be pressed, unless there are very substantial reasons, to adopt a different division of the features from that which he has chosen, if his version is not incorrect.

2.3 Two-part form unsuitable

Subject to what is stated in 2.3.2, final sentence, the applicant should be required to follow the above two-part formulation in his independent claim or claims, where, for example, it is clear that his invention resides in a distinct improvement in an old combination of parts or steps. However, as is indicated by Rule 43, this form need be used only in appropriate cases. The nature of the invention may be such that this form of claim is unsuitable, e.g. because it would give a distorted or misleading picture of the invention or the prior art. Examples of the kind of invention which may require a different presentation are:

(i) the combination of known integers of equal status, the inventive step lying solely in the combination;
(ii) the modification of, as distinct from addition to, a known chemical process e.g. by omitting one substance or substituting one substance for another; and
(iii) a complex system of functionally inter-related parts, the inventive step concerning changes in several of these or in their inter-relationships.

In examples (i) and (ii), the Rule 43 form of claim may be artificial and inappropriate, whilst in example (iii) it might lead to an inordinately lengthy and involved claim. Another example in which the Rule 43 form of claim may be inappropriate is where the invention is a new chemical compound or group of compounds. It is likely also that other cases will arise in which the applicant is able to adduce convincing reasons for formulating the claim in a different form.

2.3.1 No two-part form

There is a special instance in which the Rule 43 form of claim should be avoided. This is when the only relevant prior art is another European patent application falling within the terms of Art. 54(3). Such prior art should however be clearly acknowledged in the description (see II, 4.3, penultimate paragraph, and 4.4). *Art. 54(3)*

2.3.2 Two-part form "wherever appropriate"

When examining whether or not a claim is to be put in the form provided for in Rule 43(1), second sentence, it is important to assess whether this form is "appropriate". In this respect it should be borne in mind that the purpose of the two-part form is to allow the reader to see clearly which features necessary for the definition of the claimed subject-matter are, in combination, part of the prior art. If this is sufficiently clear from the indication of prior art made in the description, to meet the requirement of Rule 42(1)(b), the two-part form should not be insisted upon.

2.4 Formulae and tables

The claims, as well as the description, may contain chemical or mathematical formulae but not drawings. The claims may contain tables but "only if their subject-matter makes the use of tables desirable". In view of the use of the word "desirable" in this Rule, the examiner should not object to the use of tables in claims where this form is convenient. *Rule 49(9)*

3. Kinds of claim

3.1 Categories

The EPC refers to different "categories" of claim ("products, process, apparatus or use"). For many inventions, claims in more than one category are needed for full protection. In fact, there are only two basic kinds of claim, viz. claims to a physical entity (product, apparatus) and claims to an activity (process, use). The first basic kind of claim ("product claim") includes a substance or compositions (e.g. chemical compound or a mixture of compounds) as well as any physical entity (e.g. object, article, apparatus, machine, or system of co-operating apparatus) which is produced by a person's technical skill. Examples are: "a steering mechanism incorporating an automatic feed-back circuit ..."; "a woven garment comprising ..."; "an insecticide consisting of X, Y, Z"; or "a communication system comprising a plurality of transmitting and receiving stations". The second basic kind of claim ("process claim") is applicable to all kinds of activities in which the use of some material product for effecting the process is implied; the activity may be exercised upon material products, upon energy, upon other processes (as in control processes) or upon living things (see, however, IV, 4.6 and 4.8). *Rule 43(2)*

3.2 Number of independent claims

According to Rule 43(2), as applicable to all European patent applications in respect of which a communication under Rule 51(4) *Rule 43(2)*

EPC 1973 (corresponding to Rule 71(3) EPC 2000) was not issued by 2 January 2002, the number of independent claims is limited to one independent claim in each category.

Exceptions from this rule can only be admitted in the specific circumstances defined in sub-paragraphs (a), (b) or (c) of this rule, provided the requirement of Art. 82 with regard to unity is met (see III, 7).

The following are examples of typical situations falling within the scope of the exceptions from the principle of one independent claim per category:

(i) examples of a plurality of inter-related products (Rule 43(2)(a)):

– plug and socket;

– transmitter – receiver;

– intermediate(s) and final chemical product;

– gene – gene construct – host – protein – medicament;

(ii) example of a plurality of different inventive uses of a product or device (Rule 43(2)(b)):

– claims directed to *second or* further medical uses when a first medical use is known (see IV, 4.8);

(iii) examples of alternative solutions to a particular problem (Rule 43(2)(c)):

– a group of chemical compounds;

– two or more processes for the manufacture of such compounds.

3.3 Objection under Rule 43(2) or Rule 137(5)

Where the application was considered not to comply with Rule 43(2) when the European or supplementary European search report was prepared, this may have led to the issuing of a search report restricted to one independent claim in each category, or to a sub-group of independent claims in each category where these complied with Rule 43(2). Such a limitation of the search report would have been in accordance with Rule 62a(1) (see B-VIII, 4.1 and 4.2). Where this unjustified plurality of independent claims in the same category persists in the application under examination, an objection is raised under Rule 43(2) (for applications where a search opinion accompanies the search report, this objection may already have been raised in the search opinion). If no Rule 62a(1) invitation was sent at the search stage, the Examining Division can still raise an objection

under Rule 43(2). If the application is a Euro-PCT application not subject to the preparation of a supplementary European search report (see B-II, 4.3), an objection under Rule 43(2) may also arise in examination.

When an objection under Rule 43(2) arises, the applicant is invited to amend the claims appropriately. If the search was restricted in accordance with Rule 62a, and the Examining Division upholds the objection under Rule 43(2) despite possible counter-arguments provided by the applicant in his response to the invitation under Rule 62a(1) (see B-VIII, 4.2) or to the search opinion under Rule 70a (see B-XII, 9), the claims must be amended in such a way as to result in the removal of all subject-matter excluded from the search (Rule 62a(2)) and the description amended accordingly. *Rule 43(2)*

If in reply to the reasoned objection (raised or confirmed in a communication from the Examining Division) the additional independent claims are maintained and no convincing arguments are presented that one of the situations referred to in sub-paragraphs (a) to (c) of Rule 43(2) applies, the application may be refused under Art. 97(2).

If the application is amended to provide a set of claims complying with Rule 43(2), but containing one or more claims directed to subject-matter excluded from the search in accordance with Rule 62a(1), an objection under Rule 137(5) arises and the application may also be refused for this reason under Art. 97(2). However, before such a decision can be taken, it will be necessary to allow the applicant to comment according to Art. 113(1) on the underlying issue of whether or not the claims in respect of which the invitation under Rule 62a(1) was sent did in fact comply with Rule 43(2).

Where the application also lacks unity of invention, the examiner may raise an objection under either Rule 43(2) or Art. 82 or under both. The applicant cannot contest which of these objections has priority (see T 1073/98, Reasons 7.2).

3.4 Independent and dependent claims

All applications will contain one or more "independent" claims directed to the essential features of the invention. Any such claim may be followed by one or more claims concerning "particular embodiments" of that invention. It is evident that any claim relating to a particular embodiment must effectively include also the essential features of the invention, and hence must include all the features of at least one independent claim. The term "particular embodiment" should be construed broadly as meaning any more specific disclosure of the invention than that set out in the independent claim or claims. *Rule 43(3) and (4)*

Any claim which includes all the features of any other claim is termed a "dependent claim". Such a claim must contain, if possible at the beginning, a reference to the other claim, all features of which it *Rule 43(4)*

includes (see, however, III, 3.8 for claims in different categories). Since a dependent claim does not by itself define all the characterising features of the subject-matter which it claims, expressions such as "characterised in that" or "characterised by" are not necessary in such a claim but are nevertheless permissible. A claim defining further particulars of an invention may include all the features of another dependent claim and should then refer back to that claim. Also, in some cases, a dependent claim may define a particular feature or features which may appropriately be added to more than one previous claim (independent or dependent). It follows that there are several possibilities: a dependent claim may refer back to one or more independent claims, to one or more dependent claims, or to both independent and dependent claims.

3.5 Arrangement of claims

Rule 43(4)

All dependent claims referring back to a single previous claim and those referring back to several previous claims must be grouped together to the extent and in the most appropriate way possible. The arrangement must therefore be one which enables the association of related claims to be readily determined and their meaning in association to be readily construed. The examiner should object if the arrangement of claims is such as to create obscurity in the definition of the subject-matter to be protected. In general, however, when the corresponding independent claim is allowable, the examiner should not concern himself unduly with the subject-matter of dependent claims, provided he is satisfied that they are truly dependent and thus in no way extend the scope of protection of the invention defined in the corresponding independent claim (see also III, 3.8).

3.6 Subject-matter of a dependent claim

If the two-part form is used for the independent claim(s), dependent claims may relate to further details of features not only of the characterising portion but also of the preamble.

3.7 Alternatives in a claim

Art. 84
Art. 82

A claim, whether independent or dependent, may refer to alternatives, provided that the number and presentation of alternatives in a single claim does not make the claim obscure or difficult to construe and provided that the claim meets the requirements of unity (see also III, 7.4 and 7.8). In case of a claim defining (chemical or non-chemical) alternatives, i.e. a so-called "Markush-grouping", unity of invention should be considered to be present if the alternatives are of a similar nature and can fairly be substituted for one another (see III, 7.4.1).

3.8 Independent claims containing a reference to another claim

A claim may also contain a reference to another claim even if it is not a dependent claim as defined in Rule 43(4). One example of this is a claim referring to a claim of a different category (e.g. "Apparatus for carrying out the process of claim 1 ...", or "Process for the manufacture of the product of claim 1 ..."). Similarly, in a situation like the plug and socket example of III, 3.2(i), a claim to the one part referring to the

other co-operating part (e.g. "plug for co-operation with the socket of claim 1 ...") is not a dependent claim. In all these examples, the examiner should carefully consider the extent to which the claim containing the reference necessarily involves the features of the claim referred to and the extent to which it does not.

In the case of a claim for a process which results in the product of a product claim, if the product claim is patentable then no separate examination for the novelty and non-obviousness of the process claim is necessary (see IV, 11.12), provided that all features of the product as defined in the product claim inevitably (cf. IV, 11.12) result from the claimed process (see III, 4.5, and T 169/88, not published in OJ). This also applies in the case of a claim for the use of a product, when the product is patentable and is used with its features as claimed (see T 642/94, not published in OJ). In all other instances, the patentability of the claim referred to does not necessarily imply the patentability of the independent claim containing the reference. It should also be noted that if the process, product and/or use claims have different effective dates (see V, 1 and 2), a separate examination may still be necessary in view of intermediate documents.

4. Clarity and interpretation of claims

4.1 Clarity

Art. 84

The requirement that the claims must be clear applies to individual claims and also to the claims as a whole. The clarity of the claims is of the utmost importance in view of their function in defining the matter for which protection is sought. Therefore, the meaning of the terms of a claim should, as far as possible, be clear for the person skilled in the art from the wording of the claim alone (see also III, 4.2). In view of the differences in the scope of protection which may be attached to the various categories of claims, the examiner should ensure that the wording of a claim leaves no doubt as to its category.

Where it is found that the claims lack clarity under Art. 84, this may have led to the issuing of a partial European or supplementary European search report under Rule 63 (see B-VIII, 3.1 and 3.2). In such cases, in the absence of appropriate amendment and/or convincing arguments from the applicant as to why the invitation under Rule 63(1) was not justified, an objection under Rule 63(3) will also arise (see VI, 5.6).

4.2 Interpretation

Each claim should be read giving the words the meaning and scope which they normally have in the relevant art, unless in particular cases the description gives the words a special meaning, by explicit definition or otherwise. Moreover, if such a special meaning applies, the examiner should, so far as possible, require the claim to be amended whereby the meaning is clear from the wording of the claim alone. This is important because it is only the claims of the European patent, not the description, which will be published in all the official languages of

the EPO. The claim should also be read with an attempt to make technical sense out of it. Such a reading may involve a departure from the strict literal meaning of the wording of the claims. Art. 69 and its Protocol do not provide a basis for excluding what is literally covered by the terms of the claims (see T 223/05).

4.3 Inconsistencies

Any inconsistency between the description and the claims should be avoided if it may throw doubt on the extent of protection and therefore render the claim unclear or unsupported under Art. 84, second sentence or, alternatively, render the claim objectionable under Art. 84, first sentence. Such inconsistency can be of the following kinds:

(i) simple verbal inconsistency

For example, there is a statement in the description which suggests that the invention is limited to a particular feature but the claims are not thus limited; also, the description places no particular emphasis on this feature and there is no reason for believing that the feature is essential for the performance of the invention. In such a case, the inconsistency can be removed either by broadening the description or by limiting the claims. Similarly, if the claims are more limited than the description, the claims may be broadened or the description may be limited.

(ii) inconsistency regarding apparently essential features

For example, it may appear, either from general technical knowledge or from what is stated or implied in the description, that a certain described technical feature not mentioned in an independent claim is essential to the performance of the invention, or, in other words, is necessary for the solution of the problem to which the invention relates. In such a case, the claim does not meet the requirements of Art. 84, because Art. 84, first sentence, when read in conjunction with Rule 43(1) and (3), has to be interpreted as meaning not only that an independent claim must be comprehensible from a technical point of view but also that it must clearly define the subject-matter of the invention, that is to say indicate all the essential features thereof (see T 32/82, OJ 8/1984, 354). If, in response to this objection, the applicant shows convincingly, e.g. by means of additional documents or other evidence, that the feature is in fact not essential, he may be allowed to retain the unamended claim and, where necessary, to amend the description instead. The opposite situation in which an independent claim includes features which do not seem essential for the performance of the invention is not objectionable. This is a matter of the applicant's choice. The examiner should therefore not suggest that a claim be broadened by the omission of apparently inessential features;

(iii) part of the subject-matter of the description and/or drawings is not covered by the claims

For example, the claims all specify an electric circuit employing semiconductor devices but one of the embodiments in the description and drawings employs electronic tubes instead. In such a case, the inconsistency can normally be removed either by broadening the claims (assuming that the description and drawings as a whole provide adequate support for such broadening) or by removing the "excess" subject-matter from the description and drawings. However, if examples in the description and/or drawings which are not covered by the claims are presented not as embodiments of the invention but as background art or examples which are useful for understanding the invention, the retention of these examples may be allowed.

4.4 General statements, "spirit" of invention

General statements in the description which imply that the extent of protection may be expanded in some vague and not precisely defined way should be objected to. In particular, objection should be raised to any statement which refers to the extent of protection being expanded to cover the "spirit" of the invention. Objection should likewise be raised, in the case where the claims are directed to a combination of features, to any statement which seems to imply that protection is nevertheless sought not only for the combination as a whole but also for individual features or sub-combinations thereof.

4.5 Essential features

An independent claim should specify explicitly all of the essential features needed to define the invention except insofar as such features are implied by the generic terms used, e.g. a claim to a "bicycle" does not need to mention the presence of wheels.

If a claim is to a process for producing the product of the invention, then the process as claimed should be one which, when carried out in a manner which would seem reasonable to a person skilled in the art, necessarily has as its end result that particular product; otherwise there is an internal inconsistency and therefore lack of clarity in the claim.

In the case of a product claim, if the product is of a well-known kind and the invention lies in modifying it in certain respects, it is sufficient that the claim clearly identifies the product and specifies what is modified and in what way. Similar considerations apply to claims for an apparatus.

Where patentability depends on a technical effect, the claims must be so drafted as to include all the technical features of the invention which are essential for the technical effect (see T 32/82, OJ 8/1984, 354).

4.6 Relative terms

It is preferable not to use a relative or similar term such as "thin", "wide" or "strong" in a claim unless the term has a well-recognised meaning in the particular art, e.g. "high-frequency" in relation to an amplifier, and this is the meaning intended. Where the term has no well-recognised

meaning it should, if possible, be replaced by a more precise wording found elsewhere in the original disclosure. Where there is no basis in the disclosure for a clear definition and the term is not essential having regard to the invention, it should normally be retained in the claim, because to excise it would generally lead to an extension of the subject-matter beyond the content of the application as filed - in contravention of Art. 123(2). However, an unclear term cannot be allowed in a claim if the term is essential having regard to the invention. Equally, an unclear term cannot be used by the applicant to distinguish his invention from the prior art.

4.7 Terms like "about" and "approximately"

Particular attention is required whenever the word "about" or similar terms such as "approximately" are used. Such a word may be applied, for example, to a particular value (e.g. "about 200°C") or to a range (e.g. "about x to about y"). In each case, the examiner should use his judgment as to whether the meaning is sufficiently clear in the context of the application read as a whole. However, the word can only be permitted if its presence does not prevent the invention from being unambiguously distinguished from the prior art with respect to novelty and inventive step.

4.8 Trademarks

The use of trade marks and similar expressions in claims should not be allowed as it may not be guaranteed that the product or feature referred to is not modified while maintaining its name during the term of the patent. They may be allowed exceptionally if their use is unavoidable and they are generally recognised as having a precise meaning (see also II, 4.17 and 4.18).

4.9 Optional features

Expressions like "preferably", "for example", "such as" or "more particularly" should be looked at carefully to ensure that they do not introduce ambiguity. Expressions of this kind have no limiting effect on the scope of a claim; that is to say, the feature following any such expression is to be regarded as entirely optional.

4.10 Result to be achieved

The area defined by the claims must be as precise as the invention allows. As a general rule, claims which attempt to define the invention by a result to be achieved should not be allowed, in particular if they only amount to claiming the underlying technical problem. However, they may be allowed if the invention either can only be defined in such terms or cannot otherwise be defined more precisely without unduly restricting the scope of the claims and if the result is one which can be directly and positively verified by tests or procedures adequately specified in the description or known to the person skilled in the art and which do not require undue experimentation (see T 68/85, OJ 6/1987, 228). For example, the invention may relate to an ashtray in which a smouldering cigarette end will be automatically extinguished due to the shape and relative dimensions of the ashtray. The latter may

vary considerably in a manner difficult to define whilst still providing the desired effect. So long as the claim specifies the construction and shape of the ashtray as clearly as possible, it may define the relative dimensions by reference to the result to be achieved, provided that the specification includes adequate directions to enable the reader to determine the required dimensions by routine test procedures (see II, 4.9 to 4.11).

It should be noted that the above-mentioned requirements for allowing a definition of subject-matter in terms of a result to be achieved differ from those for allowing a definition of subject-matter in terms of functional features (cf. III, 4.22 and 6.5).

4.11 Parameters

Where the invention relates to a product, it may be defined in a claim in various ways, viz. as a chemical product by its chemical formula, as a product of a process (if no clearer definition is possible; see also III, 4.12) or, exceptionally, by its parameters.

Parameters are characteristic values, which may be values of directly measurable properties (e.g. the melting point of a substance, the flexural strength of a steel, the resistance of an electrical conductor) or may be defined as more or less complicated mathematical combinations of several variables in the form of formulae.

Characterisation of a product mainly by its parameters should only be allowed in those cases where the invention cannot be adequately defined in any other way, provided that those parameters can be clearly and reliably determined either by indications in the description or by objective procedures which are usual in the art (see T 94/82, OJ 2/1984, 75). The same applies to a process-related feature which is defined by parameters. Cases in which unusual parameters are employed or a non-accessible apparatus for measuring the parameter(s) is used are prima facie objectionable on grounds of lack of clarity, as no meaningful comparison with the prior art can be made. Such cases might also disguise lack of novelty (see IV, 9.6).

Whether the method of and the means for measurement of the parameters need also be in the claim is dealt with in III, 4.18.

4.12 Product-by-process claim

Claims for products defined in terms of a process of manufacture are allowable only if the products as such fulfil the requirements for patentability, i.e. inter alia that they are new and inventive. A product is not rendered novel merely by the fact that it is produced by means of a new process (see T 150/82, OJ 7/1984, 309). A claim defining a product in terms of a process is to be construed as a claim to the product as such. The claim may for instance take the form "Product X obtainable by process Y". Irrespective of whether the term "obtainable", "obtained", "directly obtained" or an equivalent wording is used in the product-by-process claim, it is still directed to the product

per se and confers absolute protection upon the product (see T 20/94, not published in OJ).

Art. 64(2)

According to Art. 64(2), if the subject-matter of a European patent is a process, the protection conferred by the patent extends to the products directly obtained by such process. The provisions of this Article are understood to apply to processes producing products completely different from the starting materials as well as to the processes producing only superficial changes (e.g. painting, polishing). However, Art. 64(2) does not affect the examination of claims in respect of their patentability under the EPC and is not to be taken into account by an Examining Division (T 103/00).

4.13 "Apparatus for ...", "Method for ...", etc.

If a claim commences with such words as: "Apparatus for carrying out the process etc..." this must be construed as meaning merely apparatus suitable for carrying out the process. Apparatus which otherwise possesses all of the features specified in the claims but which would be unsuitable for the stated purpose or would require modification to enable it to be so used, should normally not be considered as anticipating the claim.

Similar considerations apply to a claim for a product for a particular use. For example, if a claim refers to a "mold for molten steel", this implies certain limitations for the mold. Therefore, a plastic ice cube tray with a melting point much lower than that of steel would not come within the claim. Similarly, a claim to a substance or composition for a particular use should be construed as meaning a substance or composition which is in fact suitable for the stated use; a known product which prima facie is the same as the substance or composition defined in the claim, but which is in a form which would render it unsuitable for the stated use, would not deprive the claim of novelty. However, if the known product is in a form in which it is in fact suitable for the stated use, though it has never been described for that use, it would deprive the claim of novelty. An exception to this general principle of interpretation is where the claim is to a known substance or composition for use in a surgical, therapeutic or diagnostic method (see IV, 4.8).

In contrast to an apparatus or product claim, in case of a method claim commencing with such words as: "Method for remelting galvanic layers" the part "for remelting ..." should not be understood as meaning that the process is merely suitable for remelting galvanic layers, but rather as a functional feature concerning the remelting of galvanic layers and, hence, defining one of the method steps of the claimed method (see T 848/93, not published in OJ).

4.14 Definition by reference to use or another entity

Where a claim in respect of a physical entity (product, apparatus) seeks to define the invention by reference to features relating to the entity's use, a lack of clarity can result. This is particularly the case

where the claim not only defines the entity itself but also specifies its relationship to a second entity which is not part of the claimed entity (for example, a cylinder head for an engine, where the former is defined by features of its location in the latter). Before considering a restriction to the combination of the two entities, if should always be remembered that the applicant is normally entitled to independent protection of the first entity per se, even if it was initially defined by its relationship to the second entity. Since the first entity can often be produced and marketed independently of the second entity, it will usually be possible to obtain independent protection by wording the claims appropriately (for example, by substituting "connectable" for "connected"). If it is not possible to give a clear definition of the first entity per se, then the claim should be directed to a combination of the first and second entities (for example, "engine with a cylinder head" or "engine comprising a cylinder head").

It may also be allowable to define the dimensions and/or shape of a first entity in an independent claim by general reference to the dimensions and/or corresponding shape of a second entity which is not part of the claimed first entity but is related to it through use. This particularly applies where the size of the second entity is in some way standardised (for example, in the case of a mounting bracket for a vehicle number-plate, where the bracket frame and fixing elements are defined in relation to the outer shape of the number-plate). However, references to second entities which cannot be seen as subject to standardisation may also be sufficiently clear in cases where the skilled person would have little difficulty in inferring the resultant restriction of the scope of protection for the first entity (for example, in the case of a covering sheet for an agricultural round bale, where the length and breadth of the covering sheet and how it is folded are defined by reference to the bale's circumference, width and diameter, see T 455/92, not published in OJ). It is neither necessary for such claims to contain the exact dimensions of the second entity, nor do they have to refer to a combination of the first and second entities. Specifying the length, width and/or height of the first entity without reference to the second would lead to an unwarranted restriction of the scope of protection.

4.15 The expression "in"

To avoid ambiguity, particular care should be exercised when assessing claims which employ the word "in" to define a relationship between different physical entities (product, apparatus), or between entities and activities (process, use), or between different activities. Examples of claims worded in this way include the following:

(i) Cylinder head in a four-stroke engine;

(ii) In a telephone apparatus with an automatic dialler, dial tone detector and feature controller, the dial tone detector comprising...;

(iii) In a process using an electrode feeding means of an arc-welding apparatus, a method for controlling the arc welding current and voltage comprising the following steps: ...; and

(iv) In a process/system/apparatus etc. ... the improvement consisting of...

In examples (i) to (iii) the emphasis is on the fully functioning sub-units (cylinder head, dial tone detector, method for controlling the arc welding current and voltage) rather than the complete unit within which the sub-unit is contained (four-stroke engine, telephone, process). This can make it unclear whether the protection sought is limited to the sub-unit per se, or whether the unit as a whole is to be protected. For the sake of clarity, claims of this kind should be directed either to "a unit with (or comprising) a sub-unit" (e.g. "four-stroke engine with a cylinder head"), or to the sub-unit per se, specifying its purpose (for example, "cylinder head for a four-stroke engine"). The latter course may be followed only at the applicant's express wish and only if there is a basis for it in the application as filed, in accordance with Art. 123(2).

With claims of the type indicated by example (iv), the use of the word "in" sometimes makes it unclear whether protection is sought for the improvement only or for all the features defined in the claim. Here, too, it is essential to ensure that the wording is clear.

However, claims such as "use of a substance ... as an anticorrosive ingredient in a paint or lacquer composition" are acceptable on the basis of second non-medical use (see IV, 9.7, second paragraph).

4.16 Use claims

For the purposes of examination, a "use" claim in a form such as "the use of substance X as an insecticide" should be regarded as equivalent to a "process" claim of the form "a process of killing insects using substance X". Thus a claim in the form indicated should not be interpreted as directed to the substance X recognisable (e.g. by further additives) as intended for use as an insecticide. Similarly, a claim for "the use of a transistor in an amplifying circuit" would be equivalent to a process claim for the process of amplifying using a circuit containing the transistor and should not be interpreted as being directed to "an amplifying circuit in which the transistor is used", nor to "the process of using the transistor in building such a circuit". However, a claim directed to the use of a process for a particular purpose is equivalent to a claim directed to that very same process (see T 684/02).

4.17 References to the description or drawings

Rule 43(6)

The claims must not, in respect of the technical features of the invention, rely on references to the description or drawings "except where absolutely necessary". In particular they must not normally rely on such references as "as described in part ... of the description", or "as illustrated in Figure 2 of the drawings". The emphatic wording of the excepting clause should be noted. The onus is upon the applicant to

show that it is "absolutely necessary" to rely on reference to the description or drawings in appropriate cases (see T 150/82, OJ 7/1984, 309). An example of an allowable exception would be that in which the invention involves some peculiar shape, illustrated in the drawings, but which cannot be readily defined either in words or by a simple mathematical formula. Another special case is that in which the invention relates to chemical products some of whose features can be defined only by means of graphs or diagrams.

4.18 Method of and means for measuring parameters referred to in claims

A further special case is where the invention is characterised by parameters. Provided that the conditions for defining the invention in this way are met (see III, 4.11), the definition of the invention should appear completely in the claim itself whenever this is reasonably practicable. In principle the method of measurement is necessary for the unambiguous definition of the parameter. The method of and means for measurement of the parameter values need not however be in the claims when:

(i) the description of the method is so long that its inclusion would make the claim unclear through lack of conciseness or difficult to understand; in that case the claim should include a reference to the description, in accordance with Rule 43(6);

(ii) a person skilled in the art would know which method to employ, e.g. because there is only one method, or because a particular method is commonly used; or

(iii) all known methods yield the same result (within the limits of measurement accuracy).

However, in all other cases the method of and means for measurement should be included in the claims as the claims define the matter for which protection is sought (Art. 84).

4.19 Reference signs

Rule 43(7)

If the application contains drawings, and the comprehension of the claims would be improved by establishing the connection between the features mentioned in the claims and the corresponding reference signs in the drawings, then appropriate reference signs should be placed in parentheses after the features mentioned in the claims. If there is a large number of different embodiments, only the reference signs of the most important embodiments need be incorporated in the independent claim(s). Where claims are drafted in the two-part form set out in Rule 43(1), the reference signs should be inserted not only in the characterising part but also in the preamble of the claims. Reference signs should not however be seen as limiting the extent of the matter protected by the claims; their sole function is to make claims easier to understand. A comment to that effect in the description is acceptable (see T 237/84, OJ 7/1987, 309).

If text is added to reference signs in parentheses in the claims, lack of clarity can arise (Art. 84). Expressions such as "securing means (screw 13, nail 14)" or "valve assembly (valve seat 23, valve element 27, valve seat 28)" are not reference signs in the sense of Rule 43(7) but are special features, to which the last sentence of Rule 43(7) is not applicable. Consequently, it is unclear whether the features added to the reference signs are limiting or not. Accordingly, such bracketed features are generally not permissible. However, additional references to those figures where particular reference signs are to be found, such as "(13 - Figure 3; 14 - Figure 4)", are unobjectionable.

A lack of clarity can also arise with bracketed expressions that do not include reference signs, e.g. "(concrete) moulded brick". In contrast, bracketed expressions with a generally accepted meaning are allowable, e.g.-"(meth)acrylate" which is known as an abbreviation for "acrylate and methacrylate". The use of brackets in chemical or mathematical formulae is also unobjectionable.

4.20 Negative limitations (e.g. disclaimers)

A claim's subject-matter is normally defined in terms of positive features indicating that certain technical elements are present. Exceptionally, however, the subject-matter may be restricted using a negative limitation expressly stating that particular features are absent. This may be done e.g. if the absence of a feature can be deduced from the application as filed (see T 278/88, not published in OJ).

Negative limitations such as disclaimers may be used only if adding positive features to the claim either would not define more clearly and concisely the subject-matter still protectable (see T 4/80, OJ 4/1982, 149) or would unduly limit the scope of the claim (see T 1050/93, not published in OJ). It has to be clear what is excluded by means of the disclaimer (see T 286/06).

Disclaimers excluding embodiments that were disclosed in the original application as being part of the invention are considered as undisclosed disclaimers (see T 1102/00, T 1050/99, T 236/01, T 868/04). With respect to the allowability of a disclaimer not disclosed in the application as filed, see VI, 5.3.11.

4.21 "Comprising" vs. "consisting"

While in everyday language the word "comprise" may have both the meaning "include", "contain" or "comprehend" and "consist of", in drafting patent claims legal certainty normally requires it to be interpreted by the broader meaning "include", "contain" or "comprehend". On the other hand, if a claim for a chemical compound refers to it as "consisting of components A, B and C" by their proportions expressed in percentages, the presence of any additional component is excluded and therefore the percentages should add up to 100% (see T 759/91 and T 711/90, both not published in OJ).

4.22 Functional definition of a pathological condition

When a claim is directed to a further therapeutic application of a medicament and the condition to be treated is defined in functional terms, e.g. "any condition susceptible of being improved or prevented by selective occupation of a specific receptor", the claim can be regarded as clear only if instructions, in the form of experimental tests or testable criteria, are available from the patent documents or from the common general knowledge allowing the skilled person to recognise which conditions fall within the functional definition and accordingly within the scope of the claim (T 241/95, OJ 2/2001, 103) (see also IV, 4.8).

5. Conciseness, number of claims

Art. 84
Rule 43(5)

The requirement that the claims must be concise refers to the claims in their entirety as well as to the individual claims. The number of claims must be considered in relation to the nature of the invention the applicant seeks to protect. Undue repetition of wording, e.g. between one claim and another, should be avoided by the use of the dependent form. Regarding independent claims in the same category see III, 3.2 and 3.3. As for dependent claims, while there is no objection to a reasonable number of such claims directed to particular preferred features of the invention, the examiner should object to a multiplicity of claims of a trivial nature. What is or what is not a reasonable number of claims depends on the facts and circumstances of each particular case. The interests of the relevant public must also be borne in mind. The presentation of the claims should not make it unduly burdensome to determine the matter for which protection is sought (T 79/91 and T 246/91, not published in OJ). Objection may also arise where there is a multiplicity of alternatives within a single claim, if this renders it unduly burdensome to determine the matter for which protection is sought.

Where it is found that the claims lack conciseness under Art. 84, this may have led to the issuing of a partial European or supplementary European search report under Rule 63 (see B-VIII, 3.1 and 3.2). In such cases, in the absence of appropriate amendment and/or convincing arguments from the applicant as to why the invitation under Rule 63(1) was not justified, an objection under Rule 63(3) will also arise (see VI, 5.6).

6. Support in description

6.1 General remarks

Art. 84

The claims must be supported by the description. This means that there must be a basis in the description for the subject-matter of every claim and that the scope of the claims must not be broader than is justified by the extent of the description and drawings and also the contribution to the art (T 409/91, OJ 9/1994, 653). Regarding the support of dependent claims by the description, see III, 6.6.

6.2 Extent of generalisation

Most claims are generalisations from one or more particular examples. The extent of generalisation permissible is a matter which the examiner must judge in each particular case in the light of the relevant prior art. Thus an invention which opens up a whole new field is entitled to more generality in the claims than one which is concerned with advances in a known technology. A fair statement of claim is one which is not so broad that it goes beyond the invention nor yet so narrow as to deprive the applicant of a just reward for the disclosure of his invention. The applicant should be allowed to cover all obvious modifications of, equivalents to and uses of that which he has described. In particular, if it is reasonable to predict that all the variants covered by the claims have the properties or uses the applicant ascribes to them in the description, he should be allowed to draw his claims accordingly. After the date of filing, however, he should be allowed to do so only if this does not contravene Art. 123(2).

6.3 Objection of lack of support

As a general rule, a claim should be regarded as supported by the description unless there are well-founded reasons for believing that the skilled person would be unable, on the basis of the information given in the application as filed, to extend the particular teaching of the description to the whole of the field claimed by using routine methods of experimentation or analysis. Support must, however, be of a technical character; vague statements or assertions having no technical content provide no basis.

The examiner should raise an objection of lack of support only if he has well-founded reasons. Once the examiner has set out a reasoned case that, for example, a broad claim is not supported over the whole of its breadth, the onus of demonstrating that the claim is fully supported lies with the applicant (see VI, 2.3). Where an objection is raised, the reasons should, where possible, be supported specifically by a published document.

A claim in generic form, i.e. relating to a whole class, e.g. of materials or machines, may be acceptable even if of broad scope, if there is fair support in the description and there is no reason to suppose that the invention cannot be worked through the whole of the field claimed. Where the information given appears insufficient to enable a person skilled in the art to extend the teaching of the description to parts of the field claimed but not explicitly described by using routine methods of experimentation or analysis, the examiner should raise a reasoned objection, and invite the applicant to establish, by suitable response, that the invention can in fact be readily applied on the basis of the information given over the whole field claimed or, failing this, to restrict the claim accordingly.

The question of support is illustrated by the following examples:

(i) a claim relates to a process for treating all kinds of "plant seedlings" by subjecting them to a controlled cold shock so as to produce specified results, whereas the description discloses the process applied to one kind of plant only. Since it is well-known that plants vary widely in their properties, there are well-founded reasons for believing that the process is not applicable to all plant seedlings. Unless the applicant can provide convincing evidence that the process is nevertheless generally applicable, he must restrict his claim to the particular kind of plant referred to in the description. A mere assertion that the process is applicable to all plant seedlings is not sufficient;

(ii) a claim relates to a specified method of treating "synthetic resin mouldings" to obtain certain changes in physical characteristics. All the examples described relate to thermoplastic resins and the method is such as to appear inappropriate to thermosetting resins. Unless the applicant can provide evidence that the method is nevertheless applicable to thermosetting resins, he must restrict his claim to thermoplastic resins;

(iii) a claim relates to improved fuel oil compositions which have a given desired property. The description provides support for one way of obtaining fuel oils having this property, which is by the presence of defined amounts of a certain additive. No other ways of obtaining fuel oils having the desired property are disclosed. The claim makes no mention of the additive. The claim is not supported over the whole of its breadth and objection arises.

Where it is found that the claims lack support in the description under Art. 84, this may have led to the issuing of a partial European or supplementary European search report under Rule 63 (see B-VIII, 3.1 and 3.2). In such cases, in the absence of appropriate amendment and/or convincing arguments provided by the applicant in his response to the invitation under Rule 63(1) (see B-VIII, 4.2) or to the search opinion under Rule 70a (see B-XII, 9), an objection under Rule 63(3) will also arise (see VI, 5.6).

6.4 Lack of support vs. insufficient disclosure

Art. 83
Art. 84

It should be noted that, although an objection of lack of support is an objection under Art. 84, it can often, as in the above examples, also be considered as an objection of insufficient disclosure of the invention under Art. 83 (see II, 4.9 to 4.11), the objection being that the disclosure is insufficient to enable the skilled person to carry out the "invention" over the whole of the broad field claimed (although sufficient in respect of a narrow "invention"). Both requirements are designed to reflect the principle that the terms of a claim should be commensurate with, or be justified by, the invention. Whether the objection is raised as lack of support or as insufficiency is unimportant in examination proceedings; but it is important in opposition proceedings since there only the latter ground is available (see D-III, 5).

6.5 Definition in terms of function

A claim may broadly define a feature in terms of its function, i.e. as a functional feature, even where only one example of the feature has been given in the description, if the skilled reader would appreciate that other means could be used for the same function (see also III, 2.1 and III, 4.10). For example, "terminal position detecting means" in a claim might be supported by a single example comprising a limit switch, it being evident to the skilled person that e.g. a photoelectric cell or a strain gauge could be used instead. In general, however, if the entire contents of the application are such as to convey the impression that a function is to be carried out in a particular way, with no intimation that alternative means are envisaged, and a claim is formulated in such a way as to embrace other means, or all means, of performing the function, then objection arises. Furthermore, it may not be sufficient if the description merely states in vague terms that other means may be adopted, if it is not reasonably clear what they might be or how they might be used.

6.6 Support for dependent claims

Where certain subject-matter is clearly disclosed in a claim of the application as filed, but is not mentioned anywhere in the description, it is permissible to amend the description so that it includes this subject-matter. Where the claim is dependent, it may suffice if it is mentioned in the description that the claim sets out a particular embodiment of the invention (see II, 4.5).

7. Unity of invention

7.1 General remarks

Art. 82
Rule 43(2)

A European application must "relate to one invention only or to a group of inventions so linked as to form a single general inventive concept". The second of these alternatives, i.e. the single-concept linked group, may give rise to a plurality of independent claims in the same category provided these claims comply with Rule 43(2) (see III, 3.2 and 3.3), but the more usual case is a plurality of independent claims in different categories.

Where the application both lacks unity of invention and fails to comply with the requirements of Rule 43(2), the examiner may raise an objection under either Rule 43(2) or Art. 82 or under both. The applicant cannot contest which of these objections has priority (see T 1073/98, Reasons 7.2).

7.2 Special technical features

Rule 44(1)

Rule 44(1) indicates how one determines whether or not the requirement of Art. 82 is fulfilled when more than one invention appears to be present. The link between the inventions required by Art. 82 must be a technical relationship which finds expression in the claims in terms of the same or corresponding special technical features. The expression "special technical features" means, in any one claim, the particular technical feature or features that define a

contribution that the claimed invention considered as a whole makes over the prior art. Once the special technical features of each invention have been identified, one must determine whether or not there is a technical relationship between the inventions and, furthermore, whether or not this relationship involves these special technical features. It is not necessary that the special technical features in each invention be the same. Rule 44(1) makes clear that the required relationship may be found between corresponding technical features. An example of this correspondence is the following: in one claim the special technical feature which provides resilience is a metal spring, whereas in another claim it is a block of rubber.

A plurality of independent claims in different categories may constitute a group of inventions so linked as to form a single general inventive concept. In particular, Rule 44(1) should be construed as permitting the inclusion of any one of the following combinations of claims of different categories in the same application:

(i) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product; or

(ii) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process; or

(iii) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for an apparatus or means specifically designed for carrying out the said process.

However, while a single set of independent claims according to any one of the combinations (i), (ii) or (iii) above is always permissible, a plurality of such sets of independent claims in one European patent application can only be allowed if the specific circumstances defined in Rule 43(2)(a)-(c) apply and the requirements of Art. 82 and Art. 84 are met. The proliferation of independent claims arising out of a combined effect of this kind may therefore be allowed only exceptionally.

Moreover, it is essential that a single general inventive concept links the claims in the various categories. The presence in each claim of expressions such as "specially adapted" or "specifically designed" does not necessarily imply that a single general inventive concept is present.

In combination (i) above, the process is specially adapted for the manufacture of the product if the claimed process results in the claimed product, i.e. if the process is actually suited to making the claimed product accessible and thereby defines a technical relationship as

defined in Rule 44(1) between the claimed product and the claimed process (see W 11/99, OJ 4/2000, 186). A manufacturing process and its product may not be regarded as lacking unity simply by virtue of the fact that the manufacturing process is not restricted to the manufacture of the claimed product.

In combination (ii) above, the apparatus or means is specifically designed for carrying out the process if the apparatus or means is suitable for carrying out the process and thereby defines a technical relationship as defined in Rule 44(1) between the claimed apparatus or means and the claimed process. It is not sufficient for unity that the apparatus or means is merely capable of being used in carrying out the process. On the other hand, it is of no importance whether or not the apparatus or means could also be used for carrying out another process or the process could also be carried out using an alternative apparatus or means.

7.3 Intermediate and final products

Unity of invention should be considered to be present in the context of intermediate and final products where:

(i) the intermediate and final products have the same essential structural element, i.e. their basic chemical structures are the same or their chemical structures are technically closely inter-related, the intermediate incorporating an **essential** structural element into the final product, and

(ii) the intermediate and final products are technically inter-related, i.e. the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same **essential** structural element.

Unity of invention may also be present between intermediate and final products of which the structures are not known – for example, as between an intermediate having a known structure and a final product with unknown structure or as between an intermediate of unknown structure and a final product of unknown structure. In such cases, there should be sufficient evidence to lead one to conclude that the intermediate and final products are technically closely inter-related as, for example, when the intermediate contains the same essential element as the final product or incorporates an essential element into the final product.

Different intermediate products used in different processes for the preparation of the final product may be claimed provided that they have the same essential structural element. The intermediate and final products should not be separated, in the process leading from one to the other, by an intermediate which is not new. Where different intermediates for different structural parts of the final product are claimed, unity should not be regarded as being present between the

intermediates. If the intermediate and final products are families of compounds, each intermediate compound should correspond to a compound claimed in the family of the final products. However, some of the final products may have no corresponding compound in the family of the intermediate products, so the two families need not be absolutely congruent.

The mere fact that, besides the ability to be used to produce final products, the intermediates also exhibit other possible effects or activities should not prejudice unity of invention.

7.4 Alternatives

Alternative forms of an invention may be claimed either in a plurality of independent claims, as indicated in III, 7.1, or in a single claim (but see III, 3.7). In the latter case the presence of the two alternatives as independent forms may not be immediately apparent. In either case, however, the same criteria should be applied in deciding whether or not there is unity of invention, and lack of unity of invention may then also exist within a single claim. *Rule 44(2)*

7.4.1 Markush grouping

Where a single claim defines (chemical or non-chemical) alternatives, i.e. a so-called "Markush grouping", unity of invention should be considered to be present if the alternatives are of a similar nature (see III, 3.7).

When the Markush grouping is for alternatives of chemical compounds, they should be regarded as being of a similar nature where:

(i) all alternatives have a common property or activity, and

(ii) a common structure is present, i.e. a significant structural element is shared by all of the alternatives, or all alternatives belong to a recognised class of chemical compounds in the art to which the invention pertains.

A "significant structural element is shared by all of the alternatives" where the compounds share a common chemical structure which occupies a large portion of their structures, or, in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art. The structural element may be a single component or a combination of individual components linked together. The alternatives belong to a "recognised class of chemical compounds" if there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention, i.e. that each member could be substituted one for the other, with the expectation that the same intended result would be achieved. If it can be shown that at least one Markush alternative is not novel, unity of invention should be reconsidered.

7.5 Individual features in a claim

Objection of lack of unity does not arise because of one claim containing a number of individual features, where these features do not present a technical inter-relationship (i.e. a combination), but merely a juxtaposition (see IV, 11.7).

7.6 Lack of unity "a priori" or "a posteriori"

Lack of unity may be directly evident a priori, i.e. before considering the claims in relation to the prior art, or may only become apparent a posteriori, i.e. after taking the prior art into consideration - e.g. a document within the state of the art as defined in Art. 54(2) shows that there is lack of novelty or inventive step in an independent claim, thus leaving two or more dependent claims without a common inventive concept (see III, 7.8).

7.7 Examiner's approach

Although lack of unity may arise a posteriori as well as a priori, it should be remembered that lack of unity is not a ground of revocation in later proceedings. Therefore, although the objection should certainly be made and amendment insisted upon in clear cases, it should neither be raised nor persisted in on the basis of a narrow, literal or academic approach. This is particularly so where the possible lack of unity does not necessitate a further search. There should be a broad, practical consideration of the degree of interdependence of the alternatives presented, in relation to the state of the art as revealed by the search report. If the common matter of the independent claims is well-known, and the remaining subject-matter of each claim differs from that of the others without there being any unifying novel concept common to all, then clearly there is lack of unity. If, on the other hand, there is a common concept or principle which is novel and inventive, then objection of lack of unity does not arise. For determining what is allowable between these two extremes, rigid rules cannot be given and each case should be considered on its merits, the benefit of any doubt being given to the applicant. For the particular case of claims for a known substance for a number of distinct medical uses, see IV, 4.8.

7.8 Dependent claims

No objection on account of lack of unity a priori is justified in respect of a dependent claim and the claim on which it depends, on the ground that the general concept they have in common is the subject-matter of the independent claim, which is also contained in the dependent claim. For example, suppose claim 1 claims a turbine rotor blade shaped in a specified manner, while claim 2 is for a "turbine rotor blade as claimed in claim 1 and produced from alloy Z". The common general concept linking the dependent with the independent claim is "turbine rotor blade shaped in a specified manner".

If, however, the independent claim appears not to be patentable, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered (see III, 7.6, non-unity "a posteriori"). It may be that the "special

technical features" of one claim dependent on this non-patentable independent claim are not present in the same or corresponding form in another claim dependent on that claim (see also VI, 3.6).

7.9 Lack of unity during search

Rule 64(1) and (2)

In many and probably most instances, lack of unity will have been noted and reported upon by the Search Division which will have drawn up a partial search report based on those parts of the application relating to the invention, or unified linked group of inventions, first mentioned in the claims. The Search Division may neither refuse the application for lack of unity nor require limitation of the claims, but must inform the applicant that, if the search report is to be drawn up to cover those inventions present other than the first mentioned, then further search fees must be paid within two months.

7.10 Lack of unity during substantive examination

The final responsibility for establishing whether the application meets the requirement of unity of invention ultimately rests with the Examining Division (see T 631/97, OJ 1/2001, 13; see also VI, 3.4). For Euro-PCT applications which have entered the European phase, see III, 7.11.

Insofar as it finds that unity of invention is given, if the applicant has paid the further search fee(s) and requested a full or partial refund thereof, the Examining Division will order refund of the relevant further search fee(s).

If the applicant has not availed himself of the opportunity to have the search results on the other inventions included in the search report, he will be taken to have elected that the application should proceed on the basis of the invention which has been searched (see G 2/92, OJ 10/1993, 591). When considering the issue of unity, the Examining Division will consider both the reasons given in the search opinion and the applicant's response thereto (see B-XII, 9 for details of when a response to the search opinion is required). In the absence of any convincing response from the applicant to the issue of unity as raised in the search opinion, the Examining Division will normally initially uphold the position taken in the search opinion (see B-XII, 1.2) and will then require deletion of all the inventions other than that which has been searched. If the Examining Division is convinced, e.g. by arguments from the applicant, that the opinion on unity at the search stage was incorrect, then an additional search is performed for that part of the subject-matter which is judged to be unitary with an invention which was searched (see B-II, 4.2(iii)) and the examination is carried out on those claims which comply with the requirement of unity of invention.

If the applicant has taken the opportunity to have other inventions searched, then he may determine that the application is to proceed on the basis of any of these, the other(s) being deleted. If the applicant has not yet done so, the examiner should at the beginning of

substantive examination, if he maintains the objection of lack of unity, invite the applicant to state on which invention the prosecution of the application should be based and to limit the application accordingly by excising those parts belonging to the other inventions. For the latter inventions, the applicant may file divisional applications (see VI, 9.1, and A-IV, 1), provided that, when a divisional application is filed, the application being divided is still pending (see A-IV, 1.1.1.1) and at least one of the periods provided for under Rule 36(1)(a) and (b) has not yet expired (see A-IV, 1.1.1.2 and 1.1.1.3).

Rule 48(1)(c)
Rule 36(1)

Whether or not the question of unity of invention has been raised by the Search Division, it must always be considered by the Examining Division. Whenever unity is found to be lacking, the applicant should be required to limit his claims in such a way as to overcome the objection. Excision or amendment of parts of the description may also be necessary (see II, 7.4). One or more divisional applications, covering matter removed to meet this objection, may be filed (see VI, 9.1), subject to the conditions mentioned above.

7.10.1 Amended claims

Rule 137(5)

For the situation where the applicant submits new claims directed to subject-matter which has not been searched e.g. because it was only contained in the description and at the search stage it was not found to be appropriate to extend the search to this subject-matter, see VI, 5.2(ii), and B-III, 3.5.

7.11 Euro-PCT applications

7.11.1 International applications without supplementary search

Art. 153(7)

As indicated in B-II, 4.3, for certain international applications entering the European phase with an international search report, no supplementary European search is carried out. The following situations may then be distinguished during substantive examination:

(i) if, during the international search, an objection of lack of unity has been raised and the applicant has not taken the opportunity to have the other invention(s) searched by paying additional search fees for them, but has taken the opportunity to amend the claims after receipt of the international search report (see VI, 3.5.1) so that they are limited to the invention searched and has indicated that examination is to be carried out on these amended claims, the examiner proceeds on the basis of these claims.

Rule 164(2)

(ii) if, during the international search, an objection of lack of unity has been raised and the applicant has **neither** taken the opportunity to have the other invention(s) searched by paying additional search fees for them, **nor** amended the claims so that they are limited to the invention searched, **and** the examiner agrees with the objection of the ISA (taking into account any comments on the issue of unity submitted by the applicant in his

response to the WO-ISA or IPER - see VI, 3.5.1), he will then proceed to issue a communication under Rule 71(1) and (2), dealing exclusively with the subject-matter of the one and only invention which has been searched.

(iii) if the applicant has paid additional search fees during the international phase, he may determine that the application is to proceed on the basis of any of the searched inventions, the other(s) being deleted, if the examiner agrees with the objection of the ISA. Where the applicant has not yet taken that decision, the examiner will, at the beginning of substantive examination, invite him to do so.

(iv) if the claims to be examined relate to an invention which differs from any of the originally claimed inventions and which does not combine with these inventions to form a single inventive concept, an objection under Rule 137(5) should be raised in the first communication pursuant to Art. 94(3) and Rule 71(1) and (2) (see also VI, 5.2(ii)). *Rule 137(5)*

(v) if the applicant has not paid additional search fees during the international phase and the examiner does not agree with the objection of the ISA (for example, because the applicant has convincingly argued in response to the WO-ISA or IPER, see VI, 3.5.1, that the requirement of unity of invention is satisfied), an additional search will be performed (see B-II, 4.2(iii)) and the examination will be carried out on all claims.

In cases (i) to (iv), the applicant may file divisional applications for the inventions deleted to meet the objection of non-unity (see VI, 9, and A-IV, 1), provided that, when a divisional application is filed, the application being divided is still pending (see A-IV, 1.1.1.1) and at least one of the periods provided for under Rule 36(1)(a) and (b) has not yet expired (see A-IV, 1.1.1.2 and 1.1.1.3). *Rule 36(1)*

7.11.2 International applications with supplementary search

For international applications entering the European phase with an international search report established by an ISA other than the EPO, a supplementary European search is carried out by the Search Division in the cases listed in B-II, 4.3. If the Search Division, during the supplementary European search, notes a lack of unity, B-VII, 2.4 applies. *Art. 153(7)* *Rule 164(1)*

The procedure before the Examining Division in such cases is described in E-IX, 5.7.

7.11.3 International preliminary examination report (IPER)

For international applications entering the European phase with an international preliminary examination report, the examiner should carefully take into account the position taken in that IPER before deviating from it. This may be necessary where the claims have been

changed, the applicant successfully refutes the objection (either of which may happen in response to the IPER, see VI, 3.5.1) or the interpretation of the rules regarding unity of invention was erroneous; see further III, 7.11.1 and 7.11.2 above.

7.11.4 Restricted IPER

Art. 76
Rule 164(2)

If the EPO has established an IPER on the application and the applicant wishes to obtain protection pertaining to claims which were not the subject of this IPER because they were not searched during the international phase in consequence of an objection of lack of unity, he will have to file one or more divisional applications for the inventions not searched, provided that, when a divisional application is filed, the application being divided is still pending (see A-IV, 1.1.1.1) and at least one of the periods provided for under Rule 36(1)(a) and (b) has not yet expired (see A-IV, 1.1.1.2 and A-IV, 1.1.1.3).

8. Different texts of the patent application in respect of different Contracting States (see also D-VII, 4)

8.1 Different text in respect of the state of the art according to Art. 54(3)

If the EPO notes that in respect of one or more of the designated Contracting States the content of an earlier European patent application forms part of the state of the art pursuant to Art. 54(3), two situations could arise:

(i) the filing date of the application or patent under examination is before the date of entry into force of the EPC 2000. Art. 54(4) EPC 1973 is still transitionally applicable (see Art. 1, Decision of the Administrative Council of 28 June 2001, OJ EPO 2003 Special edition No. 1, 202). Here, if conflicting prior art gives rise to different texts of the claims, different sets of claims for the Contracting States concerned may be filed. Different descriptions and drawings will only be required if it is not possible to set out clearly in a common description which subject-matter is to be protected in the different Contracting States, having regard to the appropriate prior art (see also II, 4.3, IV, 7.3 and VI, 5.5).

(ii) the filing date of the application or patent under examination is on or after the date of entry into force of the EPC 2000. As Art. 54(4) EPC 1973 has been deleted, the conflicting prior art belongs to the state of the art for all Contracting States, irrespective of the effected designations. Likewise, it is irrelevant if the designation fee(s) for the earlier European patent application has/have been paid, since there is no provision in the EPC 2000 corresponding to Rule 23a EPC 1973. Consequently, the possibility of having different texts for different Contracting States on the basis of Art. 54(3) no longer exists.

8.2 Different text where a partial transfer of right has taken place pursuant to Art. 61

If by a final decision pursuant to Art. 61 it is adjudged that a third party is entitled to the grant of a European patent in respect of only part of the matter disclosed in the European patent application, the original European patent application must contain, "where appropriate", for the designated Contracting States in which the decision was taken or recognised, claims, a description and drawings which are different from those for the other designated Contracting States (see also VI, 5.5 and 9.2).

Art. 61(1)(b)
Rule 17
Rule 18(1) and (2)

8.3 Different text where a reservation has been entered in accordance with Art. 167(2)(a) EPC 1973

Where a Contracting State has entered reservations in accordance with Art. 167(2)(a) EPC 1973, patent applications and patents seeking protection for chemical, pharmaceutical or food products as such may include different sets of claims for that State and for the other designated States respectively. Such reservations were made by Austria, Greece and Spain. Without prejudice to Art. 167(5) EPC 1973, the reservation for Austria ceased to have effect after 7 October 1987, those for Greece and Spain after 7 October 1992 (for Spain, see Notice from the EPO dated 18 June 2007, OJ 7/2007, 439).

Art. 167(2)(a) EPC 1973

Normally, a common description should be sufficient for all sets of claims.

8.4 Different text where national rights of earlier date exist

National rights of earlier date are not comprised in the state of the art (Art. 54) for the purposes of the EPO examination for patentability. Consequently, a specific search for national rights of earlier date is not made, although any documents found are mentioned in the search report (see B-VI, 4.2). However, under Art. 139(2), national rights of earlier date can be invoked, after the grant of the European patent, in national proceedings as a ground for revocation. These rights represent exceptions to the uniformity of European substantive patent law. Where national rights exist, therefore, the applicant has a legitimate interest in submitting separate claims to ensure that the patent granted will not be partly revoked in some Contracting States. The filing of separate claims should, however, neither be required nor suggested.

Art. 139(2)

If an applicant produces evidence in examination proceedings of the existence of pertinent national rights of earlier date in a particular designated State, it is appropriate to allow the submission of separate claims for the Contracting State in question (see VI, 4.9 and 4.10). The evidence must be in the form of a printed specification or, where applicable, a copy of the utility model or utility certificate or of the application for it (cf. Art. 140); this is necessary to prevent unjustified deviation from the unity of the European patent.

The effect of the national right of earlier date is determined by the relevant national provisions. The examiner does not have to decide whether the applicant has, by means of separate claims, limited the scope of his application to the extent required. That is the responsibility of the applicant.

The examiner must check that the separate claims do not contravene Art. 123(2) and that they meet the other requirements of the EPC.

In contrast to European rights of earlier date, national rights of earlier date are not comprised in the state of the art, so there is no justification for a separate description. However, at a suitable point in the preamble to the description, preferably in a separate paragraph following the information pursuant to Rule 42(1)(a), a reference to this situation must be made, for example along the following lines:

"With reference to ... (e.g. earlier application No. ... in ...), the applicant has voluntarily limited the scope of the present application, and submitted separate claims for ... (Contracting State)."

8.5 Calculation of claims fees

The claims fees are calculated in accordance with VI, 14.1.

Chapter IV

Patentability

1. General

1.1 Basic requirements

There are four basic requirements for patentability:

(i) there must be an "invention", belonging to any field of technology; *Art. 52(1)*

(ii) the invention must be "susceptible of industrial application";

(iii) the invention must be "new"; and

(iv) the invention must involve an "inventive step".

These requirements will be dealt with in turn in IV, 2, 3 and 4, IV, 5, IV, 6 to 10 and IV, 11, respectively.

1.2 Further requirements

In addition to these four basic requirements, the examiner should be aware of the following two requirements that are implicitly contained in the EPC:

(i) the invention must be such that it can be carried out by a person skilled in the art (after proper instruction by the application); this follows from Art. 83. Instances where the invention fails to satisfy this requirement are given in II, 4.11; and *Art. 83*

(ii) the invention must be of "technical character" to the extent that it must relate to a technical field (Rule 42(1)(a)), must be concerned with a technical problem (Rule 42(1)(c)), and must have technical features in terms of which the matter for which protection is sought can be defined in the claim (Rule 43(1)) (see III, 2.1). *Rule 42(1)(a) and (c)* *Rule 43(1)*

1.3 Technical progress, advantageous effects

The EPC does not require explicitly or implicitly that an invention, to be patentable, must entail some technical progress or even any useful effect. Nevertheless, advantageous effects, if any, with respect to the state of the art should be stated in the description (Rule 42(1)(c)), and any such effects are often important in determining "inventive step" (see IV, 11).

2. Inventions

2.1 Exclusions

Art. 52(2)

The EPC does **not** define what is meant by "invention", but Art. 52(2) contains a non-exhaustive list of things which are not regarded as inventions. It will be noted that the items on this list are all either abstract (e.g. discoveries, scientific theories, etc.) and/or non-technical (e.g. aesthetic creations or presentations of information). In contrast to this, an "invention" within the meaning of Art. 52(1) must be of both a concrete and a technical character (see IV, 1.2(ii)). It may be in any field of technology.

2.2 Examination practice

Art. 52(3)

In considering whether the subject-matter of an application is an invention within the meaning of Art. 52(1), there are two general points the examiner must bear in mind. Firstly, any exclusion from patentability under Art. 52(2) applies only to the extent to which the application relates to the excluded subject-matter **as such.** Secondly, the examiner should disregard the form or kind of claim and concentrate on its content in order to identify whether the claimed subject-matter, considered as a whole, has a technical character. If it does not, there is no invention within the meaning of Art. 52(1).

It must also be borne in mind that the basic test of whether there is an invention within the meaning of Art. 52(1) is separate and distinct from the questions whether the subject-matter is susceptible of industrial application, is new and involves an inventive step.

Where it is found that the claims relate in part to excluded subject-matter, this may have led to the issuing of a partial European or supplementary European search report under Rule 63 (see B-VIII, 1, 3.1 and 3.2). In such cases, in the absence of appropriate amendment and/or convincing arguments provided by the applicant in his response to the invitation under Rule 63(1) (see B-VIII, 4.2) or to the search opinion under Rule 70a (see B-XII, 9), an objection under Rule 63(3) will also arise (see VI, 5.6).

2.3 List of exclusions

The items on the list in Art. 52(2) will now be dealt with in turn, and further examples will be given in order better to clarify the distinction between what is patentable and what is not.

2.3.1 Discoveries

If a new property of a known material or article is found out, that is mere discovery and unpatentable because discovery as such has no technical effect and is therefore not an invention within the meaning of Art. 52(1). If, however, that property is put to practical use, then this constitutes an invention which may be patentable. For example, the discovery that a particular known material is able to withstand mechanical shock would not be patentable, but a railway sleeper made from that material could well be patentable. To find a previously

unrecognised substance occurring in nature is also mere discovery and therefore unpatentable. However, if a substance found in nature can be shown to produce a technical effect, it may be patentable. An example of such a case is that of a substance occurring in nature which is found to have an antibiotic effect. In addition, if a microorganism is discovered to exist in nature and to produce an antibiotic, the microorganism itself may also be patentable as one aspect of the invention. Similarly, a gene which is discovered to exist in nature may be patentable if a technical effect is revealed, e.g. its use in making a certain polypeptide or in gene therapy.

For further specific issues concerning biotechnological inventions see IV, 3, 4.5 to 4.8 and 5.4.

2.3.2 Scientific theories

These are a more generalised form of discoveries, and the same principle as set out in IV, 2.3.1 applies. For example, the physical theory of semiconductivity would not be patentable. However, new semiconductor devices and processes for manufacturing these may be patentable.

2.3.3 Mathematical methods

These are a particular example of the principle that purely abstract or intellectual methods are not patentable. For example, a shortcut method of division would not be patentable but a calculating machine constructed to operate accordingly may well be patentable. A mathematical method for designing electrical filters is not patentable; nevertheless filters designed according to this method would not be excluded from patentability by Art. 52(2) and (3).

2.3.4 Aesthetic creations

An aesthetic creation relates by definition to an article (e.g. a painting or sculpture) having aspects which are other than technical and the appreciation of which is essentially subjective. If, however, the article happens also to have technical features, it might be patentable, a tyre tread being an example of this. The aesthetic effect itself is not patentable, neither in a product nor in a process claim. For example, a book claimed solely in terms of the aesthetic or artistic effect of its information content, of its layout or of its letterfont, would not be patentable, and neither would a painting defined by the aesthetic effect of its subject or by the arrangement of colours, or by the artistic (e.g. Impressionist) style. Nevertheless, if an aesthetic effect is obtained by a technical structure or other technical means, although the aesthetic effect itself is not patentable, the means of obtaining it may be. For example, a fabric may be provided with an attractive appearance by means of a layered structure not previously used for this purpose, in which case a fabric incorporating such structure might be patentable. Similarly, a book defined by a technical feature of the binding or pasting of the back may be patentable, even though it has an aesthetic effect too, similarly also a painting defined by the kind of cloth, or by the dyes or binders used. Also a process of producing an

aesthetic creation may comprise a technical innovation and thus be patentable. For example, a diamond may have a particularly beautiful shape (not of itself patentable) produced by a new technical process. In this case, the process may be patentable. Similarly, a new printing technique for a book resulting in a particular layout with aesthetic effect may well be patentable, together with the book as a product of that process. Again, a substance or composition defined by technical features serving to produce a special effect with regard to scent or flavour, e.g. to maintain a scent or flavour for a prolonged period or to accentuate it, may well be patentable.

2.3.5 Schemes, rules and methods for performing mental acts, playing games or doing business

These are further examples of items of an abstract or intellectual character. In particular, a scheme for learning a language, a method of solving crossword puzzles, a game (as an abstract entity defined by its rules) or a scheme for organising a commercial operation would not be patentable. A method of doing business is excluded from patentability even where it implies the possibility of making use of unspecified technical means or has practical utility (T 388/04, OJ 1/2007, 16). However, if the claimed subject-matter specifies an apparatus or technical process for carrying out at least some part of the scheme, that scheme and the apparatus or process have to be examined as a whole. In particular, if the claim specifies computers, computer networks or other conventional programmable apparatus, or a program therefor, for carrying out at least some steps of a scheme, it is to be examined as a "computer-implemented invention" (see below).

2.3.6 Programs for computers

Programs for computers are a form of "computer-implemented invention", an expression intended to cover claims which involve computers, computer networks or other programmable apparatus whereby prima facie one or more of the features of the claimed invention are realised by means of a program or programs. Such claims may e.g. take the form of a method of operating said apparatus, the apparatus set up to execute the method, or, following T 1173/97 (OJ 10/1999, 609), the program itself. Insofar as the scheme for examination is concerned, no distinctions are made on the basis of the overall purpose of the invention, i.e. whether it is intended to fill a business niche, to provide some new entertainment, etc.

The basic patentability considerations in respect of claims for computer programs are in principle the same as for other subject-matter. While "programs for computers" are included among the items listed in Art. 52(2), if the claimed subject-matter has a technical character it is not excluded from patentability by the provisions of Art. 52(2) and (3). Moreover, a data-processing operation controlled by a computer program can equally, in theory, be implemented by means of special circuits, and the execution of a program always involves physical effects, e.g. electrical currents. According to T 1173/97, such normal physical effects are not in themselves sufficient to lend a computer

program technical character. However, if a computer program is capable of bringing about, when running on a computer, a further technical effect going beyond these normal physical effects, it is not excluded from patentability. This further technical effect may be known in the prior art. A further technical effect which lends technical character to a computer program may be found e.g. in the control of an industrial process or in processing data which represent physical entities or in the internal functioning of the computer itself or its interfaces under the influence of the program and could, for example, affect the efficiency or security of a process, the management of computer resources required or the rate of data transfer in a communication link. As a consequence, a computer program may be considered as an invention within the meaning of Art. 52(1) if the program has the potential to bring about, when running on a computer, a further technical effect which goes beyond the normal physical interactions between the program and the computer. A patent may be granted on such a claim if all the requirements of the EPC are met; see in particular Art. 84, 83, 54 and 56, and IV, 5.3 below. Such claims should not contain program listings (see II, 4.15), but should define all the features which assure patentability of the process which the program is intended to carry out when it is run (see III, 4.5, last sentence).

Moreover, following T 769/92 (OJ 8/1995, 525), the requirement for technical character may be satisfied if technical considerations are required to carry out the invention. Such technical considerations must be reflected in the claimed subject-matter.

Any claimed subject-matter defining or using technical means is an invention within the meaning of Art. 52(1) (T 258/03, OJ 12/2004, 575). If claimed subject-matter does not have a prima facie technical character, it should be rejected under Art. 52(2) and (3). If the subject-matter passes this prima facie test for technicality, the examiner should then proceed to the questions of novelty and inventive step. In assessing whether there is an inventive step, the examiner must establish an objective technical problem which has been overcome (see IV, 11.5.2). The solution of that problem constitutes the invention's technical contribution to the art. The presence of such a technical contribution establishes that the claimed subject-matter has a technical character and therefore is indeed an invention within the meaning of Art. 52(1). If no such objective technical problem is found, the claimed subject-matter does not satisfy at least the requirement for an inventive step because there can be no technical contribution to the art, and the claim is to be rejected on this ground.

2.3.7 Presentations of information

A representation of information defined solely by the content of the information is not patentable. This applies whether the claim is directed to the presentation of the information per se (e.g. by acoustical signals, spoken words, visual displays, books defined by their subject,

gramophone records defined by the musical piece recorded, traffic signs defined by the warning thereon) or to processes and apparatus for presenting information (e.g. indicators or recorders defined solely by the information indicated or recorded). If, however, the presentation of information has new technical features, there could be patentable subject-matter in the information carrier or in the process or apparatus for presenting the information. The arrangement or manner of representation, as distinct from the information content, may well constitute a patentable technical feature. Examples in which such a technical feature may be present are: a telegraph apparatus or communication system using a particular code to represent the characters (e.g. pulse code modulation); a measuring instrument designed to produce a particular form of graph for representing the measured information; a gramophone record having a particular groove form to allow stereo recordings; a computer data structure (see T 1194/97, OJ 12/2000, 525) defined in terms which inherently comprise the technical features of the program which operates on said data structure (assuming the program itself, in the particular case, to be patentable); and a diapositive with a soundtrack arranged at the side of it.

3. Biotechnological inventions

3.1 General remarks and definitions

Rule 26(2) and (3)

"Biotechnological inventions" are inventions which concern a product consisting of or containing biological material or a process by means of which biological material is produced, processed or used. "Biological material" means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system.

3.2 Patentable biotechnological inventions

Rule 27
Rule 26(1)

In principle, biotechnological inventions are patentable under the EPC. For European patent applications and patents concerning biotechnological inventions, the relevant provisions of the EPC are to be applied and interpreted in accordance with the provisions of Rules 26 to 29. European Union Directive 98/44/EC of 6 July 1998 on the legal protection of biotechnological inventions (OJ 2/1999, 101) is to be used as a supplementary means of interpretation. In particular the recitals (abbreviated as rec.) preceding the provisions of the Directive are also to be taken into account.

Biotechnological inventions are also patentable if they concern an item on the following non-exhaustive list:

Rule 27(a)

(i) biological material which is **isolated** from its natural environment or produced by means of a technical process even if it previously occurred in nature.

Hence, biological material may be considered patentable even if it already occurs in nature (see also IV, 2.3.1).

Although the human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions (see IV, 4.5), an element isolated from the human body or otherwise produced by means of a technical process, which is susceptible of industrial application, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element. Such an element is not a priori excluded from patentability since it is, for example, the result of technical processes used to identify, purify and classify it and to produce it outside the human body, techniques which human beings alone are capable of putting into practice and which nature is incapable of accomplishing itself (EU Dir. 98/44/EC, rec. 21). *Rule 29(1) and (2)*

The examination of a patent application or a patent for gene sequences or partial sequences should be subject to the same criteria of patentability as in all other areas of technology (EU Dir. 98/44/EC, rec. 22). The industrial application of a sequence or partial sequence must be disclosed in the patent application as filed (see IV, 5.4); *Rule 29(3)*

(ii) plants or animals if the technical feasibility of the invention is not confined to a particular plant or animal variety; *Rule 27(b)*

Inventions which concern plants or animals are patentable provided that the application of the invention is not technically confined to a single plant or animal variety (EU Dir. 98/44/EC, rec. 29).

A claim wherein specific plant varieties are not individually claimed is not excluded from patentability under Art. 53(b) even though it may embrace plant varieties (see G 1/98, OJ 3/2000, 111, and IV, 4.6).

The subject-matter of a claim covering but not identifying plant varieties is not a claim to a variety or varieties (see G 1/98, OJ 3/2000, 111, reasons 3.8). In the absence of the identification of a specific plant variety in a product claim, the subject-matter of the claimed invention is neither limited nor directed to a variety or varieties within the meaning of Art. 53(b) (G 1/98, OJ 3/2000, 111, reasons 3.1 and 3.10); or

(iii) a microbiological or other technical process, or a product obtained by means of such a process other than a plant or animal variety. *Rule 27(c)*

"Microbiological process" means any process involving or performed upon or resulting in microbiological material. *Rule 26(6)*

4. Exceptions to patentability

4.1 Matter contrary to "ordre public" or morality

Art. 53(a)

Any invention the commercial exploitation of which would be contrary to "ordre public" or morality is specifically excluded from patentability. The purpose of this is to deny protection to inventions likely to induce riot or public disorder, or to lead to criminal or other generally offensive behaviour (see also II, 7.2). Anti-personnel mines are an obvious example. This provision is likely to be invoked only in rare and extreme cases. A fair test to apply is to consider whether it is probable that the public in general would regard the invention as so abhorrent that the grant of patent rights would be inconceivable. If it is clear that this is the case, objection should be raised under Art. 53(a); otherwise not. The mere possibility of abuse of an invention is not sufficient to deny patent protection pursuant to Art. 53(a) EPC if the invention can also be exploited in a way which does not and would not infringe "ordre public" and morality (T 866/01). If difficult legal questions arise in this context, then refer to VI, 7.8.

Where it is found that the claims relate in part to such excluded subject-matter, this may have led to the issuing of a partial European or supplementary European search report under Rule 63 (see B-VIII, 1, 3.1 and 3.2). In such cases, in the absence of appropriate amendment and/or convincing arguments provided by the applicant in his response to the invitation under Rule 63(1) (see B-VIII, 4.2) or to the search opinion under Rule 70a (see B-XII, 9), an objection under Rule 63(3) will also arise (see VI, 5.6).

4.2 Prohibited matter

Art. 53(a)

Exploitation is not to be deemed to be contrary to "ordre public" or morality merely because it is prohibited by law or regulation in some or all of the Contracting States. One reason for this is that a product could still be manufactured under a European patent for export to States in which its use is not prohibited.

4.3 Offensive and non-offensive use

In some cases refusal of a patent application may be unjustified. This may result when the invention has both an offensive and a non-offensive use, e.g. a process for breaking open locked safes, the use by a burglar being offensive but the use by a locksmith in the case of emergency non-offensive. In such a case, no objection arises under Art. 53(a). Similarly, if a claimed invention defines a copying machine with features resulting in an improved precision of reproduction and an embodiment of this apparatus could comprise further features (not claimed but apparent to the skilled person) the only purpose of which would be that it should also allow reproduction of security strips in banknotes strikingly similar to those in genuine banknotes, the claimed apparatus would cover an embodiment for producing counterfeit money which could be considered to fall under Art. 53(a). There is, however, no reason to consider the copying machine as claimed to be excluded from patentability, since its improved properties could be

used for many acceptable purposes (see G 1/98, OJ 3/2000, 111, reasons 3.3.3). However, if the application contains an explicit reference to a use which is contrary to "ordre public" or morality, deletion of this reference should be required under the terms of Rule 48(1)(a).

4.4 Economic effects

The EPO has not been vested with the task of taking into account the economic effects of the grant of patents in specific areas of technology and of restricting the field of patentable subject-matter accordingly (see G 1/98, OJ 3/2000, 111, reasons 3.9, and T 1213/05). The standard to apply for an exception under Art. 53(a) is whether the commercial exploitation of the invention is contrary to "ordre public" or morality.

4.5 Biotechnological inventions

In the area of biotechnological inventions, the following list of exceptions to patentability under Art. 53(a) is laid down in Rule 28. The list is illustrative and non-exhaustive and is to be seen as giving concrete form to the concept of "ordre public" and "morality" in this technical field.

Under Art. 53(a), in conjunction with Rule 28, European patents are not to be granted in respect of biotechnological inventions which concern: *Rule 28*

(i) processes for cloning human beings; *Rule 28(a)*

For the purpose of this exception, a process for the cloning of human beings may be defined as any process, including techniques of embryo splitting, designed to create a human being with the same nuclear genetic information as another living or deceased human being (EU Dir. 98/44/EC, rec. 41).

(ii) processes for modifying the germ line genetic identity of human beings; *Rule 28(b)*

(iii) uses of human embryos for industrial or commercial purposes; *Rule 28(c)*

The exclusion of the uses of human embryos for industrial or commercial purposes does not affect inventions for therapeutic or diagnostic purposes which are applied to the human embryo and are useful to it (EU Dir. 98/44/EC, rec. 42).

(iv) processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes. *Rule 28(d)*

The substantial medical benefit referred to above includes any benefit in terms of research, prevention, diagnosis or therapy (EU Dir. 98/44/EC, rec. 45).

Rule 29(1)

In addition, the human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions (see, however, IV, 3.2). Such stages in the formation or development of the human body include germ cells (EU Dir. 98/44/EC, rec. 16).

Also excluded from patentability under Art. 53(a) are processes to produce chimeras from germ cells or totipotent cells of humans and animals (EU Dir. 98/44/EC, rec. 38).

4.6 Plant and animal varieties, processes for the production of plants or animals

Art. 53(b)

The list of exceptions to patentability under Art. 53(b) also includes "plant or animal varieties or essentially biological processes for the production of plants or animals".

4.6.1 Plant varieties

Rule 26(4)
Rule 27(b)

The term "plant variety" is defined in Rule 26(4). A patent is not to be granted if the claimed subject-matter is directed to a specific plant variety or specific plant varieties. However, if the invention concerns plants and animals and if the technical feasibility of the invention is not confined to a particular plant or animal variety, the invention is patentable (see IV, 3.2).

When a claim to a process for the production of a plant variety is examined, Art. 64(2) is not to be taken into consideration (see G 1/98, OJ 3/2000, 111). Hence, a process claim for the production of a plant variety (or plant varieties) is not a priori excluded from patentability merely because the resulting product constitutes or may constitute a plant variety.

4.6.2 Processes for the production of plants or animals

Rule 26(5)

A process for the production of plants or animals is essentially biological if it consists entirely of natural phenomena such as crossing or selection. To take some examples, a method of crossing, inter-breeding, or selectively breeding, say, horses involving merely selecting for breeding and bringing together those animals having certain characteristics would be essentially biological and therefore unpatentable. On the other hand, a process of treating a plant or animal to improve its properties or yield or to promote or suppress its growth e.g. a method of pruning a tree, would not be essentially biological since although a biological process is involved the essence of the invention is technical; the same could apply to a method of treating a plant characterised by the application of a growth-stimulating substance or radiation. The treatment of soil by technical means to

suppress or promote the growth of plants is also not excluded from patentability (see also IV, 4.8.1).

4.7 Microbiological processes

4.7.1 General remarks

As expressly stated in Art. 53(b), second half-sentence, the exception referred to in the first half-sentence does not apply to microbiological processes or the products thereof. *Art. 53(b)* *Rule 26(6)*

"Microbiological process" means any process involving or performed upon or resulting in microbiological material. Hence, the term "microbiological process" is to be interpreted as covering not only processes performed upon microbiological material or resulting in such, e.g. by genetic engineering, but also processes which as claimed include both microbiological and non-microbiological steps.

The product of a microbiological process may also be patentable per se (product claim). Propagation of the microorganism itself is to be construed as a microbiological process for the purposes of Art. 53(b). Consequently, the microorganism can be protected per se as it is a product obtained by a microbiological process (see IV, 2.3.1). The term "microorganism" includes bacteria and other generally unicellular organisms with dimensions beneath the limits of vision which can be propagated and manipulated in a laboratory (see T 356/93, OJ 8/1995, 545), including plasmids and viruses and unicellular fungi (including yeasts), algae, protozoa and, moreover, human, animal and plant cells. *Rule 27(c)*

On the other hand, product claims for plant or animal varieties cannot be allowed even if the variety is produced by means of a microbiological process (Rule 27(c)). The exception to patentability in Art. 53(b), first half-sentence, applies to plant varieties irrespective of the way in which they are produced. Therefore, plant varieties containing genes introduced into an ancestral plant by recombinant gene technology are excluded from patentability (G 1/98, OJ 3/2000, 111).

4.7.2 Repeatability of results of microbiological processes

In the case of microbiological processes, particular regard should be had to the requirement of repeatability referred to in II, 4.11. As for biological material deposited under the terms of Rule 31, repeatability is assured by the possibility of taking samples (Rule 33(1)), and there is thus no need to indicate another process for the production of the biological material. *Rule 33(1)*

4.8 Surgery, therapy and diagnostic methods

European patents are not to be granted in respect of "methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body; this provision shall not apply to products, in particular substances or *Art. 53(c)*

compositions, for use in any of these methods." Hence, patents may be obtained for surgical, therapeutic or diagnostic instruments or apparatuses for use in such methods. The manufacture of prostheses or artificial limbs could be patentable. For instance, a method of manufacturing insoles in order to correct the posture or a method of manufacturing an artificial limb should be patentable. In both cases, taking the imprint of the footplate or a moulding of the stump on which an artificial limb is fitted is clearly not of a surgical nature and does not require the presence of a medically qualified person. Furthermore, the insoles as well as the artificial limb are manufactured outside the body. However, a method of manufacturing an endoprosthesis outside the body, but requiring a surgical step to be carried out for taking measurements, would be excluded from patentability under Art. 53(c) (see T 1005/98, not published in OJ).

Patents may be obtained for **new** products, particularly substances or compositions, for use in these methods of treatment or diagnosis. According to Art. 54(4), where the substance or composition is known, it may only be patented for use in these methods if the known substance or composition was not previously disclosed for use in surgery, therapy or diagnostic methods practised on the human or animal body ("**first medical use**"). A claim to a known substance or composition for the first use in surgical, therapeutic and/or diagnostic methods should be in a form such as: "Substance or composition X" followed by the indication of the use, for instance "... for use as a medicament", "... as an antibacterial agent " or "... for curing disease Y".

Art. 54(5)

Where a substance or composition is already known to have been used in a "first medical use", it may still be patentable under Art. 54(5) for any second or further use in a method according to Art. 53(c), provided that said use is novel and inventive.

Art. 54(4) and (5) thus provide for an exception from the general principle that product claims can only be obtained for (absolutely) novel products. However, this does not mean that product claims for the first and further medical uses need not fulfil all other requirements of patentability, especially that of inventive step (see T 128/82, OJ 4/1984, 164).

A claim in the form "Use of substance or composition X for the treatment of disease Y..." will be regarded as relating to a method for treatment explicitly excluded from patentability under Art. 53(c) and therefore will not be accepted.

Art. 82

If an application discloses for the first time a number of distinct surgical, therapeutic or diagnostic uses for a known substance or composition, normally in the one application independent claims each directed to the substance or composition for one of the various uses may be allowed; i.e. an a priori objection of lack of unity of invention should not, as a general rule, be raised (see III, 7.6).

A claim in the form "Use of a substance or composition X for the manufacture of a medicament for therapeutic application Z" is allowable for either a first or "subsequent" (second or further) such application ("Swiss-type" claim), if this application is new and inventive (cf. G 5/83, OJ 3/1985, 64). The same applies to claims in the form "Method for manufacturing a medicament intended for therapeutic application Z, characterised in that the substance X is used" or the substantive equivalents thereof (see T 958/94, OJ 6/1997, 241). In cases where an applicant simultaneously discloses more than one "subsequent" therapeutic use, claims of the above type directed to these different uses are allowable in the one application, but only if they form a single general inventive concept (Art. 82). Regarding use or method claims of the above type, it should also be noted that a mere pharmaceutical effect does not necessarily imply a therapeutical application. For instance, the selective occupation of a specific receptor by a given substance cannot be considered in itself as a therapeutic application; indeed, the discovery that a substance selectively binds a receptor, even if representing an important piece of scientific knowledge, still needs to find an application in the form of a **defined**, **real** treatment of a pathological condition in order to make a technical contribution to the art and to be considered as an invention eligible for patent protection (see T 241/95, OJ 2/2001, 103). See also III, 4.22, for the functional definition of a pathological condition.

4.8.1 Limitations of exception under Art. 53(c)

Art. 53(c)

It should be noted that the exceptions under Art. 53(c) are confined to methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body. It follows that other methods of treatment of live human beings or animals (e.g. treatment of a sheep in order to promote growth, to improve the quality of mutton or to increase the yield of wool) or other methods of measuring or recording characteristics of the human or animal body are patentable, provided that (as would probably be the case) such methods are of a technical and not essentially biological character (see IV, 4.6). For example, an application containing claims directed to the purely cosmetic treatment of a human by administration of a chemical product is considered as being patentable (see T 144/83, OJ 9/1986, 301). A cosmetic treatment involving surgery or therapy would, however, not be patentable (see below).

To be excluded from patentability, a treatment or diagnostic method must actually be carried out on the living human or animal body. A treatment of or diagnostic method practised on a dead human or animal body would therefore not be excluded from patentability by virtue of Art. 53(c). Treatment of body tissues or fluids after they have been removed from the human or animal body, or diagnostic methods applied thereon, are not excluded from patentability insofar as these tissues or fluids are not returned to the same body. Thus the treatment of blood for storage in a blood bank or diagnostic testing of blood samples is not excluded, whereas a treatment of blood by dialysis with the blood being returned to the same body would be excluded.

Regarding methods which are carried out on or in relation to the living human or animal body, it should be borne in mind that the intention of Art. 53(c) is only to free from restraint non-commercial and non-industrial medical and veterinary activities. Interpretation of the provision should avoid the exceptions from going beyond their proper limits (see G 5/83, OJ 3/1985, 64 and G 1/04, OJ 5/2006, 334).

However, in contrast to the subject-matter referred to in Art. 52(2) and (3) which is only excluded from patentability if claimed as such, a method claim is not allowable under Art. 53(c) if it includes at least one feature defining a physical activity or action that constitutes a method step for treatment of the human or animal body by surgery or therapy. In that case, whether or not the claim includes or consists of features directed to a technical operation performed on a technical object is legally irrelevant to the application of Art. 53(c) (see T 820/92, OJ 3/1995, 113, and T 82/93, OJ 5/1996, 274).

Taking the three exceptions in turn:

Surgery defines the nature of the treatment rather than its purpose. Thus, for example, a method of treatment by surgery for cosmetic purposes or for embryo transfer is excluded from patentability, as well as surgical treatment for therapeutic purposes.

Therapy implies the curing of a disease or malfunction of the body and covers prophylactic treatment, e.g. immunisation against a certain disease (see T 19/86, OJ 1-2/1989, 24) or the removal of plaque (see T 290/86, OJ 8/1992, 414). A method for therapeutic purposes concerning the functioning of an apparatus associated with a living human or animal body is not excluded from patentability if no functional relationship exists between the steps related to the apparatus and the therapeutic effect of the apparatus on the body (see T 245/87, OJ 5/1989, 171).

Diagnostic methods likewise do not cover all methods related to diagnosis. To determine whether a claim is directed to a diagnostic method within the meaning of Art. 53(c), it must first be established whether all of the necessary phases are included in the claim (G 1/04, OJ 5/2006, 334).

The claim must include method steps relating to **all** of the following phases:

(i) the **examination phase,** involving the collection of data,

(ii) the **comparison** of these data with standard values,

(iii) the **finding of any significant deviation**, i.e. a symptom, during the comparison,

(iv) the attribution of the deviation to a particular clinical picture, i.e. the deductive medical or veterinary **decision phase** (diagnosis for curative purposes stricto sensu).

If features pertaining to any of these phases are missing and are essential for the definition of the invention, those features are to be included in the independent claim. Due account should be taken of steps which may be considered to be implicit: for example, steps relating to the comparison of data with standard values (phase (ii)) may imply the finding of a significant deviation (phase (iii) - see T 1197/02). The deductive medical or veterinary decision phase (iv), i.e. the "diagnosis for curative purposes *stricto sensu*", is the determination of the nature of a medical or veterinary medicinal condition intended to identify or uncover a pathology; the identification of the underlying disease is not required (T 125/02).

It is then necessary to establish which of the method steps have **technical character**. The final phase (iv), for example, is normally a purely intellectual exercise (unless a device capable of reaching the diagnostic conclusions can be used) and therefore not technical in character.

In order to fulfil the "practised on the human or animal body" criterion, **each of the preceding technical method steps relating to phases (i) to (iii) must be performed on a human or animal body**. So, for each technical method step, it must be ascertained whether an interaction with the human or animal body takes place. The type or intensity of the interaction is not decisive: this criterion is fulfilled if the performance of the technical method step in question necessitates the presence of the body. Direct physical contact with the body is not required.

It is noted that a medical or veterinary practitioner does not have to be involved, either by being present or by bearing the overall responsibility, in the procedure.

If all of the above criteria are satisfied, then the claim defines a diagnostic method practised on the human or animal body, and an objection will be raised under Art. 53(c).

Accordingly, methods for merely obtaining information (data, physical quantities) from the living human or animal body (e.g. X-ray investigations, NMR studies, and blood pressure measurements) are not excluded from patentability under Art. 53(c).

5. Industrial application

5.1 General remarks

"An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture". "Industry" should be understood in its broad sense as *Art. 57*

including any physical activity of "technical character" (see IV, 1.2), i.e. an activity which belongs to the useful or practical arts as distinct from the aesthetic arts; it does not necessarily imply the use of a machine or the manufacture of an article and could cover e.g. a process for dispersing fog or for converting energy from one form to another. Thus, Art. 57 excludes from patentability very few "inventions" which are not already excluded by the list in Art. 52(2) (see IV, 2.1). One further class of "invention" which would be excluded, however, would be articles or processes alleged to operate in a manner clearly contrary to well-established physical laws, e.g. a perpetual motion machine. Objection could arise under Art. 57 only insofar as the claim specifies the intended function or purpose of the invention, but if, say, a perpetual motion machine is claimed merely as an article having a particular specified construction then objection should be made under Art. 83 (see II, 4.11).

5.2 Method of testing

Methods of testing generally should be regarded as inventions susceptible of industrial application and therefore patentable if the test is applicable to the improvement or control of a product, apparatus or process which is itself susceptible of industrial application. In particular, the utilisation of test animals for test purposes in industry, e.g. for testing industrial products (for example for ascertaining the absence of pyrogenetic or allergic effects) or phenomena (for example for determining water or air pollution) would be patentable.

5.3 Industrial application vs. exclusion under Art. 52(2)

It should be noted that "susceptibility of industrial application" is not a requirement that overrides the restriction of Art. 52(2), e.g. an administrative method of stock control is not patentable, having regard to Art. 52(2)(c), even though it could be applied to the factory store-room for spare parts. On the other hand, although an invention must be "susceptible of industrial application" and the description must indicate, where this is not apparent, the way in which the invention is thus susceptible (see II, 4.12), the claims need not necessarily be restricted to the industrial application(s).

5.4 Sequences and partial sequences of genes

Rule 42(1)(f)
Rule 29(3)

In general it is required that the description of a European patent application should, where this is not self-evident, indicate the way in which the invention is capable of exploitation in industry. The invention claimed must have such a sound and concrete technical basis that the skilled person can recognise that its contribution to the art could lead to practical exploitation in industry (T 898/05). In relation to sequences and partial sequences of genes, this general requirement is given specific form in that the industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application. A mere nucleic acid sequence without indication of a function is not a patentable invention (EU Dir. 98/44/EC, rec. 23). In cases where a sequence or partial sequence of a gene is used to produce a protein or a part of a protein, it is necessary to specify which protein or part of a

protein is produced and what function this protein or part of a protein performs. Alternatively, when a nucleotide sequence is not used to produce a protein or part of a protein, the function to be indicated could e.g. be that the sequence exhibits a certain transcription promoter activity.

6. State of the art

6.1 General remarks and definition

An invention is "considered to be new if it does not form part of the state of the art". The "state of the art" is defined as "everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application". The width of this definition should be noted. There are no restrictions whatever as to the geographical location where or the language or manner in which the relevant information was made available to the public; also no age limit is stipulated for the documents or other sources of the information. There are, however, certain specific exclusions (see IV, 10). However, since the "state of the art" available to the examiner will mainly consist of the documents listed in the search report, this section 6 deals with the question of public availability only in relation to written description (either alone or in combination with an earlier oral description or use). *Art. 54(1) and (2)*

The principles to be applied in determining whether other kinds of prior art (which could be introduced into the proceedings e.g. by a third party under Art. 115) have been made available to the public are set out in D-V, 3.

For the examination of the novelty of claimed subject-matter, see IV, 9. *Art. 52(1)*

A written description, i.e. a document, should be regarded as made available to the public if, at the relevant date, it was possible for members of the public to gain knowledge of the content of the document and there was no bar of confidentiality restricting the use or dissemination of such knowledge. For instance, German utility models ("Gebrauchsmuster") are already publicly available as of their date of entry in the Register of utility models ("Eintragungstag"), which precedes the date of announcement in the Patent Bulletin ("Bekanntmachung im Patentblatt"). The search report also cites documents in which doubts with regard to the fact of public availability and doubts concerning the precise date of publication of a document have not, or not fully, been removed. If the applicant contests the public availability or assumed date of publication of the document, the examiner should consider whether to investigate the matter further. If the applicant shows sound reasons for doubting whether the document forms part of the "state of the art" in relation to his application and any further investigation does not produce evidence sufficient to remove that doubt, the examiner should not pursue the matter further. The only other problem likely to arise for the examiner is where:

(i) a document reproduces an oral description (e.g. a public lecture) or gives an account of a prior use (e.g. display at a public exhibition); and

(ii) only the oral description or lecture was publicly available before the "date of filing" of the European application, the document itself being published on or after this date.

In such cases, the examiner should start with the assumption that the document gives a true account of the earlier lecture, display or other event and should therefore regard the earlier event as forming part of the "state of the art". If, however, the applicant gives sound reasons for contesting the truth of the account given in the document then again the examiner should not pursue the matter further.

6.2 Internet disclosures

As a matter of principle, disclosures on the internet form part of the state of the art according to Art. 54(2). Information disclosed on the internet or in online databases is considered to be publicly available as of the date the information was publicly posted. Internet websites often contain highly relevant technical information. Certain information may even be available only on the internet from such websites. This includes, for example, online manuals and tutorials for software products (such as video games) or other products with a short life cycle. Hence for the sake of a valid patent it is often crucial to cite publications only obtainable from such internet websites.

6.2.1 Establishing the publication date

Establishing a publication date has two aspects. It must be assessed separately whether a given date is indicated correctly and whether the content in question was indeed made available to the public as of that date.

The nature of the internet can make it difficult to establish the actual date on which information was made available to the public: for instance, not all web pages mention when they were published. Also, websites are easily updated, yet most do not provide any archive of previously displayed material, nor do they display records which enable members of the public - including examiners - to establish precisely what was published and when.

Neither restricting access to a limited circle of people (e.g. by password protection) nor requiring payment for access (analogous to purchasing a book or subscribing to a journal) prevent a web page from forming part of the state of the art. It is sufficient if the web page is in principle available without any bar of confidentiality.

Finally, it is theoretically possible to manipulate the date and content of an internet disclosure (as it is with traditional documents). However, in view of the sheer size and redundancy of the content available on the internet, it is considered very unlikely that an internet disclosure discovered by an examiner has been manipulated. Consequently,

unless there are specific indications to the contrary, the date can be accepted as being correct.

6.2.2 Standard of proof

When an internet document is cited against an application or patent, the same facts are to be established as for any other piece of evidence, including standard paper publications (cf. IV, 6.1). This evaluation is made according to the principle of "free evaluation of evidence" (see T 482/89, OJ 11/1992, 646, and T 750/94, OJ 1-2/1998, 32). That means that each piece of evidence is given an appropriate weight according to its probative value, which is evaluated in view of the particular circumstances of each case. The standard for assessing these circumstances is the balance of probabilities. According to this standard, it is not sufficient that the alleged fact (e.g. the publication date) is merely probable; the examining division must be convinced that it is correct. It does mean, however, that proof beyond reasonable doubt ("up to the hilt") of the alleged fact is not required.

In many cases, internet disclosures contain an explicit publication date which is generally considered reliable. Such dates are accepted at face value, and the burden of proof will be on the applicant to show otherwise. Circumstantial evidence may be required to establish or confirm the publication date (see IV, 6.2.4). If the examiner comes to the conclusion that - on the balance of probabilities - it has been established that a particular document was available to the public at a particular date, this date is used as publication date for the purpose of examination.

6.2.3 Burden of proof

It is a general principle that, when raising objections, the burden of proof lies initially with the examiner. This means that objections must be reasoned and substantiated, and must show that, on the balance of probabilities, the objection is well-founded. If this is done, it is then up to the applicant to prove otherwise - the burden of proof shifts to the applicant.

If an applicant provides reasons for questioning the alleged publication date of an internet disclosure, examiners will have to take these reasons into account. If examiners are no longer convinced that the disclosure forms part of the state of the art, they will either have to present further evidence to maintain the disputed publication date or will not use this disclosure further as prior art against the application.

The later the examiner sets out to obtain such evidence, the more difficult it may become. The examiner should use his judgment to decide whether it is worth spending a short amount of time at the search stage to find further evidence in support of the publication date.

If an applicant refutes the publication date of an internet disclosure with no reasoning or merely with generic statements about the reliability of

internet disclosures, this argument will be given minimal weight and is therefore unlikely to sway the examiner's opinion.

While the dates and content of internet disclosures can be taken at face value, there are of course differing degrees of reliability. The more reliable a disclosure, the harder it will be for the applicant to prove that it is incorrect. The following sections look at the reliability of various popular types of internet disclosure.

6.2.3.1 Technical journals

Of particular importance for examiners are online technical journals from scientific publishers (e.g. IEEE, Springer, Derwent). The reliability of these journals is the same as that of traditional paper journals, i.e. very high.

It should be noted that the internet publication of a particular issue of a journal may be earlier than the date of publication of the corresponding paper version. Furthermore, some journals pre-publish on the internet manuscripts which have been submitted to them, but which have not yet been published, and in some cases before they have even been approved for paper publication (for example, the "Geophysics" journal). If the journal then does not approve the manuscript for publication, this pre-publication of the manuscript may be the only disclosure of its content. Examiners should also remember that the pre-published manuscript may differ from the final, published version. The two documents should be treated as separate disclosures, each with its own publication date.

Where the given publication date of an online journal publication is too vague (e.g. only the month and year is known), and the most pessimistic possibility (the last day of the month) is too late, the examiner may request the exact publication date. Such a request may be made directly through a contact form that the publisher may offer on the internet, or via the EPO library.

6.2.3.2 Other "print equivalent" publications

Many sources other than scientific publishers are generally deemed to provide reliable publication dates. These include for example publishers of newspapers or periodicals, or television or radio stations. Academic institutions (such as academic societies or universities), international organisations (such as the European Space Agency ESA), public organisations (such as ministries or public research agencies) or standardisation bodies also typically fall into this category.

Some universities host so-called eprint archives to which authors submit reports on research results in electronic form before they are submitted or accepted for publication by a conference or journal. In fact, some of these reports are never published anywhere else. The most prominent such archive is known as arXiv.org (www.arxiv.org, hosted by the Cornell University Library), but several others exist, e.g. the Cryptology eprint archive (eprint.iacr.org, hosted by the

International Association for Cryptology Research). Some such archives crawl the internet to automatically retrieve publications which are publicly available from researchers' web pages, such as Citeseer or ChemXseer (citeseer.ist.psu.edu and chemxseer.ist.psu.edu, both hosted by Pennsylvania State University).

Companies, organisations or individuals use the internet to publish documents that had previously been published on paper. These include manuals for software products such as video games, handbooks for products such as mobile phones, product catalogues or price lists and white papers on products or product families. Evidently, most of these documents address the public - e.g. actual or potential customers - and are thus meant for publication. Hence the date given can be taken as a date of publication.

6.2.3.3 Non-traditional publications

The internet is also used to exchange and publish information in ways which did not exist before, via, for example, Usenet discussion groups, blogs, e-mail archives of mailing lists or wiki pages. Documents obtained from such sources also constitute prior art, although it may be more involved to establish their publication date, and their reliability may vary.

Computer-generated timestamps (usually seen, for example, on blogs, Usenet or the version history available from wiki pages) can be considered as reliable publication dates. While such dates could have been generated by an imprecise computer clock, this should be weighed against the fact that in general many internet services rely on accurate timing and will often stop functioning if time and date are incorrect. In the absence of indications to the contrary, the frequently used "last modified" date can be treated as the publication date.

6.2.4 Disclosures which have no date or an unreliable date

Where an internet disclosure is relevant for examination but does not give any explicit indication of the publication date in the text of the disclosure, or if an applicant has shown that a given date is unreliable, the examiner may try to obtain further evidence to establish or confirm the publication date. Specifically, he may consider using the following information:

(a) Information relating to a web page available from an internet archiving service. The most prominent such service is the Internet Archive accessible through the so-called "Wayback Machine" (www.archive.org). The fact that the Internet Archive is incomplete does not detract from the credibility of the data it does archive. It is also noted that legal disclaimers relating to the accuracy of any supplied information are routinely used on websites (even respected sources of information such as *esp@cenet* or IEEE), and these disclaimers should not be taken to reflect negatively on the websites' actual accuracy.

(b) Timestamp information relating to the history of modifications applied to a file or web page (for example, as available for wiki pages such as Wikipedia and in version control systems as used for distributed software development).

(c) Computer-generated timestamp information as available from file directories or other repositories, or as automatically appended to content (e.g. forum messages and blogs).

(d) Indexing dates given to the web page by search engines (e.g. from the Google cache). These will be later than the actual publication date of the disclosure, since the search engines take some time to index a new website.

(e) Information relating to the publication date embedded in the internet disclosure itself. Date information is sometimes hidden in the programming used to create the website but is not visible in the web page as it appears in the browser. Examiners may, for example, consider the use of computer forensic tools to retrieve such dates. In order to allow a fair evaluation of the accuracy of the date by both the applicant and the examiner, these dates should be used only if the examiner knows how they were obtained and can communicate this to the applicant.

(f) Information about replication of the disclosure at several sites (mirror sites) or in several versions.

It may also be possible to make enquiries with the owner or the author of the website when trying to establish the publication date to a sufficient degree of certainty. The probative value of statements so obtained will have to be assessed separately.

If no date can be obtained (other than the date of retrieval by the examiner, which will be too late for the application in question), the disclosure cannot be used as prior art during examination. If the examiner considers that a publication, although undated, is highly relevant to the invention and can therefore be considered to be of interest to the applicant or third parties, he may choose to cite the publication in the search report as an L document. The search report and the written opinion should explain why this document was cited. Citing the disclosure will also make it citable against future applications, using the date of retrieval as the date of publication.

6.2.5 Problematic cases

Web pages are sometimes divided into frames the content of which is drawn from different sources. Each of these frames may have its own publication date which may have to be checked. In an archiving system, for instance, it may happen that one frame contains the archived information with an old publishing date whereas other frames contain commercials generated at the time of retrieval. The examiner

should ensure that he uses the right publication date, i.e. that the cited publication date refers to the intended content.

When a document retrieved from the Internet Archive contains links, there is no guarantee that the links point to documents archived on the same date. It may even happen that the link does not point to an archived page at all but to the current version of the web page. This may in particular be the case for linked images, which are often not archived. It may also happen that archived links do not work at all.

Some internet addresses (URLs) are not persistent, i.e. they are designed to work only during a single session. Long URLs with seemingly random numbers and letters are indicative of these. The presence of such a URL does not prevent the disclosure being used as prior art, but it does mean that the URL will not work for other people (e.g. the applicant when he receives the search report). For non-persistent URLs, or if, for other reasons, it is considered prudent, the examiner should indicate how he arrived at that specific URL from the main home page of the respective website (i.e. which links were followed, or which search terms were used).

6.2.6 Technical details and general remarks

When printing a web page, care should be taken that the complete URL is clearly legible. The same applies to the relevant publication date on a web page.

It should be borne in mind that publication dates may be given in different formats, especially in either the European format dd/mm/yyyy, the US format mm/dd/yyyy or the ISO format yyyy/mm/dd. Unless the format is explicitly indicated, it will be impossible to distinguish between the European format and the US format for days 1-12 of each month.

If a publication date is close to the relevant priority date, the time zone of publication may be crucial to interpret a publication date.

The examiner should always indicate the date on which the web page was retrieved. When citing internet disclosures, he should explain the prior art status of the document, e.g. how and where he obtained the publication date (for example that the eight digits in the URL represent the date of archiving in the format YYYYMMDD), and any other relevant information (for example, where two or more related documents are cited, how they are related - for example that following link 'xyz' on the first document leads to the second document).

6.3 Enabling disclosures

Subject-matter can only be regarded as having been made available to the public, and therefore as comprised in the state of the art pursuant to Art. 54(1), if the information given to the skilled person is sufficient to enable him, at the relevant date (see IV, 9.3), to practise the technical teaching which is the subject of the disclosure, taking into account also the general knowledge at that time in the field to be expected of him

(see T 26/85, OJ 1-2/1990, 22, T 206/83, OJ 1/1987, 5 and T 491/99, not published in OJ).

6.4 Date of filing or priority date as effective date

Art. 89

It should be noted that "date of filing" in Art. 54(2) and 54(3) is to be interpreted as meaning the date of priority in appropriate cases (see Chapter V). It should be remembered that different claims, or different alternatives claimed in one claim, may have different effective dates, i.e. the date of filing or (one of) the claimed priority date(s). The question of novelty must be considered against each claim (or part of a claim where a claim specifies a number of alternatives) and the state of the art in relation to one claim or one part of a claim may include matter, e.g. an intermediate document (see B-X, 9.2(iv)), which cannot be cited against another claim or another alternative in the same claim because it has an earlier effective date.

Of course, if all the matter in the state of the art was made available to the public before the date of the earliest priority document, the examiner need not (and should not) concern himself with the allocation of effective dates.

Rule 56

If the applicant files missing parts of the description, or drawings (see A-II, 5.1), late under Rule 56, the accorded date of the application is the date of filing of these missing elements under Rule 56(2) (see A-II, 5.3), unless they are completely contained in the priority document and the requirements given in Rule 56(3) are satisfied (see A-II, 5.4), in which case the original filing date is maintained. The date of the application as a whole is thus either the date of filing of the missing elements or the original filing date.

Rule 58

Claims filed in response to a communication under Rule 58 (see A-III, 15) do not result in a change in the filing date of the application (see A-III, 15), as they are considered as amendments to the application as filed (see VI, 5.3.1).

6.5 Documents in a non-official language

The search report will include a document in a non-official language only if there is strong evidence (e.g.-coming from drawings, an abstract, a corresponding patent in an official language, or a translation produced by the examiner or by a person familiar with the language of the document) that the document is relevant (see B-X, 9.1.2 and 9.1.3). The examiner, in the search opinion or in the communication under Art. 94(3), may cite the document on the basis of the same evidence. If, however, the applicant disputes the relevance of the document and gives specific reasons, the examiner should consider whether, in the light of these reasons and of the other prior art available to him, he is justified in pursuing the matter. If so, he should obtain a translation of the document (or merely the relevant part of it if that can be easily identified). If he remains of the view that the document is relevant, he should send a copy of the translation to the applicant with the next official communication.

7. Conflict with other European applications

7.1 State of the art pursuant to Art. 54(3)

Art. 54(3)
Art. 56
Art. 89
Art. 85

The state of the art also comprises the content of other European applications filed or validly claiming a priority date earlier than – but published under Art. 93 on or after – the date of filing or valid date of priority of the application being examined. Such earlier applications are part of the state of the art only when considering novelty and not when considering inventive step. The "date of filing" referred to in Art. 54(2) and (3) is thus to be interpreted as meaning the date of priority in appropriate cases (see Chapter V). By the "content" of a European application is meant the whole disclosure, i.e. the description, drawings and claims, including:

(i) any matter explicitly disclaimed (with the exception of disclaimers for unworkable embodiments);
(ii) any matter for which an allowable reference (see II, 4.19, penultimate paragraph) to other documents is made; and
(iii) prior art insofar as explicitly described.

However, the "content" does not include any priority document (the purpose of such document being merely to determine to what extent the priority date is valid for the disclosure of the European application (see V, 1.2)) nor, in view of Art. 85, the abstract (see B-XI, 2).

It is important to note that it is the content of the earlier application as filed which is to be considered when applying Art. 54(3). Where an application is filed in a non-official language as permitted by Art. 14(2) (see A-VIII, 1.1), it may happen that matter is erroneously omitted from the translation in the language of the proceedings and not published under Art. 93 in that language. Even in this case, it is the content of the original text which is relevant for the purposes of Art. 54(3).

7.1.1 Requirements

Whether a published European application can be a conflicting application under Art. 54(3) is determined firstly by its filing date and the date of its publication; the former must be before the filing or valid priority date of the application under examination, the latter must be on or after that date. If the published European application claims priority, the priority date replaces the filing date (Art. 89) for that subject-matter in the application which corresponds to the priority application. If a priority claim was abandoned or otherwise lost with effect from a date prior to publication, the filing date and not the priority date is relevant, irrespective of whether or not the priority claim might have conferred a valid priority right.

Further it is required that the conflicting application was still pending at its publication date (see J 5/81, OJ 4/1982, 155). If the application was withdrawn or otherwise lost before the date of publication, but published because the preparations for publication had been completed, the publication has no effect under Art. 54(3), but only under Art. 54(2). Art. 54(3) must be interpreted as referring to the

publication of a "valid" application, i.e. a European patent application in existence at its publication date.

Changes taking effect after the date of publication (e.g. withdrawal of a designation or withdrawal of the priority claim or loss of the priority right for other reasons) do not affect the application of Art. 54(3) (see III, 8.1 for transitional provisions concerning Art. 54(4) EPC 1973 and A-III, 11.1 and A-III, 11.3 for transitional arrangements concerning non-payment of designation fees for applications filed before 1 April 2009).

7.2 Euro-PCT applications

Art. 153
Rule 165

The above principles also apply to PCT applications designating EP, but with an important difference. Art. 153, in conjunction with Rule 165, makes it clear that a PCT application is not included in the state of the art for the purposes of Art. 54(3) unless the PCT applicant has paid the required filing fee under Rule 159(1)(c) and has supplied the PCT application to the EPO in English, French or German (this means that a translation is required where the PCT application was published in Japanese, Chinese, Spanish, Russian, Korean, Portuguese or Arabic).

7.3 Commonly designated States

See C-III, 8.1 for the transitional applicability of Art. 54(4) EPC 1973 to applications which are pending on 13 December 2007 and patents which have already been granted on that date.

7.4 Double patenting

The EPC does not deal explicitly with the case of co-pending European applications of the same effective date. However, it is an accepted principle in most patent systems that two patents cannot be granted to the same applicant for one invention. It is permissible to allow an applicant to proceed with two applications having the same description where the claims are quite distinct in scope and directed to different inventions. However, in the rare case in which there are two or more European applications from the same applicant definitively designating the same State or States (by confirming the designation through payment of the relevant designation fees) and the claims of those applications have the same filing or priority date and relate to the same invention (the claims conflicting in the manner explained in VI, 9.1.6), the applicant should be told that he must either amend one or more of the applications in such a manner that they no longer claim the same invention, or choose which one of those applications he wishes to proceed to grant. Should two applications of the same effective date be received from two different applicants, each must be allowed to proceed as though the other did not exist.

8. Conflict with national rights of earlier date

Rule 138

Where a national right of an earlier date exists in a Contracting State designated in the application, there are several possibilities of amendment open to the applicant. First, he may simply withdraw that designation from his application for the Contracting State of the

national right of earlier date. Second, for such State, he may file claims which are different from the claims for the other designated States. Third, the applicant can limit his existing set of claims in such a manner that the national right of earlier date is no longer relevant.

Amendment of the application to take account of prior national rights should be neither required nor suggested (see also III, 8.4). However, if the claims have been amended, then amendment of the description and drawings should be required if necessary to avoid confusion.

9. Novelty

9.1 State of the art pursuant to Art. 54(2)

Art. 54(1)

An invention is considered to be new if it does not form part of the state of the art. For a definition of "state of the art", see IV, 6. It should be noted that in considering novelty (as distinct from inventive step, see IV, 11.8), it is not permissible to combine separate items of prior art together. It is also not permissible to combine separate items belonging to different embodiments described in one and the same document, unless such combination has specifically been suggested (T 305/87, OJ 8/1991, 429).

However, if a document (the "primary" document) refers explicitly to another document as providing more detailed information on certain features, the teaching of the latter is to be regarded as incorporated into the document containing the reference, if the document referred to was available to the public on the publication date of the document containing the reference (see T 153/85, OJ 1-2/1988, 1) (For the state of the art pursuant to Art. 54(3), see IV, 7.1, and II, 4.19, penultimate paragraph). The relevant date for novelty purposes, however, is always the date of the primary document (see IV, 9.3).

Furthermore, any matter explicitly disclaimed (with the exception of disclaimers which exclude unworkable embodiments) and prior art acknowledged in a document, insofar as explicitly described therein, are to be regarded as incorporated in the document.

It is further permissible to use a dictionary or similar document of reference in order to interpret a special term used in a document.

9.2 Implicit features or well-known equivalents

A document takes away the novelty of any claimed subject-matter derivable directly and unambiguously from that document including any features implicit to a person skilled in the art in what is expressly mentioned in the document, e.g. a disclosure of the use of rubber in circumstances where clearly its elastic properties are used even if this is not explicitly stated takes away the novelty of the use of an elastic material. The limitation to subject-matter "derivable directly and unambiguously" from the document is important. Thus, when considering novelty, it is not correct to interpret the teaching of a

document as embracing well-known equivalents which are not disclosed in the documents; this is a matter of obviousness.

9.3 Relevant date of a prior document

In determining novelty, a prior document should be read as it would have been read by a person skilled in the art on the relevant date of the document. By "relevant" date is meant the publication date in the case of a previously published document and the date of filing (or priority date, where appropriate) in the case of a document according to Art. 54(3) (see IV, 7.1).

9.4 Enabling disclosure of a prior document

Subject-matter described in a document can only be regarded as having been made available to the public, and therefore as comprised in the state of the art pursuant to Art. 54(1), if the information given therein to the skilled person is sufficient to enable him, at the relevant date of the document (see IV, 9.3), to practise the technical teaching which is the subject of the document, taking into account also the general knowledge at that time in the field to be expected of him (see T 26/85, OJ 1-2/1990, 22, T 206/83, OJ 1/1987, 5 and T 491/99, not published in OJ).

Similarly, it should be noted that a chemical compound, the name or formula of which is mentioned in a prior-art document, is not thereby considered as known, unless the information in the document, together, where appropriate, with knowledge generally available on the relevant date of the document, enables it to be prepared and separated or, for instance in the case of a product of nature, only to be separated.

9.5 Generic disclosure and specific examples

In considering novelty, it should be borne in mind that a generic disclosure does not usually take away the novelty of any specific example falling within the terms of that disclosure, but that a specific disclosure does take away the novelty of a generic claim embracing that disclosure, e.g. a disclosure of copper takes away the novelty of metal as a generic concept, but not the novelty of any metal other than copper, and one of rivets takes away the novelty of fastening means as a generic concept, but not the novelty of any fastening other than rivets.

9.6 Implicit disclosure and parameters

In the case of a prior document, the lack of novelty may be apparent from what is explicitly stated in the document itself. Alternatively, it may be implicit in the sense that, in carrying out the teaching of the prior document, the skilled person would inevitably arrive at a result falling within the terms of the claim. An objection of lack of novelty of this kind should be raised by the examiner only where there can be no reasonable doubt as to the practical effect of the prior teaching (for a second non-medical use, however, see IV, 9.7). Situations of this kind may also occur when the claims define the invention, or a feature thereof, by parameters (see III, 4.11). It may happen that in the

relevant prior art a different parameter, or no parameter at all, is mentioned. If the known and the claimed products are identical in all other respects (which is to be expected if, for example, the starting products and the manufacturing processes are identical), then in the first place an objection of lack of novelty arises. If the applicant is able to show, e.g. by appropriate comparison tests, that differences do exist with respect to the parameters, it is questionable whether the application discloses all the features essential to manufacture products having the parameters specified in the claims (Art. 83).

9.7 Examination of novelty

In determining novelty of the subject-matter of claims, the examiner should have regard to the guidance given in III, 4.5 - 4.21. He should remember that, particularly for claims directed to a physical entity, non-distinctive characteristics of a particular intended use should be disregarded (see III, 4.13). For example, a claim to a substance X for use as a catalyst would not be considered to be novel over the same substance known as a dye, unless the use referred to implies a particular form of the substance (e.g. the presence of certain additives) which distinguishes it from the known form of the substance. That is to say, characteristics not explicitly stated, but implied by the particular use, should be taken into account (see the example of a "mold for molten steel" in III, 4.13). For claims to a first medical use, see IV, 4.8.

It should further be borne in mind that a claim to the use of a known compound for a particular purpose (second non-medical use) which is based on a technical effect should be interpreted as including that technical effect as a functional technical feature, and is accordingly not open to objection under Art. 54(1), provided that such technical feature has not previously been made available to the public (G 2/88, OJ 4/1990, 93, and G 6/88, OJ 4/1990, 114). For claims to a second or further medical use, see IV, 4.8.

9.8 Selection inventions

Selection inventions deal with the selection of individual elements, sub-sets, or sub-ranges, which have not been explicitly mentioned, within a larger known set or range.

(i) In determining the novelty of a selection, it has to be decided, whether the selected elements are disclosed in an individualised (concrete) form in the prior art (see T 12/81, OJ 8/1982, 296). A selection from a single list of specifically disclosed elements does not confer novelty. However, if a selection from two or more lists of a certain length has to be made in order to arrive at a specific combination of features then the resulting combination of features, not specifically disclosed in the prior art, confers novelty (the “two-lists principle”). Examples of such selections from two or more lists are the selection of:

(a) individual chemical compounds from a known generic formula whereby the compound selected results from the

selection of specific substituents from two or more “lists” of substituents given in the known generic formula. The same applies to specific mixtures resulting from the selection of individual components from lists of components making up the prior art mixture;

(b) starting materials for the manufacture of a final product;

(c) sub-ranges of several parameters from corresponding known ranges.

(ii) A sub-range selected from a broader numerical range of the prior art is considered novel, if each of the following three criteria is satisfied (see T 198/84, OJ 7/1985, 209; T 279/89, not published in the OJ):

(a) the selected sub-range is narrow compared to the known range;

(b) the selected sub-range is sufficiently far removed from any specific examples disclosed in the prior art and from the end-points of the known range;

(c) the selected range is not an arbitrary specimen of the prior art, i.e. not a mere embodiment of the prior art, but another invention (purposive selection, new technical teaching).

An effect occurring only in the claimed sub-range cannot in itself confer novelty on that sub-range. However, such a technical effect occurring in the selected sub-range, but not in the whole of the known range, can confirm that criterion (c) is met, i.e. that the invention is novel and not merely a specimen of the prior art. The meaning of “narrow” and “sufficiently far removed” has to be decided on a case-by-case basis. The new technical effect occurring within the selected range may also be the same effect as that attained with the broader known range, but to a greater extent.

(iii) In the case of overlapping ranges (e.g. numerical ranges, chemical formulae) of claimed subject-matter and the prior art the same principles apply for the assessment of novelty as in other cases, e.g. selection inventions (see T 666/89 OJ 8/1993, 495). It has to be decided which subject-matter has been made available to the public by a prior art disclosure and thus forms part of the state of the art. In this context, it is not only examples, but the whole content of the prior art document which has to be taken into consideration. As to overlapping ranges or numerical ranges of physical parameters, novelty is destroyed by an explicitly mentioned end-point of the known range, explicitly mentioned intermediate values or a specific example of the prior art in the overlap. It is not sufficient to exclude specific

novelty destroying values known from the prior art range, it must also be considered whether the skilled person, in the light of the technical facts and taking into account the general knowledge in the field to be expected from him, would seriously contemplate applying the technical teaching of the prior art document in the range of overlap. If it can be fairly assumed that he would do so, it must be concluded that no novelty exists. In T 26/85, OJ 1-2/1990, 22, the skilled person could not seriously contemplate working in the area of overlap, since the prior art surprisingly contained a reasoned statement clearly dissuading him from choosing said range, although the latter was claimed in said prior art. The criteria mentioned in (ii) above can be applied analogously for assessing the novelty of overlapping numerical ranges (see T 17/85, OJ 12/1986, 406). As far as overlapping chemical formulae are concerned, novelty is acknowledged if the claimed subject-matter is distinguished from the prior art in the range of overlap by a new technical element (new technical teaching), cf. T 12/90, point 2.6 of the reasons, not published in the OJ, for example a specifically selected chemical residue which is covered in general terms by the prior art in the overlapping area, but which is not individualised in the prior art document. If this is not the case, then it must be considered whether the skilled person would seriously contemplate working in the range of overlap and/or would accept that the area of overlap is directly and unambiguously disclosed in an implicit manner in the prior art (see for example T 536/95, not published in the OJ). If the answer is yes, then novelty is lacking.

10. Non-prejudicial disclosures

10.1 General

There are two specific instances (and these are the only two) in which a prior disclosure of the invention is not taken into consideration as part of the state of the art, viz. where the disclosure was due to, or in consequence of: *Art. 55(1)*

(i) an evident abuse in relation to the applicant or his legal predecessor – e.g. the invention was derived from the applicant and disclosed against his wish; or *Art. 55(1)(a)*

(ii) the display of the invention by the applicant or his legal predecessor at an officially recognised international exhibition as defined in Art. 55(1)(b). *Art. 55(1)(b)*

10.2 Time limit

An essential condition, in both instances (i) and (ii), is that the disclosure in point must have taken place not earlier than six months preceding the filing of the application. For calculating the six-month period the relevant date is that of the actual filing date of the European patent application, not the priority date (G 3/98, OJ 2/2001, 62, and G 2/99, OJ 2/2001, 83).

10.3 Evident abuse

Regarding instance (i), the disclosure might be made in a published document or in any other way. As a particular instance, the disclosure might be made in a European application of earlier priority date. Thus, for example, a person B who has been told of A's invention in confidence, might himself apply for a patent for this invention. If so, the disclosure resulting from the publication of B's application will not prejudice A's rights provided that A has already made an application, or applies within six months of such publication. In any event, having regard to Art. 61, B may not be entitled to proceed with his application (see VI, 9.2).

For "evident abuse" to be established, there must be, on the part of the person disclosing the invention, either actual intent to cause harm or actual or constructive knowledge that harm would or could ensue from this disclosure (see T 585/92, OJ 3/1996, 129).

10.4 International exhibition

Art. 55(2)
Rule 25

In instance (ii), the application must be filed within six months of the disclosure of the invention at the exhibition if the display is not to prejudice the application. Furthermore, the applicant must state, at the time of filing the application, that the invention has been so displayed, and must also file a supporting certificate within four months, giving the particulars required by Rule 25 (see A-IV, 3). The exhibitions recognised are published in the Official Journal.

11. Inventive step

11.1 General

Art. 56

An invention is considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. Novelty (see IV, 7) and inventive step are different criteria. The question – "is there inventive step?" – only arises if the invention is novel.

11.2 State of the art; date of filing

The "state of the art" for the purposes of considering inventive step is as defined in Art. 54(2) (see IV, 6). It is to be understood as concerning such kind of information as is relevant to some field of technology (T 172/03, not published in OJ). It does not include later published European applications referred to in Art. 54(3). As mentioned in IV, 6.4, "date of filing" in Art. 54(2), means date of priority where appropriate (see Chapter V). The state of the art may reside in the relevant common general knowledge, which need not necessarily be in writing and needs substantiation only if challenged (see T 939/92, OJ 6/1996, 309).

11.3 Person skilled in the art

The "person skilled in the art" should be presumed to be a skilled practitioner in the relevant field, who is possessed of average knowledge and ability and is aware of what was common general

knowledge in the art at the relevant date (see T 4/98, OJ 2002, 139, T 143/94, OJ 1996, 430, T 426/88, OJ 1992, 427). He should also be presumed to have had access to everything in the "state of the art", in particular the documents cited in the search report, and to have had at his disposal the normal means and capacity for routine work and experimentation. If the problem prompts the person skilled in the art to seek its solution in another technical field, the specialist in that field is the person qualified to solve the problem. The skilled person is involved in constant development in his technical field (see T 774/89, T 817/95, not published in OJ). He may be expected to look for suggestions in neighbouring and general technical fields (see T 176/84, OJ 2/1986, 50, T 195/84, OJ 2/1986, 121) or even in remote technical fields, if prompted to do so (T 560/89, OJ 12/1992, 725). Assessment of whether the solution involves an inventive step must therefore be based on that specialist's knowledge and ability (see T 32/81, OJ 6/1982, 225). There may be instances where it is more appropriate to think in terms of a group of persons, e.g. a research or production team, rather than a single person (T 164/92, OJ 5/1995, 305, T 986/96, not published in OJ). It should be borne in mind that the skilled person has the same level of skill for assessing inventive step and sufficient disclosure (see T 60/89, OJ 6/1992, 268, T 694/92, OJ 9/1997, 408, T 373/94, not published in OJ).

11.4 Obviousness

Thus the question to consider, in relation to any claim defining the invention, is whether before the filing or priority date valid for that claim, having regard to the art known at the time, it would have been obvious to the person skilled in the art to arrive at something falling within the terms of the claim. If so, the claim is not allowable for lack of inventive step. The term "obvious" means that which does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art, i.e. something which does not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art. In considering inventive step, as distinct from novelty (see IV, 9.3), it is fair to construe any published document in the light of knowledge up to and including the day before the filing or priority date valid for the claimed invention and to have regard to all the knowledge generally available to the person skilled in the art up to and including that day.

11.5 Problem-and-solution approach

In order to assess inventive step in an objective and predictable manner, the so-called "**problem-and-solution approach**" should be applied. Thus deviation from this approach should be exceptional.

In the problem-and-solution approach, there are three main stages:

(i) determining the "closest prior art",

(ii) establishing the "objective technical problem" to be solved, and

(iii) considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person.

11.5.1 Determination of the closest prior art

The closest prior art is that which in one single reference discloses the combination of features which constitutes the most promising starting point for an obvious development leading to the invention. In selecting the closest prior art, the first consideration is that it should be directed to a similar purpose or effect as the invention or at least belong to the same or a closely related technical field as the claimed invention. In practice, the closest prior art is generally that which corresponds to a similar use and requires the minimum of structural and functional modifications to arrive at the claimed invention (T 606/89, not published in OJ).

The closest prior art must be assessed from the skilled person's point of view on the day before the filing or priority date valid for the claimed invention.

In identifying the closest prior art, account should be taken of what the applicant himself acknowledges in his description and claims to be known. Any such acknowledgement of known art should be regarded by the examiner as being correct, unless the applicant states he has made a mistake (see VI, 8.2).

11.5.2 Formulation of the objective technical problem

In the second stage, one establishes in an objective way the **technical problem** to be solved. To do this one studies the application (or the patent), the closest prior art and the difference (also called "the **distinguishing feature(s)**" of the claimed invention) in terms of features (either structural or functional) between the claimed invention and the closest prior art, identifies the technical effect resulting from the distinguishing features, and then formulates the technical problem.

Features which cannot be seen to make any contribution, either independently or in combination with other features, to the technical character of an invention are not relevant for assessing inventive step (see T 641/00, OJ 7/2003, 352). Such a situation can occur for instance if a feature only contributes to the solution of a non-technical problem, for instance a problem in a field excluded from patentability (see T 931/95, OJ 10/2001, 441).

In the context of the problem-and-solution approach, the technical problem means the aim and task of modifying or adapting the closest prior art to provide the technical effects that the invention provides over the closest prior art. The technical problem thus defined is often referred to as the "**objective technical problem**".

The objective technical problem derived in this way may not be what the applicant presented as "the problem" in his application. The latter

may require reformulation, since the objective technical problem is based on objectively established facts, in particular appearing in the prior art revealed in the course of the proceedings, which may be different from the prior art of which the applicant was actually aware at the time the application was filed. In particular, the prior art cited in the search report may put the invention in an entirely different perspective from that apparent from reading the application only.

The extent to which such reformulation of the technical problem is possible has to be assessed on the merits of each particular case. As a matter of principle any effect provided by the invention may be used as a basis for the reformulation of the technical problem, as long as said effect is derivable from the application as filed (see T 386/89, not published in OJ). It is also possible to rely on new effects submitted subsequently during the proceedings by the applicant, provided that the skilled person would recognise these effects as implied by or related to the technical problem initially suggested (see IV, 11.11 and T 184/82, OJ 6/1984, 261).

It is noted that the objective technical problem must be so formulated as not to contain pointers to the technical solution, since including part of a technical solution offered by an invention in the statement of the problem must, when the state of the art is assessed in terms of that problem, necessarily result in an ex post facto view being taken of inventive activity (T 229/85, OJ 6/1987, 237). Where the claim refers to an aim to be achieved in a non-technical field, however, this aim may legitimately appear in the formulation of the problem as part of the framework of the technical problem to be solved, in particular as a constraint that has to be met (T 641/00, OJ 7/2003, 352 and T 172/03, not published in OJ).

The expression "technical problem" should be interpreted broadly; it does not necessarily imply that the technical solution is a technical improvement over the prior art. Thus the problem could be simply to seek an alternative to a known device or process which provides the same or similar effects or is more cost-effective. A technical problem may be regarded as being solved only if it is credible that substantially all claimed embodiments exhibit the technical effects upon which the invention is based.

Sometimes, the objective technical problem must be regarded as an aggregation of a plurality of "**partial problems**". This is the case where there is no technical effect achieved by all the distinguishing features taken in combination, but rather a plurality of partial problems is independently solved by different sets of distinguishing features (see IV, 11.6 and T 389/86, OJ 3/1988, 87).

11.5.3 Could-would approach

In the third stage the question to be answered is whether there is any teaching in the prior art as a whole that **would** (not simply could, but would) have prompted the skilled person, faced with the objective

technical problem, to modify or adapt the closest prior art while taking account of that teaching, thereby arriving at something falling within the terms of the claims, and thus achieving what the invention achieves (see IV, 11.4).

In other words, the point is not whether the skilled person could have arrived at the invention by adapting or modifying the closest prior art, but whether he **would have done** so because the prior art incited him to do so in the hope of solving the objective technical problem or in expectation of some improvement or advantage (see T 2/83, OJ 6/1984, 265). Even an implicit prompting or implicitly recognisable incentive is sufficient to show that the skilled person would have combined the elements from the prior art (see T 257/98, T 35/04, not published in OJ). This must have been the case for the skilled person before the filing or priority date valid for the claim under examination.

11.6 Combining pieces of prior art

In the context of the problem-solution approach, it is permissible to combine the disclosure of one or more documents, parts of documents or other pieces of prior art (e.g. a public prior use or unwritten general technical knowledge) with the closest prior art. However, the fact that more than one disclosure must be combined with the closest prior art in order to arrive at a combination of features may be a sign of the presence of an inventive step, e.g. if the claimed invention is not a mere aggregation of features (see C-IV, 11.7).

A different situation occurs where the invention is a solution to a plurality of independent "partial problems" (see IV, 11.7 and 11.5.2). Indeed, in such a case it is necessary to separately assess, for each partial problem, whether the combination of features solving the partial problem is obviously derivable from the prior art. Hence, a different document can be combined with the closest prior art for each partial problem (see T 389/86, OJ 3/1988, 87). For the subject-matter of the claim to be inventive, it suffices however that one of these combinations of features involves an inventive step.

In determining whether it would be obvious to combine two or more distinct disclosures, the examiner should also have regard in particular to the following:

(i) whether the content of the disclosures (e.g. documents) is such as to make it likely or unlikely that the person skilled in the art, when faced with the problem solved by the invention, would combine them - for example, if two disclosures considered as a whole could not in practice be readily combined because of inherent incompatibility in disclosed features essential to the invention, the combining of these disclosures should not normally be regarded as obvious;

(ii) whether the disclosures, e.g. documents, come from similar, neighbouring or remote technical fields (see C-IV, 11.3);

(iii) the combining of two or more parts of the same disclosure would be obvious if there is a reasonable basis for the skilled person to associate these parts with one another. It would normally be obvious to combine with a prior-art document a well-known textbook or standard dictionary; this is only a special case of the general proposition that it is obvious to combine the teaching of one or more documents with the **common general knowledge** in the art. It would, generally speaking, also be obvious to combine two documents one of which contains a clear and unmistakable reference to the other (for references which are considered an integral part of the disclosure, see IV, 7.1 and 9.1). In determining whether it is permissible to combine a document with an item of prior art made public in some other way, e.g. by use, similar considerations apply.

11.7 Combination vs. juxtaposition or aggregation

The invention claimed must normally be considered as a whole. When a claim consists of a "combination of features", it is not correct to argue that the separate features of the combination taken by themselves are known or obvious and that "therefore" the whole subject-matter claimed is obvious. However, where the claim is merely an "aggregation or juxtaposition of features" and not a true combination, it is enough to show that the individual features are obvious to prove that the aggregation of features does not involve an inventive step (see C-IV, 11.5.2, last paragraph). A set of technical features is regarded as a combination of features if the functional interaction between the features achieves a combined technical effect which is different from, e.g. greater than, the sum of the technical effects of the individual features. In other words, the interactions of the individual features must produce a synergistic effect. If no such synergistic effect exists, there is no more than a mere aggregation of features (see T 389/86, OJ 3/1988, 87, T 204/06, not published in OJ).

For example, the technical effect of an individual transistor is essentially that of an electronic switch. However, transistors interconnected to form a microprocessor synergically interact to achieve technical effects, such as data processing, which are over and above the sum of their respective individual technical effects (see also C-IV-Annex, 2).

11.8 "Ex post facto" analysis

It should be remembered that an invention which at first sight appears obvious might in fact involve an inventive step. Once a new idea has been formulated, it can often be shown theoretically how it might be arrived at, starting from something known, by a series of apparently easy steps. The examiner should be wary of ex post facto analysis of this kind. When combining documents cited in the search report, he should always bear in mind that the documents produced in the search have, of necessity, been obtained with foreknowledge of what matter constitutes the alleged invention. In all cases he should attempt to visualise the overall state of the art confronting the skilled person

before the applicant's contribution, and he should seek to make a "real-life" assessment of this and other relevant factors. He should take into account all that is known concerning the background of the invention and give fair weight to relevant arguments or evidence submitted by the applicant. If, for example, an invention is shown to be of considerable technical value, and particularly if it provides a technical advantage which is new and surprising and which is not merely achieved as a bonus effect in a "one-way street" situation (see 11.10.2), and this technical advantage can convincingly be related to one or more of the features included in the claim defining the invention, the examiner should be hesitant in pursuing an objection that such a claim lacks inventive step.

11.9 Origin of an invention

While the claim should in each case be directed to technical features (and not, for example, merely to an idea), in order to assess whether an inventive step is present it is important for the examiner to bear in mind that an invention may, for example, be based on the following:

(i) the devising of a solution to a known problem;

> Example: the problem of permanently marking farm animals such as cows without causing pain to the animals or damage to the hide has existed since farming began. The solution ("freeze-branding") consists in applying the discovery that the hide can be permanently depigmented by freezing.

(ii) the arrival at an insight into the cause of an observed phenomenon (the practical use of this phenomenon then being obvious);

> Example: the agreeable flavour of butter is found to be caused by minute quantities of a particular compound. As soon as this insight has been arrived at, the technical application comprising adding this compound to margarine is immediately obvious.

Many inventions are of course based on a combination of the above possibilities - e.g. the arrival at an insight and the technical application of that insight may both involve the use of the inventive faculty.

11.10 Secondary indicators

11.10.1 Predictable disadvantage; non-functional modification; arbitrary choice

It should be noted that if the invention is the result of a foreseeable disadvantageous modification of the closest prior art, which the skilled person could clearly predict and correctly assess, and if this predictable disadvantage is not accompanied by an unexpected technical advantage, then the claimed invention does not involve an

inventive step (see T 119/82, OJ 5/1984, 217, and T 155/85, OJ 3/1988, 87). In other words, a mere foreseeable worsening of the prior art does not involve an inventive step. However, if this worsening is accompanied by an unexpected technical advantage, an inventive step might be present. Similar considerations apply to the case where an invention is merely the result of an arbitrary non-functional modification of a prior-art device or of a mere arbitrary choice from a host of possible solutions (see T 72/95, not published in OJ, and T 939/92, OJ 6/1996, 309).

11.10.2 Unexpected technical effect; bonus effect

An unexpected technical effect may be regarded as an indication of inventive step. However, if, having regard to the state of the art, it would already have been obvious for a skilled person to arrive at something falling within the terms of a claim, for example due to a lack of alternatives thereby creating a "one-way street" situation, the unexpected effect is merely a bonus effect which does not confer inventiveness on the claimed subject-matter (see T 231/97, not published in OJ and T 192/82, OJ 9/1984, 415).

11.10.3 Long-felt need; commercial success

Where the invention solves a technical problem which workers in the art have been attempting to solve for a long time, or otherwise fulfils a long-felt need, this may be regarded as an indication of inventive step.

Commercial success alone is not to be regarded as indicative of inventive step, but evidence of immediate commercial success when coupled with evidence of a long-felt want is of relevance provided the examiner is satisfied that the success derives from the technical features of the invention and not from other influences (e.g. selling techniques or advertising).

11.11 Arguments and evidence submitted by the applicant

The relevant arguments and evidence to be considered by the examiner for assessing inventive step may either be taken from the originally-filed patent application or submitted by the applicant during the subsequent proceedings (see 11.5.2 above and VI, 5.3.4, 5.3.5 and 5.3.7).

Care must be taken, however, whenever new effects in support of inventive step are referred to. Such new effects can only be taken into account if they are implied by or at least related to the technical problem initially suggested in the originally filed application (see also IV, 11.5.2, T 386/89, not published in OJ, and T 184/82, OJ 6/1984, 261).

Example of such a new effect:

The invention as filed relates to a pharmaceutical composition having a specific activity. At first sight, having regard to the relevant prior art, it would appear that there is a lack of inventive step. Subsequently, the

applicant submits new evidence which shows that the claimed composition exhibits an unexpected advantage in terms of low toxicity. In this case, it is allowable to reformulate the technical problem by including the aspect of toxicity, since pharmaceutical activity and toxicity are related in the sense that the skilled person would always contemplate the two aspects together.

The reformulation of the technical problem may or may not give rise to amendment or insertion of the statement of the technical problem in the description. Any such amendment is only allowable if it satisfies the conditions listed in VI, 5.3.7. In the above example of a pharmaceutical composition, neither the reformulated problem nor the information on toxicity could be introduced into the description without infringing Art. 123(2).

11.12 Selection inventions

The subject-matter of selection inventions differs from the closest prior art in that it represents selected sub-sets or sub-ranges. If this selection is connected to a particular technical effect, and if no hints exist leading the skilled person to the selection, then an inventive step is accepted (this technical effect occurring within the selected range may also be the same effect as attained with the broader known range, but to an unexpected degree). The criterion of "seriously contemplating" mentioned in connection with the test for novelty of overlapping ranges should not be confused with the assessment of inventive step. For inventive step, it has to be considered whether the skilled person would have made the selection or would have chosen the overlapping range in the hope of solving the underlying technical problem or in expectation of some improvement or advantage. If the answer is negative, then the claimed matter involves an inventive step.

11.13 Dependent claims; claims in different categories

If an independent claim is new and non-obvious, there is no need to investigate the novelty and the non-obviousness of any claims dependent thereon, except in situations where the subject-matter of a dependent claim has a later effective date than the independent claim and intermediate documents are to be considered (see V, 2.4.3).

Similarly, if a claim to a product is new and non-obvious there is no need to investigate the novelty and non-obviousness of any claims for a process which inevitably results in the manufacture of that product or of any claims for a use of that product. In particular, analogy processes, i.e. processes which themselves would otherwise not involve an inventive step, are nevertheless patentable insofar as they provide a novel and inventive product (see T 119/82, OJ 5/1984, 217). It should, however, be noted that in cases where the product, process and use claims have different effective dates, a separate examination as to novelty and inventive step may still be necessary in view of intermediate documents.

11.14 Examples

The annex to this chapter gives examples of circumstances where an invention may be regarded as obvious or where it may involve an inventive step. It is to be stressed that these examples are only for illustrative purposes and that the applicable principle in each case is "was it obvious to a person skilled in the art?" (see IV, 11.5). Examiners should avoid attempts to fit a particular case into one of these examples if it is not clearly applicable. Also, the list is not exhaustive.

CHAPTER IV – Annex
Examples relating to the requirement of inventive step – indicators (see IV, 11.13)

1. Application of known measures?

1.1 Inventions involving the application of known measures in an obvious way and in respect of which an inventive step is therefore to be ruled out:

(i) the teaching of a prior document is incomplete and at least one of the possible ways of "**filling the gap**" which would naturally or readily occur to the skilled person results in the invention;

> Example: The invention relates to a building structure made from aluminium. A prior document discloses the same structure and says that it is of light-weight material but fails to mention the use of aluminium.

(ii) the invention differs from the known art merely in the use of **well-known equivalents** (mechanical, electrical or chemical);

> Example: The invention relates to a pump which differs from a known pump solely in that its motive power is provided by a hydraulic motor instead of an electric motor.

(iii) the invention consists merely in a new use of a well-known material employing the **known properties** of that material;

> Example: Washing composition containing as detergent a known compound having the known property of lowering the surface tension of water, this property being known to be an essential one for detergents.

(iv) the invention consists in the substitution in a known device of a recently developed material whose properties make it plainly suitable for that use ("**analogous substitution**");

> Example: An electric cable comprises a polyethylene sheath bonded to a metallic shield by an adhesive. The invention lies in the use of a particular newly developed adhesive known to be suitable for polymer-metal bonding.

(v) the invention consists merely in the use of a known technique in a closely analogous situation ("**analogous use**").

> Example: The invention resides in the application of a pulse control technique to the electric motor driving the auxiliary mechanisms of an industrial truck, such as a fork-lift truck, the use of this technique to control the electric propulsion motor of the truck being already known.

1.2 Inventions involving the application of **known measures** in a **non-obvious** way and in respect of which an inventive step is therefore to be recognised:

(i) a known working method or means when used for a **different purpose** involves a new, **surprising effect**;

> Example: It is known that high-frequency power can be used in **in**ductive butt welding. It should therefore be obvious that high-frequency power could also be used in **con**ductive butt welding with similar effect. However, if high-frequency power were used for the continuous conductive butt welding of coiled strip but without removing scale (such scale removal normally being necessary during conductive welding in order to avoid arcing between the welding contact and the strip), there is the unexpected additional effect that scale removal is found to be unnecessary because at high frequency the current is supplied in a predominantly capacitive manner via the scale which forms a dielectric. In that case, an inventive step would exist.

(ii) a new use of a known device or material involves **overcoming technical difficulties** not resolvable by routine techniques.

> Example: The invention relates to a device for supporting and controlling the rise and fall of gas holders, enabling the previously employed external guiding framework to be dispensed with. A similar device was known for supporting floating docks or pontoons but practical difficulties not encountered in the known applications needed to be overcome in applying the device to a gas holder.

2. Obvious combination of features?

2.1 Obvious and consequently **non-inventive combination** of features:

The invention consists merely in the **juxtaposition** or association of known devices or processes functioning in their normal way and not producing any non-obvious working inter-relationship.

> Example: Machine for producing sausages consists of a known mincing machine and a known filling machine disposed side by side.

2.2 Not obvious and consequently **inventive combination** of features:

The combined features mutually support each other in their effects to such an extent that a new technical result is achieved. It is irrelevant whether each individual feature is fully or partly known by itself. However, if the combination of features is a bonus effect, e.g. as the

result of a "one-way street" situation, the combination might lack an inventive step.

Example: A mixture of medicines consists of a painkiller (analgesic) and a tranquilliser (sedative). It was found that through the addition of the tranquilliser, which intrinsically appeared to have no painkilling effect, the analgesic effect of the painkiller was intensified in a way which could not have been predicted from the known properties of the active substances.

3. Obvious selection?

3.1 Obvious and consequently **non-inventive selection** among a number of known possibilities:

(i) the invention consists merely in choosing from a number of **equally likely alternatives**;

Example: The invention relates to a known chemical process in which it is known to supply heat electrically to the reaction mixture. There are a number of well-known alternative ways of so supplying the heat, and the invention resides merely in the choice of one alternative.

(ii) the invention resides in the choice of particular dimensions, temperature ranges or other parameters from a limited range of possibilities, and it is clear that these parameters could be arrived at by routine trial and error or by the application of **normal design procedures**;

Example: The invention relates to a process for carrying out a known reaction and is characterised by a specified rate of flow of an inert gas. The prescribed rates are merely those which would necessarily be arrived at by the skilled practitioner.

(iii) the invention can be arrived at merely by a **simple extrapolation** in a straightforward way from the known art;

Example: The invention is characterised by the use of a specified minimum content of a substance X in a preparation Y in order to improve its thermal stability, and this characterising feature can be derived merely by extrapolation on a straight-line graph, obtainable from the known art, relating thermal stability to the content of substance X.

(iv) the invention consists merely in **selecting** particular chemical compounds or compositions (including alloys) **from a broad field**.

Example: The prior art includes disclosure of a chemical compound characterised by a specified structure including a substituent group designated "R". This substituent "R" is defined so as to embrace entire ranges of broadly-defined radical groups such as all alkyl or aryl radicals either unsubstituted or substituted by halogen and/or hydroxy, although for practical reasons only a very small number of specific examples are given. The invention consists in the selection of a particular radical or particular group of radicals from amongst those referred to as the substituent "R" (the selected radical or group of radicals not being specifically disclosed in the prior-art document since the question would then be one of lack of novelty rather than obviousness). The resulting compounds:

(a) are neither described as having nor shown to possess any advantageous properties not possessed by the prior art examples; or

(b) are described as possessing advantageous properties compared with the compounds specifically referred to in the prior art, but these properties are ones which the person skilled in the art would expect such compounds to possess, so that he is likely to be led to make this selection.

3.2 Not obvious and consequently **inventive selection** among a number of known possibilities:

(i) the invention involves **special selection** in a process of particular operating conditions (e.g. temperature and pressure) within a known range, such selection producing **unexpected effects** in the operation of the process or the properties of the resulting product;

Example: In a process where substance A and substance B are transformed at high temperature into substance C, it was known that there is in general a constantly increased yield of substance C as the temperature increases in the range between 50 and 130 °C. It is now found that in the temperature range from 63 to 65 °C, which previously had not been explored, the yield of substance C was considerably higher than expected.

(ii) the invention consists in selecting **particular** chemical compounds or compositions (including alloys) from a broad field, such compounds or compositions having **unexpected advantages**.

> Example: In the example of a substituted chemical compound given at (iv) under 3.1 above, the invention again resides in the selection of the substituent radical "R" from the total field of possibilities defined in the prior disclosure. In this case, however, not only does the selection embrace a particular area of the possible field, and result in compounds that can be shown to possess advantageous properties (see IV, 11.10 and VI, 5.3.5) but there are no indications which would lead the person skilled in the art to this particular selection rather than any other in order to achieve the advantageous properties.

4. Overcoming a technical prejudice?

As a general rule, there is an inventive step if the prior art leads the person skilled in the art away from the procedure proposed by the invention. This applies in particular when the skilled person would not even consider carrying out experiments to determine whether these were alternatives to the known way of overcoming a real or imagined technical obstacle.

> Example: Drinks containing carbon dioxide are, after being sterilised, bottled while hot in sterilised bottles. The general opinion is that immediately after withdrawal of the bottle from the filling device the bottled drink must be automatically shielded from the outside air so as to prevent the bottled drink from spurting out. A process involving the same steps but in which no precautions are taken to shield the drink from the outside air (because none are in fact necessary) would therefore be inventive.

Chapter V

Priority

1. The right to priority

1.1 Filing date as effective date

According to Art. 80, a European application is accorded as its date of filing the date on which it satisfies the requirements of Rule 40, or, if filed under the PCT, the date on which it satisfies Art. 11 PCT. This date remains unchanged except in the special circumstances of late-filed drawings or parts of the description provided for in Rule 56 EPC and Art. 14(2) PCT. *Rule 40*

The date of filing may be the only effective date of the application. It will be of importance for fixing the expiry of certain time limits (e.g. the date by which the designation of the inventor must be filed under Rule 60), for determining the state of the art relevant to the novelty or obviousness of the subject-matter of the application, and for determining, in accordance with Art. 60(2), which of two or more European applications from separate persons for the same invention is to proceed to grant.

1.2 Priority date as effective date

However, in many cases, a European application will claim the right of priority of the date of filing of a previous application. In such cases, it is the priority date (i.e. the date of filing of the previous application) which becomes the effective date for the purposes mentioned in the preceding paragraph. *Art. 89*

1.3 Validly claiming priority

For a valid claim to priority, the following conditions must be satisfied: *Art. 87(1) and (5)*

(i) the previous application must have been made in or for a Member State of the Paris Convention, a Member of the World Trade Organization (WTO) or in a State which has concluded an equivalent bilateral or multilateral agreement with the Office (to date, no such agreements have been concluded);

(ii) the previous application whose priority is claimed must have been filed by the applicant of the European application or his predecessor in title;

(iii) the previous application must have been filed not more than 12 months before the filing date of the European application; and

(iv) the previous application must have been the "first application" filed in respect of the same invention as the one to which the European application relates (see V, 1.4 and 1.4.1).

Art. 87(2) and (3)

As concerns (i), the words "in or for" any Member State of the Paris Convention or Member of the WTO mean that priority may be claimed in respect of a previous national application, European application or PCT application. If the previous application was filed in or for an EPC Contracting State, this State may also be designated in the European application. The previous application may be for a patent or for the registration of a utility model or for a utility certificate. However, a priority right based on the deposit of an industrial design is not recognised (see J 15/80, OJ 7/1981, 213). So long as the contents of the application were sufficient to establish a filing date, it can be used to create a priority date, no matter what the outcome of the application may be; for example, it may subsequently be abandoned or refused.

As concerns (ii) and (iii), see A-III, 6.1 and 6.6, respectively.

Art. 87(1)

As concerns (iv), the expression "the same invention" in Art. 87(1) means that the subject-matter of a claim in a European application may enjoy the priority of a previous application only if the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole. This means that the specific combination of features present in the claim must at least implicitly be disclosed in the previous application (see V, 2.2 and G 2/98, OJ 10/2001, 413).

1.4 First application

Art. 87(1)

The filing date of the "first application" must be claimed as a priority, i.e. the application disclosing for the first time any or all of the subject-matter of the European application. If it is found that the application to which the priority claim is directed is in fact not the first application in this sense, but some or all of the subject-matter was disclosed in a still earlier application filed by the same applicant or his predecessor in title, the priority claim is invalid insofar as the subject-matter was already disclosed in the still earlier application (see V, 1.4.1).

To the extent the priority claim is invalid, the effective date of the European application is the date of its filing. The previously disclosed subject-matter of the European application is not novel if the still earlier application referred to above was published prior to the effective date of the European application (Art. 54(2)) or if the still earlier application is also a European application which was published on or after the effective date of the European application in question (Art. 54(3)).

1.4.1 Subsequent application considered as first application

Art. 87(4)

A subsequent application for the same subject-matter and filed in or for the same State or Member of the WTO is considered as the "first application" for priority purposes if, at the date this subsequent application was filed, the still earlier application had been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and had not served as a basis for claiming priority. The EPO will not consider this question unless

there is evidence of the existence of a still earlier application as, for example, in the case of a United States continuation-in-part application. Where it is clear that a still earlier application for the same subject-matter exists, and where the priority right is important because of intervening prior art (see V, 2.1), the applicant should be required to establish by evidence from an appropriate authority (normally a national patent office) that there were no rights outstanding in the still earlier application in respect of the subject-matter of the application being examined.

1.5 Multiple priorities

Art. 88(2) and (3)

"Multiple priorities may be claimed" – i.e. a European application may claim rights of priority based on more than one previous application. The previous application may have been filed in or for the same or different States or Members of the WTO, but in all cases the earliest application must have been filed not more than 12 months before the date of filing of the European application. Subject-matter of a European application will be accorded the priority date of the earliest priority application which discloses it. If, for instance, the European application describes and claims two embodiments (A and B) of an invention, A being disclosed in a French application and B in a German application, both filed within the preceding 12 months, the priority dates of both the French and German applications may be claimed for the appropriate parts of the European application; embodiment A will have the French priority date and embodiment B the German priority date as effective dates. If embodiments A and B are claimed as alternatives in one claim, these alternatives will likewise have the different priority dates as effective dates. If, on the other hand, a European application is based on one previous application disclosing a feature C and a second previous application disclosing a feature D, neither disclosing the combination of C and D, a claim to that combination will be entitled only to the date of filing of the European application itself. In other words, it is not permitted to "mosaic" priority documents. An exception might arise where one priority document contains a reference to the other and explicitly states that features from the two documents can be combined in a particular manner.

2. Determining priority dates

2.1 Examining the validity of a right to priority

As a general rule, the examiner should not make any investigation as to the validity of a right to priority. However, the priority right assumes importance if prior art has to be taken into account which has been made available to the public within the meaning of Art. 54(2) on or after the priority date claimed and before the date of filing (e.g. an intermediate document, see IV, 6.4) or if the content of the European patent application is totally or partially identical with the content of another European application within the meaning of Art. 54(3), such other application claiming a priority date within that period. In such cases, (i.e. cases where the art in question would be relevant if of earlier date) the examiner must investigate whether the priority date(s)

claimed may be accorded to the appropriate parts of the application he is examining and should inform the applicant of the outcome and whether, in consequence, the particular prior art under consideration, e.g. the intermediate document, or the other European application forms part of the state of the art within the meaning of Art. 54. Also, in the case of possible conflict with another European application under Art. 54(3), it may be necessary in addition to allocate effective dates to the appropriate parts of that other application and to communicate this to the applicant analogously (see also IV, 6.4). When the examiner needs to consider the question of priority date, he should bear in mind all the matters which are mentioned in V, 1.3 to 1.5 above.

If in case of a Euro-PCT application, where the EPO is acting as a designated or elected Office, the priority document is not on file, substantive examination may nevertheless be started. In such a case, without the priority document being on file, the application may even, where appropriate, be refused because the claimed subject-matter lacks novelty or inventive step, provided that the relevant state of the art is neither an intermediate document nor an Art. 54(3) application. However, no European patent may be granted until such time as the priority document is on file. In such a case, the applicant is informed that the decision to grant will not be taken as long as the priority document is missing.

If intermediate documents or Art. 54(3) applications exist and the patentability of the subject-matter claimed depends on the validity of the priority right, substantive examination cannot be finalised as long as the priority document is missing. Where the applicant has complied with Rule 17.1(a) or (b) PCT, he may not be requested to file the priority document. The proceedings have to be stayed and the applicant is informed that, since the patentability of the subject-matter claimed depends on the validity of the priority right, substantive examination cannot be finalised as long as the priority document is not on file.

2.2 The same invention

The basic test to determine whether a claim is entitled to the date of a priority document is, as far as the requirement of "the same invention" is concerned (see V, 1.3(iv)), the same as the test for determining whether or not an amendment to an application satisfies the requirement of Art. 123(2) (see VI, 5.3). That is to say, for the priority date to be valid in this respect the subject-matter of the claim must be directly and unambiguously derivable from the disclosure of the invention in the priority document, also taking into account any features implicit to a person skilled in the art in what is expressly mentioned in the document (see G 2/98, OJ 10/2001, 413). As an example of an implicit disclosure, a claim to an apparatus including "releasable fastening means" would be entitled to the priority date of a disclosure of that apparatus in which the relevant fastening element was, say, a nut and bolt, or a spring catch or a toggle-operated latch, provided the general concept of "releasable" is implicit in the disclosure of such element.

Art. 88(4)

It is not necessary that the subject-matter for which priority is claimed be found among any claims in the previous application. It is sufficient that the documents of the previous application taken as a whole "specifically disclose" such subject-matter. The description and any claims or drawings of the previous application should, therefore, be considered as a whole in deciding this question, except that account should not be taken of subject-matter found solely in that part of the description referring to prior art, or in an explicit disclaimer.

The requirement that the disclosure must be specific means that it is not sufficient if the subject-matter in question is merely referred to in broad and general terms. A claim to a detailed embodiment of a certain feature would not be entitled to priority on the basis of a mere general reference to that feature in a priority document. Exact correspondence is not required, however. It is enough that, on a reasonable assessment, there is in substance a disclosure of all the subject-matter of the claim.

A disclaimer not originally disclosed which is allowable under Art. 123(2) and therefore does not provide a technical contribution (see VI, 5.3.11) does not change the identity of the invention within the meaning of Art. 87(1). Also, a disclaimer which does not provide a technical contribution could be allowably introduced when drafting and filing a European patent application, without affecting the right to priority from the first application not containing the disclaimer (G 1/03, OJ 8-9/2004, 413 and G 2/03, OJ 8-9/2004, 448).

2.3 Priority claim not valid

If the tests set out in V, 2.2 are not satisfied in relation to a particular previous application, then the effective date of the subject-matter of the claim in question will either be the filing date of the earliest application which does provide the required disclosure and of which the priority is validly claimed (see G 3/93, OJ 1-2/1995, 18) or, in the absence of such, will be the date of filing of the European application itself (or the new date of filing if the application has been re-dated under Rule 56).

2.4 Some examples of determining priority dates

Note: the dates used are merely illustrative; they do not take account of the fact that the filing offices of the EPO are closed on weekends and certain public holidays.

2.4.1 Intermediate publication of the contents of the priority application

P is the application from which priority is claimed by EP, D is the disclosure of the subject-matter of P.

1.1.90	1.5.90	1.6.90
filing	publication	filing
P	D	EP

D is state of the art under Art. 54(2) if the priority claim of P is not valid.

2.4.2 Intermediate publication of another European application

P1 is the application from which priority is claimed by EP1, P2 the one from which EP2 claims priority. EP1 and EP2 are filed by different applicants.

1.2.89	1.1.90	1.2.90	1.8.90	1.1.91
filing	filing	filing	publication	filing
P1	P2	EP1	EP1	EP2
A + B	A + B	A + B	A + B	A + B

EP1 is state of the art under Art. 54(3) if the respective priority claims of P1 and P2 are valid. This does not change if the publication of EP1 takes place after the filing date of EP2. The publication of EP1 is state of the art under Art. 54(2) if the priority claim of P2 is not valid.

2.4.3 Multiple priorities claimed for different inventions in the application with an intermediate publication of one of the inventions

EP claims priority of P1 and P2, D is the disclosure of A+B.

1.1.90	1.2.90	1.3.90	1.6.90
filing	publication	filing	filing
P1	D	P2	EP
A + B	A + B	A + B + C	claim 1: A + B claim 2: A + B + C

Claim 1 has a valid priority of P1 for its subject-matter, thus publication D is not state of the art under Art. 54(2) against this claim. Claim 2 cannot benefit from the priority of P1, as it does not concern the same subject-matter. Thus publication D is state of the art under Art. 54(2) for this claim (see G 3/93, OJ 1-2/1995, 18). It is immaterial whether claim 2 is in the form of a dependent or an independent claim.

2.4.4 A situation in which it has to be checked whether the application from which priority is actually claimed is the "first application" in the sense of Art. 87(1)

P1 is the earliest application of the same applicant containing the invention. EP claims the priority of the later US application P2, which is a "continuation-in-part" of P1. D is a public disclosure of A+B.

1.7.89	1.1.90	1.6.90	1.12.90
filing	filing	publication	filing
P1	P2 (cip)	D	EP
A + B	A + B A + B + C	A + B	claim 1: A + B claim 2: A + B + C

The priority claim of P2 for claim 1 is not valid as P2 is not the "first application" for this subject-matter in the sense of Art. 87(1), but P1, which has "left rights outstanding" in that P2 is a "continuation-in-part" thereof. Therefore Art. 87(4) does not apply and this is not altered by an abandonment, withdrawal, refusal or non-publication of P1. D is

prior art pursuant to Art. 54(2) against claim 1, but not against claim 2, as the latter claim has the earlier priority of P2.

3. Claiming priority

3.1 General remarks

An applicant who wishes to claim priority must file a declaration of priority giving particulars of the previous filing, as specified in Rule 52(1), together with a certified copy of the previous application and, if necessary for the assessment of patentability, a translation of it into one of the EPO official languages (see A-III, 6). *Art. 88(1)* *Rule 52(1)* *Rule 53(1) and (3)*

3.2 Declaration of priority

A declaration of priority from an earlier filing should preferably be made at the time of filing the European application, although this can be done at any time within 16 months from the earliest priority date claimed (see A-III, 6.5.1). The declaration of priority must indicate the date of the priority application, the relevant State party to the Paris Convention or Member of the WTO, and the file number. *Rule 52(1) and (2)*

A declaration of priority may be corrected within 16 months from the earliest priority date. This time limit cannot expire earlier than four months after the filing date (see A-III, 6.5.2). *Rule 52(3)*

3.3 Certified copy of the previous application (priority document)

The certified copy of the previous application, i.e. the priority document, must be filed within 16 months of the priority date (see also A-VII, 3.5), unless such a copy is already on file because it has been supplied in the context of a request pursuant to Rule 56, see A-III, 6.7. *Rule 53(1)*

Moreover, in accordance with Rule 53(2) and the Decision of the President of the EPO dated 17 March 2009, OJ EPO 4/2009 236, the EPO will include a copy of the previous application in the file of the European patent application without charging a fee, if the previous application is: *Rule 53(2)*

(i) a European patent application;

(ii) an international application filed with the EPO as receiving Office under the PCT;

(iii) a Japanese patent or utility model application;

(iv) a United States provisional or non-provisional patent application; or

(v) a Korean patent or utility model application.

No request is necessary to this end. As soon as the EPO has included in the file of the European patent application a copy of the previous application, it informs the applicant accordingly.

3.4 Translation of the previous application

Art. 88(1)
Rule 53(3)

A translation of the previous application into one of the official languages of the *EPO* is required only if it is needed for determining the validity of the priority claim, where this is of relevance to the patentability of the underlying invention. The translation must be filed within the time limit set by the *EPO*. Alternatively, a declaration that the European patent application is a complete translation of the previous application may be submitted within that same time limit. If this is not the case, or if the European application contains more or less text than is contained in the previous application as filed, such a declaration cannot be accepted and a complete translation must be filed. Where the European application contains claims on its date of filing and the priority application did not contain claims on its filing date or contained fewer claims on its filing date than the subsequent European application, the declaration cannot be accepted (see A-III, 6.8). A merely different arrangement of the various elements of the application (e.g. presenting the claims before the description, or vice versa) does not affect the validity of such a declaration (see Legal Advice No. 19/99 (OJ 5/1999, 296)).

The translation or declaration under Rule 53(3) must also be filed in those cases where the EPO adds a copy of the previous application to the file (Notice from the EPO, OJ 4/2002, 192).

Rule 56

If the applicant has already provided the EPO with a translation of the priority document as part of a request under Rule 56 (see A-II, 5.4(vi)) to base missing parts of the description or drawings on the priority application itself, then there is no need for the applicant to file the translation a second time.

If the required translation or declaration is not filed within the time limit, then the intermediate document(s) which resulted in the validity of the priority claimed becoming relevant for the assessment of patentability will be considered to belong to the prior art under Art. 54(2) or Art. 54(3), as applicable (see A-III, 6.8). However, for reasons of legal certainty the right of priority remains effective for determining the state of the art for the purposes of Art. 54(3) (see V, 2.1 and 3.5) in respect of any other European patent application. In that respect it is immaterial whether the translation or declaration has been filed, as changes taking effect after the date of publication do not affect the application of Art. 54(3).

3.5 Abandonment of priority claim

An applicant may voluntarily abandon a claimed priority at any time. If he does so before the technical preparations for publication have been completed, then the priority date is not effective and the publication is deferred until 18 months after the filing date. If it is abandoned after the technical preparations for publication have been completed, then the application is still published 18 months after the priority date originally claimed (see A-VI, 1.1 and C-IV, 7.1.1).

3.6 Re-establishment of rights in respect of the priority period

Art. 122
Rule 136(1)

An applicant may file a request for re-establishment of rights in respect of the priority period under Art. 122 (see A-III, 6.6). Any request for re-establishment of rights in respect of the period specified in Art. 87(1) must be filed within two months of expiry of that period, according to Rule 136(1), second sentence. Where a request for re-establishment in respect of the priority period has been allowed, the examiner should carefully review the relevance of prior art documents cited previously in the search report or communications.

Chapter VI

Examination procedure

This chapter sets out the general procedure for examination, together with guidance on particular matters where necessary. It does not provide detailed instructions on matters of internal administration.

1. The start of examination

1.1 Request for examination

In order that examination of a European application can begin, the applicant is required to file a request for examination, which, however, is not deemed to be filed until after the examination fee has been paid. The request for examination may be filed from the date on which the application is filed up to the end of six months after the date on which the European Patent Bulletin mentions the publication of the European search report. If the request for examination is not filed within this period, the application is deemed to be withdrawn. However, in such a case, the applicant has the possibility of filing a request for further processing pursuant to Art. 121. According to Rule 70(1), the request for examination may not be withdrawn.

Art. 94
Art. 121
Rule 70
Art. 122(4)
Rule 136(3)

Subject to certain exceptions, the applicant must also respond to the search opinion within the above-mentioned period for filing the request for examination (see B-XII, 9 and VI, 3.2), unless the EPO invites him to confirm an early request for examination according to Rule 70(2), in which case he must respond to the search opinion within the period provided for under Rule 70(2) (see VI, 1.1.1).

Rule 70a(1) and (3)

Responsibility for examining the application passes from the Receiving Section to the Examining Division at the time when a request for examination is filed. This is subject to two exceptions:

Rule 10
Rule 70(2)

(i) if the applicant has filed a request for examination before the European search report has been sent to him, then the Examining Division is responsible only from the time when the confirmation of the request is received by the EPO following an invitation under Rule 70(2);

(ii) if the applicant has filed a request for examination before the European search report has been sent to him and has also waived the right to receive an invitation to confirm under Rule 70(2), then the Examining Division is responsible only from the time when the search report is sent to the applicant.

1.1.1 Confirmation of early request for examination

Rule 70(2) and (3)
Art. 121
Art. 11 RFees
Rule 70a(2) and (3)

If the applicant has filed a request for examination before the search report has been transmitted to him, the EPO will invite him to confirm, within the six-month period, that he desires to proceed further with his application. Where the applicant also has to respond to the search opinion, his response is required within this same period (see B-XII, 9 and VI, 3.2). In these cases, the applicant's response to the search opinion is interpreted as the confirmation required by Rule 70(2), even where not explicitly expressed as such. If the applicant fails to confirm his desire to proceed further with the application in due time in reply to this invitation, the application will be deemed to be withdrawn. In this case, however, the means of redress provided for in Art. 121 (further processing of the application) will apply (see A-VI, 2.2 and 2.3). For the conditions applicable to a refund of the examination fee if the application is withdrawn, refused or deemed to be withdrawn, see A-VI, 2.5.

1.1.2 Acceleration of examination procedure

Rule 70(2)
Art. 11(b) RFees
Rule 62(1)

Where the applicant files a request for examination before the search report is transmitted to him, he may also dispense with the need to comply with the invitation pursuant to Rule 70(2), and file a categorical request for examination whatever the result of the search may be, by which the procedure can also be accelerated (see Notice from the EPO dated 14 July 2007, Special edition No. 3, OJ EPO 2007, F.1). In this case, confirmation that he desires to proceed further with his application is deemed to be given when the search report is transmitted to him, so that in accordance with Rule 62(1) the search report is not accompanied by a search opinion. Under these circumstances, if the application is not in order for grant, a communication under Art. 94(3) and Rule 71(1) and (2) is transmitted to the applicant. If the application is in order for grant, the subsequent procedure will depend on whether or not it is possible at that time to carry out the search for conflicting European applications according to Art. 54(3) (see VI, 8.1 and B-XII, 8). If that search can be carried out, and assuming that it does not identify any conflicting applications, then the communication under Rule 71(3) is transmitted to the applicant. If it cannot yet be carried out, then the communication from the examining division will be postponed until the said search is completed and the applicant will be informed accordingly. If the European patent application is subsequently withdrawn before the substantive examination has begun, 75% of the examination fee will be refunded. For other ways of accelerating the European grant procedure, e.g. under the PACE programme, see E-VIII, 3.

1.1.3 Euro-PCT applications

Art. 153(4), (6) and (7)
Art. 150(2)
Rule 159(1)(f)

If the application has proceeded via the PCT (Euro-PCT application), the above-mentioned six-month period begins with the publication of the PCT search report or the declaration under Art. 17(2)(a) PCT. However, as is laid down in Art. 150(2), the time limit for requesting examination in a Euro-PCT case does not expire before the time prescribed in Art. 22 PCT and Art. 39 PCT (i.e. not before the time limit

of Rule 159(1)(f)). The time limit will not be affected by whether a supplementary European search pursuant to Art. 153(7) needs to be made or whether the international application pursuant to Art. 153(4) is again published by the EPO.

If the request for examination of a Euro-PCT application has not been filed within the time limit, the application is deemed withdrawn under Rule 160(1). In such a case, however, the applicant has the possibility of filing a request for further processing pursuant to Art. 121.

Art. 121
Rule 136(3)
Rule 160(1)

1.1.4 Invention to be examined

It is to be noted that where the search report and the search opinion have been drawn up to cover several inventions lacking unity, the applicant is free to select the invention to be examined in the application under consideration. The others will be subject to objections of lack of unity and may be divided out according to Rule 36 (see III, 7.9 to 7.11), provided that, when a divisional application is filed, the application being divided is still pending (see A-IV, 1.1.1.1) and at least one of the periods provided for under Rule 36(1)(a) and (b) has not yet expired (see A-IV, 1.1.1.2 and 1.1.1.3).

Rule 36

1.2 Allocation of the application

The dossier will normally be allocated to an Examining Division responsible for the examination of applications in the technical field in which the particular application has been classified by the Search Division or ISA which carried out the search. There may be instances where it is appropriate to allocate the application to an Examining Division comprising examiners who are not normally responsible for the indicated part of the IPC. There are a number of possible reasons for this: e.g. if examination of an application requires very specialist technical knowledge; or to make it possible, where appropriate, that an original and a divisional application are dealt with by the same Examining Division (this could sometimes be more efficient even when the two applications are classified in different technical fields); or if the classification of the published application does not correspond to the subject-matter of the application in the form in which it reaches the substantive examiner (e.g. because the application has been amended after receipt of the search report).

1.3 Examining Division

An Examining Division will normally consist of three technical examiners. However, within the Examining Division made responsible for the application, one member will, as a general rule, be entrusted to carry out all the work up to the point of a decision to grant a patent or refuse the application. This means that this examiner is entrusted to act on behalf of the Examining Division in all communications with the applicant up to that point, but he may confer informally with the other members of the Division at any time if a special point of doubt or difficulty arises (see VI, 7.1). Where reference is made in this Part C of the Guidelines to the "examiner", this normally means the examiner entrusted with the work in this way, and it should be understood that

Art. 18(2)

this primary examiner is always acting in the name of the Examining Division. This examiner is normally the examiner who drafted the search report.

1.4 Designation fee(s), extension fees

Rule 39(1)
Art. 90(3)

Under Rule 39(1), the designation fee(s) can be validly paid up to the same time limit as the examination fee and therefore will be generally paid at the same time as the examination fee. The examination whether and to what extent a designation fee has been validly paid has been entrusted to the formalities officer by virtue of Rule 11(3); see the Decision of the President of the EPO dated 12 July 2007 (Special edition No. 3, OJ EPO 2007, F.2). The same applies to the examination as to whether extension fees have been paid, see A-III, 12.2.

2. Examination procedure in general

2.1 Purpose of examination

Art. 94(1)
Art. 164(1)

The purpose of examination is to ensure that the application and the invention to which it relates meet the requirements set out in the relevant Articles of the EPC and the Rules of its Implementing Regulations. The prime task of the Examining Division is to deal with the substantive requirements; the criteria by which an examiner judges whether they have been met are dealt with in detail, insofar as appears necessary, in Chapters II to V. As for the formal requirements (see Part A), these are initially the responsibility of the Receiving Section. As soon as the application has passed to the Examining Division under Rule 10, that Division will have ultimate responsibility, but formal matters will normally be dealt with by a formalities officer. The examiner should not spend time checking the work done by the Receiving Section or the formalities officer, but if he believes a formalities report is incorrect or incomplete he should refer the application to the formalities officer for further consideration.

Rule 70(2)

The examination is to be carried out in accordance with Art. 94(3) and (4), Art. 97, Rule 71(1) to 71(10) and Rule 72. The examiner's first step is to study the description, drawings (if any) and the claims of the application. However, as the examiner will normally already have done this when he carried out the search (see B-XII, 3), he should concentrate on any amendments and/or comments filed by the applicant in response to the search opinion (see B-XII, 9). If amendments were made and these have not been identified and/or their basis in the application as filed not indicated by the applicant (see VI, 5.7) and the application is one of those mentioned in VI, 5.7.4, the Examining Division may send a communication according to Rule 137(4) requesting the applicant to provide this information (see VI, 5.7.1).

2.2 Topping-up search

The examiner should make a search for any additional conflicting European applications falling within the area defined by Art. 54(3) (see VI, 8.1), unless this was already covered by the search report.

2.3 Communication with the applicant

Rule 71(1) and (2)
Rule 132
Art. 94(3)

Taking into account the documents (if any) cited in the search report and any further documents found as the result of the search referred to in VI, 2.2 above, and taking account of any amendments proposed, or comments made, by the applicant in reply to the search opinion (see B-XII, 9), the examiner should identify any requirements of the EPC which, in his opinion, the application does not satisfy. He will then write to the applicant giving reasons for any objections he raises and inviting the applicant within a specified period to file his observations or submit amendments. The filed application documents are not sent back to the applicant although a copy of the description and claims may be sent in appropriate cases (see E-II). When the applicant has replied, the examiner will then re-examine the application.

2.3.1 Requesting information from the applicant

Art. 124
Rule 141

The EPO may invite the applicant to submit information on prior art which has been taken into consideration in national or regional patent proceedings concerning an invention to which the European patent application relates. Failure on the part of the applicant to comply with this invitation results in the application being deemed to be withdrawn under Art. 124(2).

2.4 Re-examination, refusal, appeal, interlocutory revision

Art. 94(3)
Art. 97
Rule 111(2)
Art. 113(1)
Art. 109
Art. 111(1) and (2)

The examiner should be guided at the re-examination stage by the over-riding principle that a final position (grant or refusal) should be reached in as few actions as possible, and he should control the procedure with this always in mind. The EPC provides that the process of communicating with the applicant described in VI, 2.3 is repeated "as often as necessary". Nevertheless, if despite the applicant's submissions, i.e. amendments or counter-arguments, objections persist, then even at the first re-examination stage the examiner should bring the application before the other members of the Examining Division, which may then decide to refuse the application. In any event, at some stage, the examiner will make a short written recommendation to the Division either that the application should be refused or that a patent should be granted. If the Division intends to refuse the application, a written reasoned decision is necessary and this will normally be prepared by the examiner entrusted with the examination of the application. In preparing the decision, the examiner must take care to abide by the general principles set out in Art. 113(1), i.e. the decision must be based on grounds or evidence on which the applicant has had the opportunity to comment. If the applicant appeals against the decision and the Examining Division considers, in the light of the applicant's statement, that the appeal is admissible and well-founded, it should rectify its decision accordingly within three months after receipt of the statement of grounds. Otherwise, the appeal will be

considered by a Board of Appeal. If a decision to refuse a patent is reversed on appeal, the application may be referred back to the Examining Division for further examination. In such a case, the further examination will normally be entrusted to the examiner who performed the original examination. The Examining Division is bound by the ratio decidendi of the Board of Appeal, insofar as the facts are the same.

2.5 Communication under Rule 71(3)

Rule 71(3) and (10)
Rule 50(1)

If the Examining Division considers that a European patent may be granted, it will first issue a communication under Rule 71(3) in order to inform the applicant of the text in which it intends to grant the patent. In this communication, the applicant is requested to pay the fee for grant and publishing and to file a translation of the claims in the two official languages of the EPO other than the language of the proceedings within a period of four months. The translation should meet the requirements pursuant to Rule 50(1). If the applicant pays the fee and files the translation within the period of four months, he is deemed to have approved the text intended for grant.

Rule 71(6)

In the communication under Rule 71(3), if applicable, the applicant is also requested to pay claims fees pursuant to Rule 71(6) within the same period.

Rule 71(10)

The communication must contain a reference to the relevant pages on the EPO website where information concerning translation requirements of the Contracting States under Art. 65(1) is published (Rule 71(10)).

For further details of the procedure at the final stage of examination, see VI, 14.

2.6 Grant of a patent

Art. 97(1)

If the applicant has fulfilled the requirements set out in VI, 2.5, it is decided that a European patent be granted, provided that renewal fees and any additional fees already due have been paid.

2.7 Application deemed withdrawn

Rule 71(7)

If the applicant does not pay the fee for grant and publishing or the claims fees or does not file the translation in due time, the application is deemed to be withdrawn.

2.8 Amendments

Rule 71(4)

If the applicant files amendments or other requests in reply to the communication pursuant to Rule 71(3), the proceedings are continued as set out in VI, 14.4.

2.9 Examination stages

The different stages of the examination procedure are considered in more detail in the following sections.

3. The first stage of examination

3.1 Missing drawings or parts of the description filed under Rule 56 or claims filed after accordance of a date of filing

Rule 56

Where the applicant has supplied missing drawings or parts of the description after accordance of a filing date (see A-II, 5) under Rule 56, and the Receiving Section has determined that the missing drawings or parts of the description are "completely contained" in the claimed priority application, the application is not re-dated to the date on which the missing drawings or parts of the description were supplied. The Examining Division may review the findings of the Receiving Section on the applicability of Rule 56(3), unless those findings have become final after a decision of a Board of Appeal. Should the Examining Division come to the conclusion that the missing elements are not "completely contained" in the priority document, contrary to the original finding of the Receiving Section, it must communicate this to the applicant and, once it has been established that the right to be heard under Art. 113(1) has been observed, notify him of the new date of filing (see A-II, 5). The Examining Division must also inform the applicant that the missing drawings or parts of the description can still be withdrawn within two months from the date of notification of the new date of filing. If the applicant opts for withdrawal, the re-dating of the application will be deemed not to have been made (see also B-XII, 2.1 and 2.2). For Euro-PCT applications a review is possible under Rule 82ter PCT.

Art. 123(2)

If the claims were not present at the date of filing the application, the Examining Division must check whether the subsequently filed claims satisfy the requirements of Art. 123(2). If the basis for these subsequently filed claims in the application as filed has not been indicated by the applicant (see VI, 5.7) and the application is one of those mentioned in VI, 5.7.4, the Examining Division may send a communication according to Rule 137(4) requesting the applicant to provide this information (see VI, 5.7.1).

3.2 Response to the search opinion, PACE

Rule 137(2)
Rule 70(2)

Following receipt of the search report and search opinion, and prior to the first communication from the examining division, the applicant must (subject to certain exceptions) respond to the search opinion, by filing amendments to the description, claims or drawings and/or filing his observations on the objections raised in the search opinion (see B-XII, 9 for details). These amendments may be submitted to overcome the objections raised in the search opinion or they may be suggested for some other reason, e.g. to remedy some obscurity which the applicant himself has noted in the original documents. In order to avoid delays, care should be taken to comply with the requirements of Rule 137(4) when filing such amendments.

With a written request for accelerated examination under the programme for accelerated prosecution of European patent applications (PACE), the applicant can speed up the proceedings at

the examination stage (see Notice from the EPO dated 14 July 2007, Special edition No. 3, OJ EPO 2007, F.1 and E-VIII, 3).

3.3 Amendments by the applicant following the EESR and made of his own volition

Rule 137(2)

The amendments referred to in VI, 3.2 are made by the applicant "of his own volition" (the applicant is required to respond to the search opinion in the EESR, but does not necessarily have to respond by filing amendments; he can also respond by filing observations on the search opinion – see B-XII, 9). This means that the applicant is not restricted to amendment(s) necessary to remedy a defect in his application. It does not, however, mean that the applicant is free to amend in any way he chooses. Any amendment must satisfy the following conditions:

Art. 123(2)

(i) it must not add subject-matter to the content of the application as filed (see VI, 5.3 to 5.3.11); and

(ii) it must not itself cause the application as amended to be objectionable under the EPC, e.g. the amendment must not introduce obscurity.

If the amendments do not meet these conditions, the applicant should be told that the amended application cannot be allowed. Apart from the amendments referred to above, which are admissible under Rule 137(2), the applicant may correct obvious errors at any time (see VI, 5.4).

If amendments were made and these have not been identified and/or their basis in the application as filed not indicated by the applicant (see VI, 5.7) and the application is one of those mentioned in VI, 5.7.4, the Examining Division may send a communication according to Rule 137(4) requesting the applicant to provide this information (see VI, 5.7.1).

3.4 Unity of invention

Art. 82

An objection of lack of unity of invention, if applicable, should already have been raised at the search stage. If such an objection was not raised, but the Examining Division nevertheless considers that the requirements of Art. 82 are not met, the question of lack of unity will be addressed as early as possible during examination. If the applicant has paid further search fees in response to an invitation of the Search Division under Rule 64(1) and has requested a refund of these, the Examining Division will have to reconsider the matter (see also III, 7.9 to 7.11).

If the applicant has not responded to the above-mentioned invitation of the Search Division to pay a further search fee in respect of certain subject-matter, it must nevertheless be taken into account that the final responsibility for establishing whether the application meets the requirement of unity of invention ultimately rests with the Examining Division (T 631/97, OJ 1/2001, 13). In the absence of a convincing

response to an objection of lack of unity raised in the search opinion (see B-XII, 9), the Examining Division will normally uphold the position taken therein (see III, 7.10 and B-XII, 1.2) and the examination will proceed only for the invention which has been the subject of the search and the applicant will have to limit the application to that subject-matter by excising those parts which relate to the non-searched subject-matter (see G 2/92, OJ 10/1993, 591). The applicant may, however, file a divisional application for that subject-matter.

If the applicant has responded to the above-mentioned invitation to pay further search fees, he will be invited at the beginning of the substantive examination to state, if he has not yet done so, on which invention the prosecution of the application should be based and to limit the application accordingly by excising those parts belonging to the other inventions. For the latter, the applicant may file divisional applications. *Rule 36*

The filing of a divisional application is subject to the proviso that this is only possible if, when a divisional application is filed, the application being divided is still pending (see A-IV, 1.1.1.1) and at least one of the periods provided for under Rule 36(1)(a) and (b) has not yet expired (see A-IV, 1.1.1.2 and 1.1.1.3).

3.5 First communication

If no search opinion has been issued (see 1.1.2 above, III, 7.11.1(ii) and B-XII, 1.1), the examiner's first communication under Art. 94(3) will, as a general rule (see B-XII, 3), cover all objections to the application (but see B-XII, 3.4). These objections may relate to formal matters (e.g. failure to comply with one or more of the requirements specified in Rules 30 to 34, 41 to 43, 46 and 48 to 50), to substantive matters (e.g. the subject-matter of the application is not patentable), or to both.

Where the European or supplementary European search report was drawn up on or after 1 April 2010 and is accompanied by a search opinion (see B-XII, 1.1 and 8), the applicant is, subject to certain exceptions, required to respond to that search opinion (see B-XII, 9). *Rule 70a*

However, if deficiencies persist in the application even after the applicant has filed his response to the search opinion, the Examining Division will issue a communication according to Art. 94(3) and Rule 71(1), (2) in subsequent examination proceedings and will consider the applicant's reply thereto before issuing a decision or a summons to oral proceedings.

Consequently, if a search opinion according to Rule 62(1) has been issued and the European search report or supplementary European search report it accompanies was drawn up on or after 1 April 2010, the applicant will already have responded to it with either amendments and/or observations under Rule 70a (see B-XII, 9). If the European search report or supplementary European search report was *Art. 94(3) and (4)* *Rule 62(1)*

accompanied by a search opinion but was drawn up before 1 April 2010 and the applicant has not replied to it, a communication referring to the search opinion and setting a time limit for reply will be issued as the first communication under Art. 94(3). Failure to respond to this communication in due time will result in the application being deemed withdrawn according to Art. 94(4). The applicant's response to the search opinion required by Rule 70a (or filed voluntarily in response to search opinions accompanying search reports drawn up before 1 April 2010) will be taken into account by the Examining Division when drafting the first communication. Failure to respond to this communication in due time will result in the application being deemed withdrawn according to Art. 94(4) (with regard to what constitutes a valid response, see B-XII, 9).

3.5.1 Euro-PCT applications and reply to the WO-ISA/IPER

Rule 161

If the EPO acted as ISA and/or IPEA, a written opinion of the ISA (WO-ISA) and/or an international preliminary examination report (IPER) will already have been transmitted to the applicant during the PCT phase. For applications where a communication according to Rule 161 has not yet been issued by 1 April 2010 and where a supplementary European search report is not prepared (see B-II, 4.3), the applicant will be required to respond to the WO-ISA prepared by the EPO or, where applicable, to the IPER prepared by the EPO as IPEA unless amendments have already been filed which can be considered to be a reply (subject to certain requirements, see below). The time limit for response is one month from the invitation according to Rule 161(1) as in force from 1 April 2010. Failure to respond to the WO-ISA or IPER within this period leads to the application being deemed to be withdrawn according to Rule 161(1). In all cases, the latest filed request on file after expiry of the time limit according to Rule 161(1) will then be taken into account when drafting the first communication, provided that the application is not deemed to be withdrawn. In particular, the following situations may occur:

(i) If the applicant has filed new amendments and/or comments upon entry into the regional phase before the EPO, he will still be sent a communication according to Rule 161(1), but in this case he will not be required to respond to it (note, however, that if the requirements of Rule 137(4) were not fulfilled for amendments already filed, it is advisable to make the required indications in reply to the Rule 161(1) communication in order to avoid a further communication according to Rule 137(4)).

(ii) If the applicant filed amendments according to Art. 19 and/or 34 PCT in the international phase and these amendments are maintained on entry into the European phase, and if the EPO prepared the WO-ISA but no IPER (either because the applicant did not demand Chapter II or because the IPEA was an office other than the EPO), then these amendments are considered to constitute a response to the WO-ISA; the applicant will still be sent a communication according to Rule 161(1) in such cases,

but he will not be required to respond to it (note, however, that if the requirements of Rule 137(4) were not fulfilled for amendments already filed, it is advisable to make the required indications in reply to the Rule 161(1) communication in order to avoid a further communication according to Rule 137(4)).

(iii) Amendments filed under Art. 19 or 34 PCT which are taken into consideration in the drawing up of an IPER by the EPO acting as IPEA are not considered to constitute a response to the IPER as required by Rule 161(1); in these cases, the applicant is required to respond to the IPER within the one-month period according to Rule 161(1).

(iv) Where the WO-ISA or, where applicable, the IPER prepared by the EPO was positive (according to the same principles explained for European search opinions in B-XII, 3.9), the applicant is still sent a communication according to Rule 161(1), but is not required to respond to it.

(v) In cases where the Rule 161 communication was already issued before 1 April 2010, there is no requirement to respond to the WO-ISA prepared by the EPO or to the IPER prepared by the EPO as IPEA; if the applicant has not filed any amendments or comments upon entry into the regional phase before the EPO, the first communication will essentially be based on the content of said WO-ISA or IPER prepared by the EPO.

In cases (i), (ii) and (iv), where the applicant is not required to respond to the WO-ISA or IPER prepared by the EPO (in response to the invitation under Rule 161(1)), he *may* still do so by filing further amendments and/or comments if he so wishes. Once again it is advisable that the requirements of Rule 137(4) are fulfilled for any such amendments when they are filed, thus avoiding a further communication according to Rule 137(4).

Form 1200

In all cases it is important that the applicant clearly indicates on Form 1200 which documents are to form the basis for further prosecution of the application (for details relating to Form 1200, see E-IX, 5.1). Failure to make the appropriate indications on Form 1200 and/or provide copies and/or translations of the amended application documents as indicated below will result in the applicant being required to respond to the invitation according to Rule 161(1).

In particular:

In case (i), comments and/or amendments (the latter according to Rule 159(1)(b)) which are filed on entry into the European phase will be considered to constitute a response to the WO-ISA or the IPER only if the applicant indicates on Form 1200 that such amendments and/or comments are to form the basis for

further prosecution of the application and have been filed no later than the date of filing of Form 1200.

In case (ii), amendments filed in the international phase will be considered to be a response to the WO-ISA or the IPER only if the applicant indicates on Form 1200 that these amendments are maintained on entry into the European phase and also provides a translation thereof in the language of the proceedings, where necessary. Furthermore, a copy of the amendments under Art. 34 PCT (not made before the EPO as IPEA) would also be required no later than the date of filing of Form 1200.

Rule 137(4)

If the application is of one of the types mentioned in VI, 5.7.4 and if amendments which are to form the basis for further examination were filed either during the Rule 161(1) time limit or earlier, the requirements of Rule 137(4) must be complied with (the amendments must be identified and the basis for them in the application as filed indicated). If the applicant has not yet complied with these requirements on expiry of the time limit according to Rule 161(1), the Examining Division may request him to provide this information within a period of one month, by issuing a communication according to Rule 137(4). Failure to respond to this communication in time will lead to the application being deemed to be withdrawn (see VI, 5.7 and 5.7.1). The Examining Division may send a Rule 137(4) communication before sending a communication according to Art. 94(3) and Rule 71(1), (2) or Rule 71(3).

If deficiencies persist in the application even after the applicant has filed his response to the WO-ISA or IPER, the Examining Division will issue at least one communication according to Art. 94(3) and Rule 71(1), (2) in subsequent examination proceedings and will consider the applicant's reply thereto before issuing a decision or a summons to oral proceedings.

Where the application under consideration derives from an international application for which the EPO did not act as ISA, the application is subject to a supplementary European search under Art. 153(7) (see B-II, 4.3), and normally an EESR is issued accordingly (see B-XII, 1 and 2). The first communication is then issued as in 3.5 above.

3.6 Reasoned objections

For each objection the communication should indicate the part of the application which is deficient and the requirement of the EPC which is not met, either by referring to specific Articles or Rules, or by other clear indication; it should also give the reason for any objection where this is not immediately apparent. For example, where prior art is cited and only part of a cited document is relevant, the particular passage relied upon should be identified. If the cited prior art is such as to demonstrate lack of novelty or inventive step in the independent claim or claims, and if, consequently, there is lack of

unity between dependent claims (see III, 7.8), the applicant should be informed of this situation (see VI, 5.2(i)). Substantive matters should normally be set out first. The communication should be drafted in such a manner as to facilitate re-examination of the amended application and, in particular, to avoid the need for extensive rereading (see VI, 4.2).

3.7 Invitation to file comments and amendments

Rule 71(1)
Art. 94(3) and (4)

The communication should include an invitation to the applicant to file his observations, to correct any deficiencies and, if necessary, to submit amendments to the description, claims and drawings. It must also state the period within which the applicant must reply. Failure to reply in due time will cause the application to be deemed withdrawn (see E-VIII, 1).

4. Examination of replies

4.1 General procedure

Following the applicant's reply to the search opinion (see B-XII, 9), WO-ISA or IPER prepared by the EPO (see C-VI, 3.5.1) or to the first communication, the examiner must re-examine the application, taking into account observations or amendments made by the applicant.

Where the application is one of those mentioned in VI, 5.7.4, Rule 137(4) requires that any amendments made by the applicant in reply to the search opinion, WO-ISA or IPER be identified and their basis in the application as filed indicated. Failure to comply with this requirement may result in the Examining Division sending a communication according to Rule 137(4). For more details of the procedure, see VI, 5.7.1 and 5.7.2.

In the case of one or more subsidiary request(s) (sometimes referred to as "auxiliary requests") directed to alternative texts for grant of a patent, every such request qualifies as a text submitted or agreed by the applicant within the meaning of Art. 113(2) and therefore must be dealt with in the order indicated or agreed to by the applicant, up to and including the highest-ranking allowable request, if any (see also Legal Advice No. 15/05 (rev. 2), OJ 6/2005, 357, and 14.1 below). It is also to be noted that, for the types of application mentioned in VI, 5.7.4, Rule 137(4) must also be complied with in respect of auxiliary requests, which may also be subject to a communication according to Rule 137(4).

4.2 Extent of examination of replies

After the first examination stage, provided that the:

search opinion,

WO-ISA (when prepared by the EPO),

IPER (when prepared by the EPO), or

first communication (see B-XII, 1.1 and B-XII, 8)

was comprehensive and clear (see B-XII, 3, VI, 3.5 and 3.6), the examiner will not normally need to completely reread the application but rather should concentrate on the amendments themselves, the related passages, and the deficiencies previously noted.

4.3 Further action upon examination of replies

In most cases, the applicant will have tried to deal with all the examiner's objections (see B-XII, 9).

Art. 113(1)

If examination of the applicant's reply shows that despite his submissions objections persist, and provided that at least one communication has been sent in examination proceedings (see VI, 3.5 and 3.5.1) and the applicant has been given the right to be heard (Art. 113(1)), i.e. the decision is based solely on grounds on which he has had an opportunity to comment, the application is to be refused (T 201/98, not published in OJ).

If examination of the applicant's reply shows that he has not dealt with all the main objections in his reply, it may be appropriate to draw the deficiencies to his attention, e.g. by telephone. But if no positive reaction is to be expected, the examiner should consider recommending to the other members of the Examining Division that the application be refused immediately (again provided that at least one communication has been sent in examination proceedings).

In most cases, however, examination of the applicant's reply will show that there are good prospects of bringing the proceedings to a positive conclusion, i.e. in the form of a decision to grant. In such cases, if there are still objections to be met, the examiner must consider whether they can best be resolved by a further written communication, a telephone discussion or a personal interview. If substantial differences of opinion exist, the issues are generally best dealt with in writing. If, however, there seems to be confusion about points in dispute, e.g. the applicant seems to have misunderstood the examiner's arguments or the applicant's own arguments are unclear, then an interview may be useful. If, on the other hand, the matters to be resolved are minor, they can be settled more expeditiously over the telephone. Interviews or telephone discussions with the applicant or his representative are more fully considered in VI, 6. Telephone discussions or interviews do not constitute oral proceedings (see E-III).

4.4 Later stages of examination

Similar considerations apply to later stages of examination on the understanding that, having regard to the principle stated in VI, 2.4, the greater the number of actions which have already taken place, the greater is the likelihood that the most appropriate action is to refer the application to the other members of the Examining Division for a

decision. Where this decision is to refuse the application, particular care should be taken to ensure that the decision does not offend against Art. 113(1).

4.5 Decision according to the state of the file

A special case is where the applicant does not file comments or amendments in reply to the examiner's communication but requests a decision "according to the state of the file" or "on the file as it stands", meaning that the applicant wishes to close the debate and a decision is taken on the basis of the current status of the application and any supporting arguments. The decision, which may be appealed, may only be based on grounds and evidence on which the applicant has had an opportunity to present his comments (Art. 113(1)). The decision will be of a standard form, simply referring to the previous communication(s) for its grounds and to the request of the applicant for such a decision (see also E-X, 4.4).

4.6 Examination of amendments

Any amendment must satisfy the conditions listed in VI, 3.3. When it was effected must also be established.

4.7 Admissibility of amendments made by the applicant

Rule 137(2) and (3)

After receiving the European search report and the search opinion, the applicant must respond to the search opinion (see B-XII, 9) and may, in his reply and of his own volition, amend the description, claims and drawings (see VI, 3.2 and VI, 3.3). Likewise, for applications for which no supplementary European search report is prepared (see B-II, 4.3) when entering the European phase from the PCT, the applicant is required to respond to the WO-ISA or the IPER, where the ISA and, if applicable, the IPEA was the EPO (see VI, 3.5.1). This response to the WO-ISA or IPER may include amendments made by the applicant of his own volition to the description, claims and drawings. Thereafter, the applicant may amend the application only with the consent of the Examining Division.

For applications:

Rule 71(1)

(i) for which no search opinion is prepared (see B-XII, 1.1 and B-XII, 8),

(ii) for which a search opinion was prepared, but where the search report was drawn up before 1 April 2010 (in which case Rule 70a does not apply and the applicant is not required to respond to the search opinion), or

(iii) which enter the European phase from the PCT, where the EPO was the ISA and prepared a written opinion, but for which a communication under Rule 161 was already issued before 1 April 2010,

it is after receipt of the first communication from the examiner in examination proceedings that the applicant may "of his own volition, amend once the description, claims and drawings". provided that the amendment is filed at the same time as his reply.

Rule 137(3)

Subsequent to the above, the applicant may amend only if the examiner consents to the amendments proposed. Giving the Examining Division this discretion is intended to ensure that the examination procedure is brought to a conclusion in as few actions as possible (see VI, 2.4). If an amendment is admissible, subsequent proceedings are based on the description, claims and drawings as amended. Consent to an amendment does not necessarily imply that the application as amended is free from any objection under the EPC. Distinctions should be drawn between different types of amendments.

Art. 94(3)

Amendments remedying a deficiency in response to the preceding communication must always be admitted, provided they do not give rise to some new deficiency. Amendments limiting a claim which is already considered allowable should normally be admitted. The same applies to amendments improving the clarity of the description or claims in a manner clearly desirable.

A further factor is the amount of alteration to the application documents involved. Extensive reworking of the description or claims may be a proper response to highly relevant further prior art of which the applicant has only just become aware (e.g. either through further citation by the examiner or through knowledge obtained from another source). Regarding less extensive amendments, the examiner should adopt a reasonable approach, trying to balance fairness to the applicant against the need to avoid unnecessary delay and excessive and unjustified additional work for the EPO. Any subsequent request to withdraw an amendment is itself a request for further amendment; thus, if this subsequent request occurs after reply to the first communication from the examiner, the corresponding amendment will be admitted only if the examiner consents. In exercising his discretion under Rule 137(3), the examiner should bear in mind the length of the proceedings to date and whether the applicant has already had sufficient opportunity for amendments. He should refuse in particular amendments reintroducing deficiencies previously pointed out to and removed by the applicant.

Additional reasons for not admitting amendments according to Rule 137(3) include the non-admittance of:

one or more requests where auxiliary requests are filed (see VI, 5.7.1, last paragraph), and

a request filed in, or in preparation for, oral proceedings (see VI, 5.7.3),

where this is for reasons of procedural economy (taking into account the applicant's right to comment according to Art. 113(1)), where Rule 137(4) is not complied with in respect of the request in question.

In deleting subject-matter from an application, the applicant should avoid any statement which could be interpreted as abandonment of that subject-matter. Otherwise the subject-matter cannot be reinstated.

Additional limitations on possible amendments of the application may apply if the European or supplementary European search report was a partial one due to Rule 63 or restricted in accordance with Rule 62a (see VI, 5.2 and 5.6). *Rule 62a* *Rule 63* *Rule 137(5)*

4.8 Examples of inadmissible amendments

Any request by an applicant to replace the text of the application on the basis of which a patent could be granted by a text that has been extensively revised should be refused, unless the applicant gives good reasons for proposing the changes only at this stage in the proceedings. This applies particularly in cases where the Examining Division has indicated that a version of the claims proposed by the applicant is grantable and that the applicant has only to bring the description into line with that version. *Rule 137(3)*

4.9 Amendments filed in reply to a communication under Rule 71(3)

The communication under Rule 71(3) (see VI, 2.5 and 14.1 to 14.3) does not constitute an opportunity for the applicant to call into question the outcome of the earlier procedure. At this stage of the proceedings, the substantive examination has already been completed and the applicant has had the opportunity to amend the application and therefore normally only those amendments which do not appreciably delay the preparations for grant of the patent will be admitted under Rule 137(3). It is, however, appropriate to admit separate sets of claims for one or more designated States that made a reservation under Art. 167(2) EPC 1973 (see III, 8.3) or for which prior national rights exist (see III, 8.4). *Rule 71(3)* *Rule 137(3)*

If, on reviewing the proposed text for grant, the applicant wishes to make minor amendments and/or corrections, he should file them, together with a translation of the claims as amended and/or corrected, and should pay the fee for grant and publishing within the period set under Rule 71(3), as required by Rule 71(4). If the amendments and/or corrections do not relate to the claims, then translations of the claims as in the communication under Rule 71(3) should be filed. Failure to file the translations or pay the fee within this time limit will result in the application being deemed withdrawn, in accordance with Rule 71(7). The three situations specified in VI, 14.4.1 in which this requirement does not apply (maintenance of a higher request, maintenance of the existing request without the amendments made by the Examining Division in the communication under Rule 71(3) and the issuing of the *Rule 71(4)*

communication under Rule 71(3) on the basis of the wrong documents) should be noted.

Rule 71(4)

If, under Rule 137(3), the Examining Division consents to the amendments and/or corrections and considers them allowable, it can immediately proceed to grant pursuant to Art. 97(1).

Rule 71(5)
Rule 137(3)
Art. 113(1)

If, however, a request for amendment is to be refused under Rule 137(3), the applicant must first in compliance with Rule 71(5) and Art. 113(1) be sent a communication giving the reasons for refusing the amendment and giving him the opportunity to either withdraw his request for amendment or submit his observations and any amendments considered necessary by the Examining Division and, where the claims are amended, a translation of the claims as amended.

Art. 97(2)
Art. 113(2)

If the applicant maintains his request for the amendment, and the Examining Division sees no reason to change its opinion not to consent to the amendments pursuant to Rule 137(3), the application must be refused under Art. 97(2), since, in these circumstances, there is no text of the application which has been agreed by the applicant and allowed by the Examining Division (Art. 113(2)).

Rule 137(3)

It should be noted that if no communication under Art. 94(3) has preceded the communication under Rule 71(3) and the application was one of the exceptional cases (i), (ii) or (iii) as mentioned in VI, 4.7, the applicant may amend the description, claims and drawings of his own volition (see VI, 3.3 for the conditions any amendment must satisfy). The provisions of Rule 71(4) concerning the filing of translations of the amended claims and payment of fees nonetheless still apply in this case, unless the applicant's response corresponds to one of the exceptions defined in VI, 14.4.1. In these circumstances however, if the Examining Division is of the opinion that the amendments are inadmissible or not allowable, then the examination procedure should normally be resumed in accordance with VI, 14.5. As in the cases referred to in VI, 4.11, if this leads to a version which meets the requirements of the EPC, a second communication under Rule 71(3) is issued. An exception to this procedure would be when the objections of the Examining Division are of a relatively minor nature, such that they could be resolved by means of a telephone conversation, in which case resumption of the examination procedure would be unnecessary.

Any amendments filed in reply to the communication according to Rule 71(3) must satisfy the requirements of Rule 137(4) by identifying the amendments and indicating the basis for them in the application as filed (see VI, 5.7). If these requirements are not met and the application is of one of the types mentioned in VI, 5.7.4, the Examining Division may send a communication according to Rule 137(4) (see VI, 5.7.1) before proceeding further (see VI, 14.4).

4.10 Further requests for amendment after approval

Rule 137(3)

Once the applicant has approved the text communicated to him pursuant to Rule 71(3), by paying the fees and filing the translation of the claims, possibly including minor amendments and/or corrections, further requests for amendment will only exceptionally be allowed under the discretionary power of the Examining Division given by Rule 137(3). A clear example of an allowable request is where the applicant files separate sets of claims for designated States that made reservations under Art. 167(2) EPC 1973 (see III, 8.3) or for which prior national rights exist (see III, 8.4). Similarly, it is appropriate to admit minor amendments which do not require re-opening of the substantive examination and which do not appreciably delay the issue of the decision to grant (see G 7/93, OJ 11/1994, 775). If these amendments involve changes to the claims, these should of course be accompanied by translations, as required by Rule 71(4).

Rule 140

However, once the decision to grant is handed over to the EPO's internal postal service for transmittal to the applicant, the Examining Division is bound by it (see G 12/91, OJ 5/1994, 285) and can only amend it to the limited extent provided for in Rule 140 (see E-X, 10).

4.11 Resumption of the examination proceedings

Paragraphs 4.9 and 4.10 above do not prevent the Examining Division from resuming the proceedings of its own motion where it becomes aware of circumstances which are such as to render non-patentable the subject-matter claimed. Such circumstances may be brought to the Examining Division's attention by the applicant or following observations by third parties under Art. 115 and can be considered up to the moment the decision is handed over to the EPO's internal postal service. In the resumed proceedings, substantive amendments to resolve this problem are possible. Where this leads to a version which meets the requirements of the EPC, a second communication under Rule 71(3) is issued, and 4.9 and 4.10 above apply again.

5. Amendments

5.1 Making amendments

The general considerations relating to the procedures for making amendments are set out in E-II.

5.2 Allowability of amendments

The question of allowability of amendments is legally a question of whether the application as so amended is allowable. An amended application must of course satisfy all the requirements of the EPC including, in particular, inventive step and the other matters listed in B-XII, 3.6 (see also VI, 3.3). Also, however, especially when the claims have been substantially limited, the examiner should bear in mind that the following questions may require special consideration at the amendment stage.

(i) Unity of invention

Do the amended claims still satisfy the requirements of Art. 82? If the search report seems to reveal lack of novelty or inventive step in the concept common to all the claims, but the amended claims do not necessitate further search, the examiner should consider carefully whether an objection of lack of unity is justified at this stage of the proceedings (see III, 7.7). If, however, the claims lack a common inventive concept and a further search is necessary, objection should be raised.

Rule 137(5)

(ii) Changing to unsearched subject-matter

If amended claims are directed to subject-matter which has not been searched (e.g. because it only appeared in the description and the Search Division did not find it appropriate to extend the search to this subject-matter, see B-III, 3.5) and which does not combine with the originally claimed and searched invention or group of inventions to form a single general inventive concept, such amendments are not admissible. This applies particularly when this unsearched subject-matter alone is now claimed, whereas it should not be applied if a feature originally disclosed in the description is added to an originally-filed claim in order to meet an objection, e.g. lack of novelty or inventive step, raised by the examiner. In the latter case, however, an additional search (see VI, 8.2) may be required.

However, where features taken from the description and pertaining to a different inventive concept than the original claim are added to the claim, an objection under Rule 137(5) may be raised. It may occur that the description of the application contains a further general inventive concept, distinct from that underlying the main claim and its dependent claims, if any, but not clearly identified or declared as such in the description. In such a case, if the subject-matter of the main claim based on the first inventive concept is amended, any amendment of the claim pertaining exclusively to said further inventive concept could justify an objection of lack of unity "*a posteriori*" (see T 1394/04). An objection under Rule 137(5) may arise if a technical feature taken from the description, which has an effect unrelated to the effect(s) of the originally claimed invention(s), is added to a claim not reflecting an originally claimed invention.

Furthermore, amended claims may not relate to subject-matter which was not searched in accordance with Rules 62a or 63 (see B-VIII, 3.1, 3.2, 4.1 and 4.2).

Thus, if an objection under Rule 137(5) is to be raised, the applicant should be informed that he may continue to pursue such subject-matter only in the form of a divisional application under Art. 76, provided that at least one of the periods provided for in Rule 36(1)(a) and (b) has not yet expired (see A-IV, 1.1.1, 1.1.1.2 and 1.1.1.3).

If a communication from the Examining Division does not raise an objection as to lack of unity under Art. 82, but rather raises an objection

as to the admissibility of an amendment according to Rule 137(5), this does not cause the period for the filing of a divisional application according to Rule 36(1)(b) to start, or to start again if a unity objection has been raised before in examination proceedings (see A-IV, 1.1.1.3). Consequently, in such a case, if the period provided for in Rule 36(1)(a) has already expired and, if a unity objection has been raised before in examination proceedings, the period provided for under Rule 36(1)(b) has also expired, it will not be possible for the applicant to file a divisional application. If no such objection under Rule 137(5) is raised, the Examining Division should consider performing an additional search (see VI, 8.2).

However, applicants should bear in mind that the examining procedure should be brought to a conclusion in as few actions as possible. So the Examining Division may exercise its right not to admit further amendments under Rule 137(3) (see VI, 4.7).

(iii) Agreement of description and claims

If the claims have been amended, will the description require corresponding amendment to remove serious inconsistency between them? For example, is every embodiment of the invention described still within the scope of one or more claims? (see III, 4.3). Conversely, are all of the amended claims supported by the description? (see III, 6). Also, if the categories of claims have been altered, will the title require corresponding amendment? It is important also to ensure that no amendment adds to the content of the application as filed and thus offends against Art. 123(2), as explained in the following paragraphs.

5.3 Additional subject-matter

Art. 123(2)

There is normally no objection to an applicant introducing, by amendment, further information regarding prior art which is relevant; indeed this may be required by the examiner (see II, 4.3 and 4.19). Nor will the straightforward clarification of an obscurity or the resolution of an inconsistency be objected to. If, however, the applicant seeks to amend the description (other than references to the prior art), the drawings or the claims in such a way that subject-matter which extends beyond the content of the application as filed is thereby introduced, the application as so amended cannot be allowed.

5.3.1 Basic principle; priority document

The underlying idea of Art. 123(2) is that an applicant is not allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application (see G 1/93, OJ 8/1994, 541). An amendment should be regarded as introducing subject-matter which extends beyond the content of the application as filed, and therefore unallowable, if the overall change in the content of the application (whether by way of addition, alteration or excision) results in the skilled person being presented with information which is not directly and

unambiguously derivable from that previously presented by the application, even when account is taken of matter which is implicit to a person skilled in the art. At least where the amendment is by way of addition, the test for its allowability normally corresponds to the test for novelty given in IV, 9.2 (see T 201/83, OJ 10/1984, 481).

Under Art. 123(2) it is impermissible to add to a European application matter present only in the priority document for that application (see T 260/85, OJ 4/1989, 105). For correction of errors, see VI, 5.4.

Rule 56

The procedure under Rule 56 allows the applicant to file missing drawings or parts of the description subsequently, and to rely on the priority document in order to avoid re-dating of the application to the date of filing of the missing parts. Under Rule 56(3), re-dating is only avoided where the missing parts were “completely contained” in the priority document (see VI, 3.1 and A-III, 5). The provisions of Rule 56(3) apply only to the filing stage of the application, without further implications: in particular, it is not permissible at later stages of the procedure to rely on the priority documents to correct or amend the application as filed (in keeping with G 3/89 and G 11/91, OJ 3/1993, 117 and 125, respectively). For Euro-PCT applications a review is possible under Rule 82ter PCT.

5.3.2 Examples

For example, if an application relates to a rubber composition comprising several ingredients and the applicant seeks to introduce the information that a further ingredient may be added, then this amendment should normally be objected to as offending against Art. 123(2).

A new range that is based on the combination of the lower limit of the general range with the lower limit of the preferred range, thus excluding the preferred range, may be acceptable (see T 1170/02).

In an application which describes and claims apparatus "mounted on resilient supports", without disclosing any particular kind of resilient support, objection should be raised if the applicant seeks to add the specific information that the supports are, or could be, e.g. helical springs.

If, however, the applicant were able to demonstrate that the drawings, as interpreted by the skilled person, show helical springs, the specific mention of helical springs would be allowable.

However, care should be taken when amendments are based on details which may only be derived from the schematic drawings of the original application. The manner in which a particular feature is depicted in the drawings may be accidental. In such cases, the skilled person must be able to clearly and unmistakably recognise from the drawings, in the context of the whole description, that the added feature is the deliberate result of the technical considerations directed

to the solution of the technical problem involved. For example, the drawings may depict a vehicle in which approximately two thirds of the height of the engine is located below a plane tangent to the top of the wheels. An amendment which defines that the major portion of the engine is located below the given level would not infringe Art. 123(2) if the skilled person would recognise that such a spatial arrangement of the engine with respect to the wheels is in fact a deliberate measure directed to the solution of the technical problem (see T 398/00).

5.3.3 Clarification of a technical effect

Where a technical feature was clearly disclosed in the original application but its effect was not mentioned or not mentioned fully, yet it can be deduced without difficulty by a person skilled in the art from the application as filed, subsequent clarification of that effect in the description does not contravene Art. 123(2).

5.3.4 Introduction of further examples and new effects

Amendment by the introduction of further examples should always be looked at very carefully in the light of the general considerations outlined in paragraphs VI, 5.3 to 5.3.3. The same applies to the introduction of statements of new (i.e. previously not mentioned) effects of the invention such as new technical advantages. For example, if the invention as originally presented related to a process for cleaning woollen clothing consisting of treating the clothing with a particular fluid, the applicant should not be allowed to introduce later into the description a statement that the process also has the advantage of protecting the clothing against moth damage.

Art. 123(2)

5.3.5 Evidence

Under certain circumstances, however, later filed examples or new effects, even if not allowed into the application, may nevertheless be taken into account by the examiner as evidence in support of the patentability of the claimed invention. For instance, an additional example may be accepted as evidence that the invention can be readily applied, on the basis of the information given in the originally filed application, over the whole field claimed (see III, 6.3). Similarly a new effect (e.g. the one mentioned in VI, 5.3.4) may be considered as evidence in support of inventive step, provided that this new effect is implied by or at least related to an effect disclosed in the originally filed application (see IV, 11.10).

Art. 123(2)

5.3.6 Supplementary technical information

Any supplementary technical information submitted after the filing date of the application will be added to the part of the file which is open to public inspection, unless excluded from public inspection pursuant to Rule 144(d). From the date on which the information is added to the open part of the file, it forms part of the state of the art within the meaning of Art. 54(2). In order to notify the public of the existence of such information submitted after the application was filed and not included in the specification, an appropriate mention will be printed on the cover page of the patent specification.

5.3.7 Revision of stated technical problem

Care must also be taken to ensure that any amendment to, or subsequent insertion of, a statement of the technical problem solved by the invention meets Art. 123(2). For example it may happen that following restriction of the claims to meet an objection of lack of inventive step, it is desired to revise the stated problem to emphasise an effect attainable by the thus restricted invention but not by the prior art. It must be remembered that such revision is only permissible if the effect emphasised is one deducible by a person skilled in the art without difficulty from the application as filed (see 5.3.3 and 5.3.4 above).

5.3.8 Reference document

Features which are not disclosed in the description of the invention as originally filed but which are only described in a cross-referenced document which is identified in such description are prima facie not within "the content of the application as filed" for the purpose of Art. 123(2). It is only under particular conditions that such features can be introduced by way of amendment into the claims of an application.

Such an amendment would not contravene Art. 123(2) if the description of the invention as originally filed leaves no doubt to a skilled reader (see T 689/90, OJ 10/1993, 616) that:

(i) protection is or may be sought for such features;

(ii) such features contribute to solving the technical problem underlying the invention;

(iii) such features at least implicitly clearly belong to the description of the invention contained in the application as filed (Art. 78(1)(b)) and thus to the content of the application as filed (Art. 123(2)); and

(iv) such features are precisely defined and identifiable within the disclosure of the reference document.

Moreover, documents not available to the public on the date of filing of the application can only be considered if (see T 737/90, not published in OJ):

(i) a copy of the document was available to the EPO on or before the date of filing of the application; and

(ii) the document was made available to the public no later than on the date of publication of the application under Art. 93 (e.g. by being present in the application dossier and therefore made public under Art. 128(4)).

5.3.9 Alteration, excision or addition of text

Alteration or excision of the text, as well as the addition of further text, may introduce fresh subject-matter. For instance, suppose an invention related to a multi-layer laminated panel, and the description included several examples of different layered arrangements, one of these having an outer layer of polyethylene; amendment of this example either to alter the outer layer to polypropylene or to omit this layer altogether would not normally be allowable. In each case, the panel disclosed by the amendment example would be quite different from that originally disclosed and, hence, the amendment would introduce fresh subject-matter and therefore be unallowable.

5.3.10 Replacement or removal of a feature from a claim

The replacement or removal of a feature from a claim does not violate Art. 123(2) if the skilled person would directly and unambiguously recognise that:

(i) the feature was not explained as essential in the disclosure;

(ii) the feature is not, as such, indispensable for the function of the invention in the light of the technical problem the invention serves to solve; and

(iii) the replacement or removal requires no real modification of other features to compensate for the change.

In case of a replacement by another feature, the replacing feature must of course find support in the original application documents, so as not to contravene Art. 123(2) (see T 331/87, OJ 1-2/1991, 22).

5.3.11 Disclaimers not disclosed in the application as filed

Limiting the scope of a claim by using a "disclaimer" to exclude a technical feature not disclosed in the application as filed does not infringe Art. 123(2) in the following cases (see G 1/03, OJ 8-9/2004, 413, and G 2/03, OJ 8-9/2004, 448, and III, 4.20):

(i) restoring novelty over a **disclosure under Art. 54(3);**

(ii) restoring novelty over an **accidental anticipation** under Art. 54(2). "An anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention". The status of "accidental" should be ascertained without looking at the available further state of the art. A related document does not become an accidental anticipation merely because there are other disclosures even more closely related. The fact that a document is not considered to be the closest prior art is insufficient for achieving the status of "accidental". An accidental disclosure has nothing to do with the teaching of the claimed invention, since it is not relevant for examining inventive step. For example, this is the case when the

same compounds serve as starting materials in entirely different reactions yielding different end products (see T 298/01, not published in OJ). A prior art, the teaching of which leads away from the invention, however, does not constitute an accidental anticipation; the fact that the novelty destroying disclosure is a comparative example is also insufficient for achieving the status of “accidental” (see T 14/01 and T 1146/01, both not published in OJ);

(iii) removing subject-matter which, under Art. 52 to Art. 57, is excluded from patentability for **non-technical reasons**. For example, the insertion of "non-human" in order to satisfy the requirements of Art. 53(a) is allowable.

However, an undisclosed disclaimer is **not** allowable if:

(i) it is made in order to exclude **non-working embodiments** or remedy **insufficient disclosure**;

(ii) it makes a **technical contribution**.

An undisclosed disclaimer is, **in particular**, **not** allowable in the following situations:

(i) the limitation is relevant for assessing inventive step;

(ii) the disclaimer, which would otherwise be allowable on the basis of a conflicting application alone (Art. 54(3)), renders the invention novel or inventive over a separate prior art document under Art. 54(2), which is a **not accidental** anticipation of the claimed invention;

(iii) the disclaimer based on a conflicting application removes also a deficiency under Art. 83;

A disclaimer should remove no more than is necessary either to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons. A claim containing a disclaimer must meet the clarity and conciseness requirements of Art. 84. In the interest of the patent's transparency, the excluded prior art should be indicated in the description in accordance with Rule 42(1)(b) and the relation between the prior art and the disclaimer should be shown.

5.4 Correction of errors

Rule 139
Art. 123(2)

Correction of errors is a special case involving an amendment, therefore the requirements of Art. 123(2) apply likewise.

Linguistic errors, errors of transcription and other mistakes in any document filed with the EPO may be corrected at any time. However, where the mistake is in the description, claims or drawings, both the

error and the correction must be such that it is immediately evident (at least once attention is directed to the matter):

(i) that an error has occurred; and

(ii) what the correction should be.

Regarding (i), the incorrect information must be objectively recognisable for a skilled person, using common general knowledge, from the originally-filed application documents (description, claims and drawings) taken by themselves.

Regarding (ii), the correction should be within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the originally-filed application documents.

Evidence of what was common general knowledge on the date of filing may be furnished in any suitable form.

The priority documents cannot be used for the purposes mentioned under (i) and (ii) above (see G 3/89 and G 11/91, OJ 3/1993, 117 and 125, respectively).

Correction under Rule 139, second sentence, is of a strictly declaratory nature and establishes what a skilled person, using common general knowledge, would already derive on the date of filing from the parts of a European patent application, seen as a whole, relating to the disclosure (see G 3/89 and G 11/91 mentioned above). Therefore, the complete replacement of the application documents (i.e. description, claims and drawings) by other documents is not possible (see G 2/95, OJ 10/1996, 555).

Such requests for correction can only be considered until such time as the decision to grant a patent or to refuse the application has been handed over to the EPO's internal postal service, for transmittal to the applicant (in written proceedings) or has been pronounced in oral proceedings (see G 12/91, OJ 5/1994, 285).

5.5 Plural forms of amendment

Rule 138

A situation may arise in which, as a result of amendment, the application has two or more distinct sets of claims (see IV, 7.1.1 and III, 8.1).

In examining the sets of claims referred to above, it will generally be found expedient to deal with each one quite separately, especially where the difference between them is substantial. The communication to the applicant will thus be divided into two or more parts, and the aim will be to have each set of claims, together with the description and drawings, brought into a state where it is in order to proceed to grant.

If the examiner considers that the description and drawings are so inconsistent with either set of claims as to create confusion, he should require the applicant to amend the description and drawings to remedy this. If the applicant voluntarily proposes such amendment the examiner should admit it only if he considers it necessary.

Hence this type of application will, after amendment, either consist of two or more distinct sets of claims each supported by the same description and drawings, or two or more sets of claims each supported by different descriptions and drawings.

Rule 18(2) A similar situation may arise where a final decision on entitlement to the grant of a European patent applies to only some of the States designated in the application (see VI, 9.2.4).

5.6 Rule 62a and/or Rule 63 cases

Rule 63(3) Where the search was limited to certain subject-matter by application of Rule 63 (see B-VIII, 3.1 and 3.2), the claims must be amended in such a way as to remove the unsearched subject-matter and the description adapted accordingly.

Rule 62a(2) Where the search was limited to certain claims by application of Rule 62a (see B-VIII, 4.1 and 4.2), the claims must be amended in such a way as to remove the unsearched independent claims and the description adapted accordingly. To this end, the claims may be amended, for example, by deleting an unsearched independent claim or, where this complies with Art. 123(2) and Art. 84, by making an unsearched independent claim dependent on another independent claim of the same category which *has* been searched.

In both of these cases, a specific amendment is necessary, unless the applicant can convincingly argue that the invitation sent under Rule 62a(1) and/or Rule 63(1) was not justified.

Rule 137(5) Furthermore, amended claims may not relate to subject-matter not searched in accordance with Rule 62a or 63. Consequently, the presence of this subject-matter in the description cannot be used as a basis for its re-introduction into the claims.

5.7 Indication of amendments and their basis under Rule 137(4)

Rule 137(4) When filing amendments, the applicant must identify them and indicate the basis for them in the application as filed. The requirement that the basis for amendments be indicated is met if, on consulting those parts of the application indicated, it is not necessary to look further in order to assess the amendment's compliance with Art. 123(2). Non-specific indications such as "see the description as filed" or "see the claims as filed" or "see the examples as filed" are generally not considered sufficient. This requirement also applies in cases where the applicant requests the Examining Division to amend his application (see E-II, 3).

Whether the requirements of Rule 137(4) are met is assessed independently of whether the amendments in question comply with Art. 123(2). For example, the applicant may indicate that a particular amendment is based on a technical feature disclosed only in a schematic drawing. If the feature supposedly forming the basis for the amendment is indeed disclosed in the drawing indicated by the applicant, the requirements of Rule 137(4) are met, irrespective of whether the amendment based on that technical feature is allowable according to Art. 123(2) (see VI, 5.3.2).

Where the application was not filed in an official language of the EPO, in the absence of evidence to the contrary, for the purpose of assessing compliance with Art. 123(2) the EPO assumes that any translation of the application as filed is accurate. Consequently, in order to comply with Rule 137(4) it is sufficient to indicate the basis of an amendment in the translation of the application as filed. *Rule 7*

5.7.1 Rule 137(4) communication and response thereto

If the Examining Division notes a failure to meet either requirement of Rule 137(4), it may issue a communication requesting the correction of this deficiency within a period of one month. The amendments in respect of which such a communication may be sent include, *inter alia*: *Rule 137(4)*

(i) claims filed after the date of filing under Rule 58 (see A-III, 15)

(ii) amendments filed before entry into the European phase from the PCT under Art. 19 and/or 34 PCT (see VI, 3.5.1)

(iii) amendments filed on entry into the European phase from the PCT under Rule 159(1)(b) (see VI, 3.5.1)

(iv) amendments filed after entry into the European phase from the PCT under Rule 161(1) or (2) (see VI, 3.5.1)

(v) amendments filed in response to the search opinion (see B-XII, 9)

(vi) amendments filed during the examination procedure (see, however, VI, 5.7.3), including those filed after the communication according to Rule 71(3) (see VI, 4.9).

Such a communication can only be sent in respect of amendments which are part of a current request. It cannot relate to amendments which have since been withdrawn or superseded.

If the applicant fails to comply with this requirement within the above-mentioned period of one month, the application is deemed to be withdrawn due to the applicant's failure to reply to this communication from the Examining Division. The applicant may request further processing for failure to observe this time limit (see E-VIII, 2.1). *Art. 94(4)*

If the amendments are filed in response to a communication according to Rule 71(3) and the requirements of Rule 137(4) are not satisfied in respect of them, the Examining Division may send a Rule 137(4) communication. Thereafter, if the applicant replies in time, the Examining Division will then decide whether to admit the amendments (see VI, 14.4).

Where auxiliary requests are filed, a Rule 137(4) communication may also be sent in respect of one or more of the main and/or auxiliary requests. Alternatively, where Rule 137(4) is not complied with in respect of a specific request (main or auxiliary), this request may, for reasons of procedural economy and taking into account the applicant's right to be heard in accordance with Art. 113(1), be deemed inadmissible according to Rule 137(3).

5.7.2 Amendments withdrawn or superseded in the Rule 137(4) period

If the applicant replies in time to the Rule 137(4) communication by withdrawing the amendments in respect of which the communication was sent but without identifying those amendments or indicating their basis in the application as filed, then no loss of rights will occur according to Rule 137(4). However, where objections are thereby re-introduced into the application, this may result in the amendments being deemed to be inadmissible according to Rule 137(3) (see VI, 4.7).

No further Rule 137(4) communication will be sent in respect of further amendments filed in a timely response to the Rule 137(4) communication. By the expiry of the one-month period, the applicant must have identified and indicated the basis of:

(i) amendments in respect of which the Rule 137(4) communication was sent and which are not superseded by further amendments filed during the one-month period under Rule 137(4), and

(ii) amendments filed during that one-month period.

The applicant does not need to comply with Rule 137(4) in respect of amendments which are superseded by further amendments filed in the one-month period. For example:

03.06.2010	Application filed: 10 claims
25.03.2011	Extended European search report drawn up
21.08.2013	Amended claims 1-10 filed in examination proceedings, no basis indicated
03.09.2013	Examining Division sends a Rule 137(4) communication in respect of amended claims 1-10 filed on 21.08.2013
07.10.2013	Amended claims 6-10 filed
14.10.2013	One-month period under Rule 137(4)

expires

In the above example, the applicant must, by expiry of the one-month period according to Rule 137(4) on 14.10.2013, indicate the basis for amended claims 1-5 as filed on 21.08.2013 and for amended claims 6-10 as filed on 07.10.2013, and failure to do so results in the application being deemed to be withdrawn according to Art. 94(4). It is not necessary for the applicant to indicate the basis for the superseded amendments to claims 6-10 filed on 21.08.2013. Note in particular that, where the basis for the amendments to claims 6-10 filed on 07.10.2013 is not indicated by 14.10.2013, then no further Rule 137(4) communication is sent in respect of these amendments and the application is deemed to be withdrawn on expiry of the one-month period on 14.10.2013.

5.7.3 Rule 137(4) and oral proceedings

A Rule 137(4) communication will not be sent where the amendments in question are filed during oral proceedings. Nonetheless, it is a requirement of Rule 137(4) that amendments and their basis be identified. If the applicant fails to fulfil this requirement in respect of amendments filed during oral proceedings, the amendments may, for reasons of procedural economy and taking into account the applicant's right to be heard in accordance with Art. 113(1), be rejected as inadmissible by the Examining Division, exercising its discretion under Rule 137(3).

Amendments filed in preparation for oral proceedings in response to the summons thereto according to Rule 116(2) will be dealt with in those oral proceedings as indicated above. However, if the oral proceedings are cancelled or the applicant does not attend and the procedure is continued in writing after the oral proceedings are held in his absence, a Rule 137(4) communication may be sent by the Examining Division in respect of those amendments.

5.7.4 Transitional provisions relating to Rule 137(4)

The above procedure applies to the following applications (see Art. 2(2) of the Decision of the Administrative Council of 25 March 2009, OJ EPO 5/2009, 299):

(i) European applications for which the search report is drawn up on or after 1 April 2010,

(ii) Euro-PCT applications for which the supplementary European search report is drawn up on or after 1 April 2010, and

(iii) Euro-PCT applications for which the international search report is drawn up by the EPO acting as International Searching Authority on or after 1 April 2010 (Art. 153(6)).

6. Discussion with the applicant

6.1 General remark

In this section the term "applicant" is intended to mean "representative" where he has appointed one. Where the applicant has appointed a representative, the communication should be with that representative.

6.2 Telephone conversation, personal interview

The circumstances in which it may be appropriate for the examiner to communicate with the applicant by telephone or propose an interview rather than send a further written action are considered in VI, 4.3. If the applicant requests an interview, the request should be granted unless the examiner believes that no useful purpose would be served by such a discussion. With regard to the issue of telephone conversations and personal interviews in response to the EESR, before the application has entered the examination phase, see B-XII, 9.

When an interview is arranged, whether by telephone or in writing, and whether by the examiner or the applicant, the matters for discussion should be stated. If the arrangement is made by telephone, the examiner should record the particulars and briefly indicate, in the file, the matters to be discussed.

The interview will normally be conducted solely by the examiner dealing with the application. It is not a formal procedure (for formal oral proceedings before the Examining Division, see E-III), and the minuting of the interview depends upon the nature of the matters under discussion. Where the interview is concerned with the clarification of obscurities, the resolution of uncertainties, or putting the application in order by clearing up a number of minor points it will usually be sufficient if the examiner makes a note in the minutes of the matters discussed and the conclusions reached or amendments agreed. If, however, the interview is concerned with resolving weightier matters, such as questions of novelty, inventive step, unity or whether the amendment introduces fresh subject-matter, then a fuller note of the matters discussed should be made in the minutes. It should always be made clear to the applicant that any agreement reached must ultimately be subject to the views of the other members of the Examining Division.

If a fresh objection of substance is raised at an interview and no amendment to meet it is agreed at the time, the objection must be confirmed by a communication of the minutes thereof, giving the applicant a fresh period within which to reply..

When the telephone is used to settle outstanding matters, the normal procedure should be for the examiner to telephone the applicant stating the number of the application he wishes to discuss and requesting the applicant to telephone back at a specified time. A note must be made in the minutes, giving particulars and identifying the matters discussed and any agreements reached. Any matters on

which agreement was not reached should also be noted and the arguments adduced by the applicant should be summarised.

The minutes of interviews or telephone conversations should always indicate whether the next action is due to come from the applicant or the examiner. The minutes when dispatched to the applicant may:

(i) be dispatched for information only, in which case if a time limit is still running, it should be observed; if no time limit is running, no action is required from the applicant;

(ii) be dispatched such as to extend a running time limit, in which case the applicant must reply within that extended time limit, or

(iii) be dispatched such as to set a new time limit for response, in which case the applicant must reply within this new time limit.

7. Work within the Examining Division

7.1 General remarks

As stated in VI, 1.3, the examiner may seek the advice of other members of the Examining Division, if necessary, at any stage in the examination. However, a point will be reached when it becomes appropriate for the examiner to refer the case formally to the other members of the Examining Division. This will arise if he considers the case is in order to proceed to grant or, alternatively, where there seems no possibility of amendment which would overcome his objections or where the applicant has not overcome these objections, and the examiner considers the case is in order to proceed to refusal. There are also other circumstances in which reference to the Examining Division is appropriate, e.g. oral proceedings may be suggested by the examiner or requested by the applicant because an impasse has been reached. In considering whether to refer the application to the Division, the examiner should be guided by the principle stated in VI, 2.4.

7.2 Recommendation to grant

If the examiner considers that the application satisfies the requirements of the EPC and is thus in order to proceed to grant, he should make a brief written report (the "votum"). As a general rule, it will be appropriate in this report for the examiner to give the reasons why, in his opinion, the subject-matter as claimed in the application is not obvious having regard to the state of the art. He should normally comment on the document reflecting the nearest prior art and the features of the claimed invention which make it patentable, although there may be exceptional circumstances where this is not necessary, e.g. where patentability is based on a surprising effect. He should also indicate how any apparently obscure but important points have ultimately been clarified, and if there are any borderline questions which the examiner has resolved in favour of the applicant he should draw attention specifically to these.

7.3 Recommendation to refuse

When referring to the Examining Division an application which is not in order for grant of a patent, the examiner should make a written report which sets out the points at issue, summarises the case history to the extent necessary to enable the other members to obtain a quick grasp of the essential facts, and recommends the action to be taken, e.g. refusal, or grant conditional upon certain further amendments. As the other members will need to study the case themselves, there is no need for a detailed exposition. It will be useful, however, to draw attention to any unusual features or to points not readily apparent from the documents themselves. If the report recommends refusal and the issue seems clear-cut, the examiner may include with his report a draft reasoned decision for issue by the Examining Division (see VI, 2.4); if the issue is not clear-cut, the drafting of the reasoned decision should be deferred until the Division has discussed the case.

7.4 Tasks of the other members of the Examining Division

Art. 18(2)

When an application is referred to the other members of the Division, they will first consider the case individually and each will indicate his opinion on the course of action to be taken. If there is complete agreement with the recommendation of the primary examiner, no meeting of the Division will be necessary. When further action is needed, the primary examiner will be entrusted with the work. If, however, there is not complete agreement immediately with the primary examiner, or at least one member of the Division wishes to discuss the case, a meeting of the Division will be arranged. At such a meeting, the Division should try to reach a unanimous opinion by discussion, but where this seems unlikely, the difference of opinion must be resolved by voting. When the Division is enlarged to four members (see VI, 7.8), the chairman has a casting vote should this be necessary.

The other members of the Examining Division should bear in mind that their function generally is not to perform a complete re-examination of the application. If, following a discussion, the conclusions of the examiner entrusted with the examination are generally considered to be reasonable, the other members should accept them.

7.5 Further communication with the applicant

If, in the opinion of the Examining Division, the possibility exists of amending the application to bring it into a form which meets the requirements of the EPC, then the primary examiner should be entrusted with the task of informing the applicant that the Examining Division is of the opinion that the application should be refused on certain grounds unless satisfactory amendments are submitted within a stated period. If, within the time limit, satisfactory amendments are made, the examiner will then report back to the Examining Division recommending that the application should proceed to grant. If not, he should report back recommending refusal.

7.6 Refusal

If, on the other hand, the Examining Division is satisfied that the applicant has had sufficient opportunity to amend and that all the requirements are still not met, it should issue a decision to refuse the application; this decision will normally be drafted by the primary examiner.

The grounds of refusal must be stated and full reasons must be given. Refusal may be based only on grounds on which the applicant has had an opportunity to put forward comments. In addition, the applicant's attention must be directed to the provisions for appeal laid down in Art. 106 to 108. If oral proceedings take place (see E-III), the decision may be given orally but must subsequently be notified in writing, the time for appeal then running from the date of such notification.

Art. 113(1)
Art. 97(2)
Rule 111

7.7 Decision

Any decision is issued by the Examining Division as a whole and not by an individual examiner. All members, therefore, sign the written decision irrespective of whether or not it was a unanimous one. A seal may replace the signature.

Rule 113

7.8 Enlargement of the Examining Division; consultation of a legally qualified examiner

If the Examining Division considers that the nature of the decision so requires, it is enlarged by the addition of a legally qualified examiner.

Art. 18(2)

The participation of a legally qualified examiner or at least internal consultation of Directorate Patent Law, the department responsible for providing legally qualified members for Examining and Opposition Divisions, will be required if a difficult legal question arises which has not yet been solved by the Guidelines or by jurisprudence.

If the Examining Division has been enlarged by the addition of a legally qualified examiner, it consists of four members. In this case, in the event of parity of votes, the vote of the chairman will be decisive. As a rule, this enlargement of the Examining Division will be required in cases where evidence has to be taken according to Rule 117. The addition of a legally qualified examiner is to be considered also in the case of oral proceedings.

Depending on the nature of the problem, as an alternative to the enlargement of the Examining Division, internal consultation of a legally qualified examiner in Directorate Patent Law may take place. For instance, doubts may arise whether an application concerns an invention within the meaning of Art. 52(2) or whether the claimed invention is excluded from patentability by virtue of Art. 53. Consultation of a legally qualified examiner may also be appropriate in cases where legal considerations are predominant in respect to a decision, as in proceedings following a request for re-establishment of rights according to Art. 122. The formalities officer may also consult

Directorate Patent Law in cases within the scope of the duties transferred to him according to Rule 11(3).

8. Search-related issues in examination

8.1 Search for conflicting European applications

As stated in VI, 2.2, the examiner will need to make a "topping-up" search for conflicting European applications falling within the area defined by Art. 54(3). This is because as a general rule the search files will not be complete in respect of such material at the time the main search is made. Since priority dates claimed (if any) may not be accorded to all or part of the application but may be accorded to the appropriate part of a conflicting application (see V, 2.1), this search should be extended so as to cover all European applications published up to eighteen months after the filing of the application under consideration. If the examiner is unable to complete this "topping-up" search at the time the search opinion or the first communication under Art. 94(3) is prepared, he should ensure that such search is completed before the application is reported to be in order for the grant of a patent. In the rare case in which the application is found to be in order before this search can be completed (e.g. due to a request for accelerated prosecution of an application not claiming priority ("PACE", see Notice from the EPO dated 14 July 2007, Special edition No. 3, OJ EPO 2007, F.1), the grant of a patent should be postponed until the topping-up search can be completed.

8.2 Additional searches during examination

An additional search will sometimes be required either at the first stage of amendment or subsequently. This may arise for a number of reasons. First, an additional search may be necessary where a declaration or a partial search taking the place of the search report under Rule 63 has been issued at the search stage after an invitation under Rule 63(1) (see B-VIII, 3.1 and 3.2), and subsequently the deficiencies which rendered a meaningful search impossible under Rule 63 have been corrected by amendment complying with Rule 137(5) (see VI, 5.6) or successfully refuted by the applicant. Secondly, an additional search may also be necessary where the applicant successfully argues that a plurality of independent claims in the same category, which led to a limitation of the search report in accordance with Rule 62a (see B-VIII, 4.1 and 4.2), is in fact allowable according to the exceptions provided for in Rule 43(2) (see C-III, 3.2). Thirdly, an additional search may be necessary where a particular part of the application has not been searched because of an objection of lack of unity of invention, and the arguments put forward by the applicant have convinced the Examining Division that unity is given. Fourthly, an additional search may be necessary where the claims have been so amended that their scope is no longer covered by the original search. Exceptionally, an additional search may be required if the applicant resiles from an acknowledgement of prior art (see IV, 11.7.1) or if the examiner believes that material relevant to obviousness might be found in technical fields not taken into account

during the search. Finally, an additional search may be necessary if the applicant has introduced a new priority claim after the date of filing: it is possible that the search examiner was unaware of the new priority claim and consequently focused the search strategy on the assumption that the filing date (or original priority date) was the "cut-off point". The new priority date could lead to the exclusion of one or more of the documents cited in the original search report from the state of the art.

If the application has been filed under the PCT, the search report will be the international search report made under the PCT, which will be accompanied by a supplementary European search report, unless the Administrative Council has decided that a supplementary report is to be dispensed with (see E-IX, 5.4). Both of these reports will have to be considered by the examiner when deciding whether any additional search is required. *Art. 153(6) and (7)*

8.3 Search at the examination stage

Although in principle all search work (other than for Art. 54(3) material) should be done at the search stage, in exceptional circumstances the examiner is not barred from looking for a relevant document whose existence he knows of or has reason to suspect, if he can retrieve that document in a short time.

8.4 Citing documents not mentioned in the search report

A copy of any document cited by the examiner but not mentioned in the search report, for example one found in a search under VI, 8.1 or 8.2, should be sent to the applicant, and a further copy placed in the dossier so as to be available to the public.

9. Special applications

9.1 Divisional applications (see also A-IV, 1)

9.1.1 General remarks

Subsequent to the filing of a European application, a divisional application may be filed. The divisional application is accorded the same filing date as the parent application and has the benefit of any right of priority of the parent application in respect of the subject-matter contained in the divisional application. A European application may give rise to more than one divisional application. A divisional application may itself give rise to one or more divisional applications. *Art. 76(1)*

9.1.2 Voluntary and mandatory division

The applicant may file a divisional application of his own volition (voluntary division). The most common reason, however, for filing a divisional application is to meet an objection under Art. 82 due to lack of unity of invention (mandatory division). If the examiner raises an objection due to lack of unity, the applicant is allowed a period (see VI, 10) in which to limit his application to a single invention. The limitation of the parent application has to be clear and unconditional. *Art. 82*

The communication inviting the applicant to limit the application due to lack of unity should therefore include a reference to the fact that if the application is not limited within the set time limit the application may be refused.

9.1.3 Time limit; abandonment of subject-matter

Rule 36(1)

For a divisional application to be validly filed, the following requirements must be met on the date when the divisional application is filed:

(i) the parent application must be pending, and

(ii) at least one of the periods according to Rule 36(1)(a) and (b) must not yet have expired.

An application is pending up to (but **not** including) the date on which the European Patent Bulletin mentions the grant of the patent (OJ 2/2002, 112). For further details, see A-IV, 1.1.1 and sub-sections.

The mere deletion of subject-matter in the parent application is not prejudicial to the later filing of a divisional application. When deleting subject-matter, the applicant should, however, avoid any statements which could be interpreted as abandonment with substantive effect, thereby impeding the valid filing of a divisional application for that subject-matter (see also VI, 4.7, last paragraph).

9.1.4 Examination of a divisional application

Art. 76(1)

The substantive examination of a divisional application should in principle be carried out as for any other application but the following special points need to be considered. The claims of a divisional application need not be limited to subject-matter already claimed in claims of the parent application. However, under Art. 76(1), the subject-matter may not extend beyond the content of the parent application as filed. If a divisional application as filed contains subject-matter additional to that contained in the parent application as filed, it can be amended later in order that its subject-matter no longer extends beyond the earlier content, even at a time when the earlier application is no longer pending (G 1/05, OJ 5/2008, 271). If the applicant is unwilling to remedy the defect by removal of that additional subject-matter, the divisional application must be refused under Art. 97(2) due to non-compliance with Art. 76(1).

It cannot be converted into an independent application taking its own filing date. Moreover, a further divisional application for this additional subject-matter should also be refused under Art. 97(2) due to non-compliance with Art. 76(1).

Art. 123(2)

Amendments made to a divisional application subsequent to its filing must comply with the requirements of Art. 123(2), i.e. they may not extend the subject-matter beyond the content of the divisional application as filed (see G 1/05, OJ 5/2008, 271 and T 873/94,

OJ 10/1997, 456). If those amendments have not been identified and/or their basis in the application as filed not indicated by the applicant (see VI, 5.7) and the application is one of those mentioned in VI, 5.7.4, the Examining Division may send a communication according to Rule 137(4) requesting the applicant to provide this information (see VI, 5.7.1).

If the subject-matter of a divisional application is restricted to only a part of the subject-matter claimed in the parent application, this part of the subject-matter must be directly and unambiguously derivable from the parent application as being a separate part or entity, i.e. one which can even be used outside the context of the invention of the parent application (see T 545/92, not published in OJ).

In the case of a sequence of applications consisting of a root (originating) application followed by divisional applications, each divided from its predecessor, it is a necessary and sufficient condition for a divisional application of that sequence to comply with Art. 76(1), second sentence, that anything disclosed in that divisional application be directly and unambiguously derivable from what is disclosed in each of the preceding applications as filed (G 1/06, OJ 5/2008, 307).

9.1.5 Description and drawings

The description and drawings of the parent application and the or each divisional application should in principle be confined to matter which is relevant to the invention claimed in that application. However, amendment of the description should be required only where it is absolutely necessary. Thus the repetition in a divisional application of matter in the parent application need not be objected to unless it is clearly unrelated to or inconsistent with the invention claimed in the divisional application. As for the matter of cross-references, there is no need for the examiner to check in the description since, under present practice, cross-references are always made between the parent and divisional applications. These appear on the front page of the respective application and patent published after receipt of the divisional application, unless the technical preparations for publication have already been completed.

9.1.6 Claims

The parent and divisional applications may not claim the same subject-matter (see IV, 7.4). This means not only that they must not contain claims of substantially identical scope, but also that one application must not claim the subject-matter claimed in the other, even in different words. The difference between the claimed subject-matter of the two applications must be clearly distinguishable. As a general rule, however, one application may claim its own subject-matter in combination with that of the other application. In other words, if the parent and divisional applications claim separate and distinct elements A and B respectively which function in combination, one of the two applications may also include a claim for A plus B.

9.2 Applications resulting from a decision under Art. 61

9.2.1 General remarks

In certain circumstances, before a patent has been granted on a particular application, it may be adjudged as a result of a final decision of a national court that a person other than the applicant is entitled to the grant of a patent thereon. In this event this third party may either:

Art. 61(1)(a) (i) prosecute the application as his own application in place of the applicant;

Art. 61(1)(b) (ii) file a new European patent application in respect of the same invention; or

Art. 61(1)(c) (iii) request that the application be refused.

(See also IV, 10.3).

If the third party adopts the first of these options, he becomes the applicant in place of the former applicant and the prosecution of the application is continued from the position at which it was interrupted.

Art. 61(1) and (2)
Rule 17(1)

If, however, the third party files a new application under Art. 61(1)(b), the provisions of Art. 76(1) apply to this new application mutatis mutandis. This means that the new application is treated as though it were a divisional application i.e. it takes the date of filing and the benefit of any priority right of the original application. The examiner must therefore ensure that the subject-matter content of the new application does not extend beyond the content of the original application as filed. The original application is deemed to be withdrawn on the date of filing of the new application for the designated States concerned.

9.2.2 Original application no longer pending

In cases where the original application has been withdrawn, refused or deemed to be withdrawn and is thus no longer pending, Art. 61(1)(b) is applicable, thus allowing the third party to still file a new European patent application in respect of the same invention (see G 3/92, OJ 9/1994, 607).

9.2.3 Partial entitlement

Rule 18(1)

If, by a final decision, it is adjudged that a third party is entitled to the grant of a European patent in respect of only part of the matter disclosed in the European patent application, then the foregoing considerations apply only to that part. In such a case, option (i) mentioned in VI, 9.2.1 is not open to the third party and, regarding option (ii), the new application must be confined to that part of the original subject-matter to which he has become entitled. Similarly, the original application must, for the designated States concerned, be confined to the subject-matter to which the original applicant remains entitled. The new application and the amended original application will

stand in a relationship to each other similar to that pertaining between two divisional applications, and they will each stand in a relationship to the original application similar to that in which divisional applications stand in relation to the application from which they are divided. The guidance set out in VI, 9.1.4, 9.1.5 and 9.1.6 is therefore applicable to this situation.

9.2.4 Entitlement for certain designated States only

Where the final decision on entitlement applies only to some of the designated States, the original application may contain different claims, description and drawings for those States compared with the others (see VI, 5.5, last paragraph, and III, 8.2). *Rule 18(2)*

If the sole result of the application of Art. 61(1) is to divide the right to the grant between the original applicant and the third party so that each may apply for the entire subject-matter for different designated States, each application should be examined in the normal way without regard to the other, with the proviso that the subject-matter of each application must not extend beyond that of the original application.

9.3 Applications where a reservation has been entered in accordance with Art. 167(2)(a) EPC 1973

See III, 8.3.

9.4 International applications (Euro-PCT applications)

The general considerations relating to PCT applications are set out in E-IX. The examination of European applications made under the provisions of the PCT should be carried out in exactly the same way as for other European applications. Where, however, the search is performed by an ISA other than the EPO, the examiner may have to consider both the international search report (with the corresponding International Preliminary Report on Patentability or the International Preliminary Examination Report) and a supplementary European search report (with the corresponding search opinion) prepared by the EPO (see B-II, 4.3). *Art. 153*

Rule 161 lays down the framework for amending the application after entry into the European phase (see A-VII, 7) and additionally provides that, for applications for which the EPO prepared the WO-ISA when acting as ISA in the international phase, the applicant is required to reply to the WO-ISA (or to the subsequent IPER, where this was prepared by the EPO) after entry into the European phase, subject to certain exceptions (see VI, 3.5.1 for details). The application may be amended within a non-extendable period of one month as from notification of a communication informing the applicant accordingly, the communication being issued promptly after expiry of the time limit for entry into the European phase. Where applicable, the application as amended under Rule 161(2) serves as the basis for any supplementary European search under Art. 153(7) (see B-II, 4.3). *Rule 161*

Where the EPO is an elected Office, the international preliminary examination report and the documents attached to it must be considered in accordance with E-IX, 6.3.

10. Time limits for response to communications from the examiner

10.1 General considerations

The general considerations relating to time limits are set out in E-VIII. The time limit for response to a communication from the examiner should in general be between two and four months in accordance with Rule 132. The period to be allowed will be determined by the examiner taking all the factors relevant to the particular application into account. These include the language normally used by the applicant or his representative; the number and nature of the objections raised; the length and technical complexity of the application; the proximity of the EPO to the applicant or, if he has one, his representative; and the distance separating applicant and representative.

10.2 Special circumstances

In certain special circumstances the examiner may allow up to six months for the time limit. The six-month period may be appropriate, for instance, if the applicant resides a long way from his representative and the language of the proceedings is not one to which the applicant is accustomed; or if the subject-matter of the application or the objections raised are exceptionally complicated.

The search opinion is not a communication under Art. 94(3) and therefore no time limit is set.

11. Examination of observations by third parties

The general considerations relating to observations from third parties are set out in E-VI, 3. In the context of substantive examination, such observations are not taken into account unless a request for examination has been filed.

12. Oral proceedings

The general considerations relating to oral proceedings are set out in E-III.

13. Taking of evidence

13.1 General remark

The general considerations relating to the taking of evidence are set out in E-IV. This section deals only with the kind of evidence most likely to arise in pre-grant proceedings, viz. written evidence.

13.2 Producing evidence

An Examining Division would not, as a general rule, require evidence to be produced. The primary function of the examiner in proceedings before grant is to point out to the applicant any ways in which the

application does not meet the requirements of the EPC. If the applicant does not accept the view of the examiner, then it is for the applicant to decide whether he wishes to produce evidence in support of his case and, if so, what form that evidence should take. The Examining Division should afford the applicant a reasonable opportunity of producing any evidence which is likely to be relevant.

However, this opportunity should not be given where the Examining Division is convinced that no useful purpose would be served by it, or that undue delay would result.

13.3 Written evidence

Written evidence could include the supply of information, or the production of a document or of a sworn statement. To take some examples:

To rebut an allegation by the examiner of lack of inventive step, the applicant might supply information as to the technical advantages of the invention. Again he might produce a sworn statement, either from himself or from an independent witness, purporting to show that workers in the art have been trying for a long time unsuccessfully to solve the problem with which the invention is concerned, or that the invention is a completely new departure in the relevant art.

14. The final stage of examination

14.1 Communication under Rule 71(3)

Once the Examining Division has decided that a patent can be granted it must inform the applicant of the text on the basis of which it intends to do so. This text may include amendments and corrections made by the Examining Division on its own initiative which it can reasonably expect the applicant to accept. *Rule 71(3)*

The text is communicated to the applicant by despatching a communication under Rule 71(3), in which the applicant is furthermore invited to pay the fee for grant and publishing and to file a translation of the claims in the two official languages of the EPO other than the language of the proceedings within a period of four months, which is non-extendable. Note that for European patent applications filed before 1 April 2009 and international applications entering the regional phase before that date the fee for grant and printing may include an element depending on the number of pages, but for applications filed or entering the regional phase on or after that date this additional element is payable as part of the filing fee (see A-III, 13.2). *Rule 71(3)*

If during examination proceedings a main and subsidiary requests have been filed (see VI, 4.1 and E-X, 3) and one of the requests is allowable, the communication pursuant to Rule 71(3) is to be issued on the basis of the (first) allowable request and must be accompanied by an explanation of the reasons why the higher-ranking requests are not allowable (see also Legal Advice No. 15/05 (rev. 2), OJ 6/2005, 357).

If the application contains different sets of claims for particular Contracting States (see III, 8), a translation of all the sets of claims must be filed.

Only one copy of the translation need be filed.

The examiner should not concern himself with the quality of the translation filed.

Rule 71(6)
Rule 45(1)
Rule 162(1) and (2)

If the text of the European patent application serving as the basis for grant contains more than fifteen claims, the Examining Division requests the applicant to pay, within the period under Rule 71(3), claims fees in respect of each claim over and above that number, unless he has already done so under Rule 45(1) or Rule 162(1) and 162(2) (see A-III, 9). Where there is more than one set of claims, fees are incurred under Rule 45(1), Rule 162(1) and 162(2) or Rule 71(6) only for the set with the greatest number of claims.

Rule 74

In the communication under Rule 71(3), the applicant is asked whether he requests a paper copy of the patent specification to be supplied to him with the certificate for the European patent. This paper copy of the specification is supplied free of charge on request. For further details see VI, 14.10.

An annex to the communication under Rule 71(3) states the Contracting States which have been validly designated, the title of the invention in the three EPO official languages, the international patent classification and the registered name of the applicant.

Art. 65(1)
Rule 71(10)

The communication under Rule 71(3) also contains a reference to the relevant pages on the EPO website where information concerning translation requirements of the Contracting States under Art. 65(1) is published.

14.2 Grant of a patent

Rule 71(3)
Art. 97(1)

If the applicant pays the fee for grant and publishing and files the translation of the claims within the specified period, he is deemed to have approved the text intended for grant. Once all the requirements set out in VI, 14.1, are met, it is decided that a European patent is granted, provided that renewal fees and any additional fees already due have been paid.

Rule 71(9)
Art. 86(1)

If a renewal fee becomes due after notification of the Rule 71(3) communication but before the expected date of publication of the mention of the grant of the European patent, the mention is not published until the renewal fee has been paid. The applicant is informed accordingly. If the renewal fee or any additional fee is not paid in time, the application is deemed to be withdrawn.

Rule 71(8)

In the rare case that examination was accelerated to such an extent that the communication under Rule 71(3) is issued before the

designation fee becomes due, the mention of grant of the patent will not be published until the designation fee has been paid. The applicant is informed accordingly. For European patent applications filed before 1 April 2009 or international applications entering the regional phase before that date this publication will not take place until the designation fees have been paid and the designation of States for which no designation fees have been paid has been withdrawn (see also A-III, 11.1 and A-III, 11.3).

The decision to grant does not take effect until the date on which the grant is mentioned in the European Patent Bulletin. *Art. 97(3)*

14.3 Application deemed withdrawn

If the applicant fails to pay the fee for grant and publishing or the claims fees or to file the translation in due time, the application is deemed to be withdrawn. This applies also if the applicant merely states in his reply to the communication under Rule 71(3) that he does not approve of the text proposed for grant. *Rule 71(7)*

14.4 Amendments filed in reply to a communication under Rule 71(3)

The communication under Rule 71(3) does not constitute an opportunity for the applicant to call into question the outcome of the earlier procedure. At this stage of the proceedings, substantive examination has already been completed and the applicant has had the opportunity to amend the application and therefore normally only those amendments which do not appreciably delay the preparations for grant of the patent will be admitted under Rule 137(3). It is, however, appropriate to admit separate sets of claims for one or more designated States that made a reservation under Art. 167(2) EPC 1973 (see III, 8.3) or for which prior national rights exist (see III, 8.4). *Rule 71(3)* *Rule 137(3)*

However, if no communication under Art. 94(3) has preceded the communication under Rule 71(3) and the application is one of the exceptional cases (i), (ii) or (iii) as mentioned in VI, 4.7, the applicant may amend the description, claims and drawings of his own volition (see VI, 3.3 for the conditions any amendment must satisfy). Nonetheless, unless the applicant's response corresponds to one of the exceptions defined in VI, 14.4.1, the fee for grant and publishing must be paid and the translations of the claims filed, as required by Rule 71(4). *Rule 137(3)*

If, in reply to the communication under Rule 71(3) and within the specified period, the applicant files a request for amendments under Rule 137(3) and/or a correction of errors under Rule 139, and these concern the claims, the request should be accompanied by a translation of the claims as amended and/or corrected. This applies regardless of whether the request is an explicit request for amendment or is drafted as an approval which is conditional on the filed amendments. Failure to observe this requirement results in the *Rule 71(4)*

application being deemed withdrawn (Rule 71(7)). Provided that the applicant has filed the translation of the claims as amended and/or corrected and has paid the fee for grant and publishing within the specified period, he is deemed to have approved the grant of the patent as amended and/or corrected.

Any amendments filed in reply to the communication under Rule 71(3) must satisfy the requirements of Rule 137(4) by identifying the amendments and indicating the basis for them in the application as filed (see VI, 5.7). If these requirements are not met and the application is of one of the types mentioned in VI, 5.7.4, the Examining Division may send a Rule 137(4) communication before proceeding further (see VI, 5.7.1). If the applicant replies to this communication in time, the Examining Division will then decide if it consents to the amendments and will proceed accordingly as indicated below.

If the Examining Division gives its consent under Rule 137(3) to these amendments and/or the correction and considers them allowable without issuing a further communication under Art. 94(3), it does not issue a second communication under Rule 71(3), but proceeds to the grant of the patent pursuant to Art. 97(1).

Rule 71(5)

If, under Rule 137(3), the Examining Division does not admit the amendments and/or corrections proposed (cf. VI, 4.7 - 4.9) or does not allow the amendments and/or corrections because the application does not comply with the requirements of the EPC (see VI, 3.3, 5.2 and 5.4), the Examining Division informs the applicant of this fact, stating its reasons and giving him an opportunity to submit within a specified period his observations and any amendments considered necessary by the Examining Division and, where the claims are again amended, a translation of the claims as amended. The procedure may subsequently continue e.g. as follows:

(i) if the applicant fails to reply within the specified period, the application is deemed to be withdrawn (Art. 94(4));

(ii) if the applicant withdraws the amendments and/or corrections he requested with his reply to the Rule 71(3) communication, a translation of the claims as annexed to the Rule 71(3) communication must be filed within the specified period;

Art. 113(2)

(iii) if the applicant submits his observations while maintaining the requested amendments and/or corrections and the Examining Division sees no reason to change its opinion not to admit the amendments pursuant to Rule 137(3) or not to allow them, for the reasons given, the application is refused under Art. 97(2), since, in these circumstances, there is either no text of the application which has been agreed by the applicant and admitted by the Examining Division (Art. 113(2)) or the application does not meet the requirements of the EPC; or

(iv) if the applicant files further amendments, and these concern the claims, a translation of these claims must be filed within the specified period.

The procedure under Rule 71(5) should however not normally be applied if the communication under Rule 71(3) was the first communication from the examining division (see VI, 4.9, last paragraph). In these circumstances the normal procedure following the filing of amendments which are not allowable would be the resumption of the examination procedure as described in VI, 14.5.

14.4.1 Exceptions to the requirement of Rule 71(4)

The requirement of Rule 71(4) concerning the filing of translations and payment of fees however does not apply in the three following situations, in which the changes to the applicant's requests do not represent amendments within the meaning of Rule 137(3):

(i) if the communication under Rule 71(3) was based on a subsidiary request, and the applicant replies by maintaining one or more higher requests which do not meet the requirements of the EPC (see also Legal Advice 15/05 (rev. 02), OJ 6/2005, 357);

(ii) if the communication under Rule 71(3) included amendments to the claims carried out by the examining division (see VI, 14.1, first paragraph), and the applicant responds by indicating that he does not approve of these amendments and maintains his request as on file when the communication under Rule 71(3) was issued; or

(iii) if due to an error on the part of the EPO, the communication under Rule 71(3) was based on the wrong documents, and the applicant replies by pointing out or correcting that error.

If, as described in paragraph (i) above, the applicant maintains a higher ranking request which is not allowable, or if, as described in paragraph (ii) above, he does not agree to the amendments proposed by the examining division but instead maintains his request in an unallowable form, then a reasoned refusal under Art. 97(2) would be issued, preceded where necessary by a communication setting out the reasons why the request is not allowable. If on the other hand, agreement is reached on an allowable text, where necessary following further communication from the examining division and response from the applicant, a second communication under Rule 71(3) will have to be issued in order to indicate the requirement for the translations and fees and to reset the related time limits. However, no further communication under Rule 71(3) would be required under the circumstances of paragraph (iii) above if the applicant replied to the original communication under Rule 71(3) by filing, of his own volition, the correct documents together with the translations and paid the fee, in which circumstances the application could proceed directly to grant.

14.5 Resumption of the examination procedure

The Examining Division may resume the examination procedure at any time up to the moment the decision to grant is handed over to the EPO's internal postal service for transmittal to the applicant. This will seldom occur, but may be necessary if e.g. the applicant files further prior art which necessitates further substantive examination, if the Examining Division becomes aware of very relevant prior art following observations by third parties under Art. 115, if one of the exceptions of VI, 14.4.1(ii) and VI, 14.4.1(iii) applies, or if the communication under Rule 71(3) was the first communication from the examining division, the application is one of the exceptional cases (i), (ii) or (iii) as mentioned in VI, 4.7 and the applicant responds by filing amendments which are not allowable. A second Rule 71(3) communication is sent out if the resumed examination results in a text on the basis of which a patent can be granted. The fee for grant and publishing should not be paid again if they were already paid in response to the first Rule 71(3) communication.

14.6 Further processing

Art. 121

If the applicant overruns the time limit set under Rule 71(3) or 71(5), he may request further processing under Art. 121 (see E-VIII, 2.1).

14.7 Refund of fees

Rule 71(5)

If the European patent application is refused, withdrawn or deemed to be withdrawn, the fee for grant and publishing and any claims fees paid under Rule 71(6) are refunded.

14.8 Publication of the patent specification

The decision to grant contains the date of the mention of the grant of the European patent and is sent to the applicant when the technical preparations for printing the patent specification have been completed.

Art. 98

As soon as possible after the mention of the grant is published in the Bulletin, the EPO publishes the patent specification containing the

Rule 73

description, claims (in the three official languages) and any drawings.

Art. 14(6)

The front page of the published specification shows inter alia the Contracting States which are still designated at the time of grant (or the designation of which has been withdrawn after completion of the technical preparations for printing).

Mistakes in the specification of a European patent arising in the course of its production have no effect on the content of the patent granted. For this, only the text on which the decision to grant the patent is based is decisive (see Legal Advice No. 17/90, OJ 6/1990, 260).

14.9 Withdrawal before publication of the patent specification

Rule 73

The specification of the European patent is not published if the application is withdrawn before termination of the technical preparations for publication. If after termination of the technical preparations the application is withdrawn to avoid publication, non-publication cannot be guaranteed. The EPO will, however, try (in

accordance with the principles of J 5/81, OJ 4/1982, 155) to prevent publication on a case-by-case basis if the stage reached in the publication procedure permits this reasonably easily. The application may be withdrawn by means of a signed declaration, which should be unqualified and unambiguous (see J 11/80, OJ 5/1981, 141). The applicant is bound by an effective declaration of withdrawal (see Legal Advice No. 8/80, OJ 1/1981, 6).

14.10 Certificate

Rule 74

As soon as the European patent specification has been published, the EPO issues the proprietor with a certificate attesting that the European patent has been granted to the person named in the certificate. Upon special request filed within the time limit of Rule 71(3) a copy of the patent specification is attached to the certificate . The proprietor may also request that a duplicate copy of the certificate with the specification attached be supplied to him upon payment of an administrative fee. For further details see the Decision of the President of the EPO dated 12 July 2007 (Special edition No. 3, OJ EPO 2007, D.2).

14.11 European Patent Bulletin

Art. 129(a)

If no notice of opposition is recorded in the dossier of the European patent within nine months of publication of the mention of grant, the patent proprietor is informed and an appropriate entry is published in the European Patent Bulletin (point 1, Art. 1, Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, E.1). If, subsequently, it emerges that an opposition was filed in time, the proprietor is again informed and a correction is published in the Bulletin.

Part D

Guidelines for Opposition and Limitation/Revocation Procedures

Contents

Chapter I – General remarks **I-1**

1.	The meaning of opposition	I-1
2.	Opposition after surrender or lapse	I-1
3.	Territorial effect of the opposition	I-1
4.	Entitlement to oppose	I-1
5.	Intervention of the assumed infringer	I-2
6.	Parties to opposition proceedings	I-2
7.	Representation	I-3
8.	Information to the public	I-3

Chapter II – The Opposition Division **II-1**

1.	Administrative structure	II-1
2.	Composition	II-1
2.1	Technically qualified examiners	II-1
2.2	Legally qualified examiners	II-1
2.3	Chairman	II-1
3.	Allocation of duties and appointment of members of the Opposition Division	II-1
4.	Tasks of the Opposition Divisions	II-1
4.1	Examination of oppositions	II-1
4.2	Decision concerning the awarding of costs by the Opposition Division	II-2
4.3	Ancillary proceedings	II-2
5.	Allocation of tasks to members	II-2
6.	Duties and powers of members	II-2
7.	Allocation of individual duties	II-3

Chapter III – Opposition **III-1**

1.	Time allowed for filing notice of opposition	III-1
2.	Opposition fee	III-1
3.	Submission in writing	III-1
3.1	Form of the opposition	III-1
3.2	Notices of opposition filed by fax	III-1
3.3	Signature of the notice of opposition	III-1
4.	Derogations from language requirements	III-2
5.	Grounds for opposition	III-2
6.	Content of the notice of opposition	III-3

Chapter IV – Procedure up to substantive examination IV-1

1.	Examination for deficiencies in the notice of opposition and communications from the formalities officer arising from this examination	IV-1
1.1	Forwarding of the notice of opposition to the formalities officer	IV-1
1.2	Examination for deficiencies in the notice of opposition	IV-1
1.2.1	Deficiencies which, if not remedied, lead to the opposition being deemed not to have been filed	IV-1
1.2.2	Deficiencies which, if not remedied, lead to the opposition being rejected as inadmissible	IV-2
1.2.2.1	Deficiencies under Rule 77(1)	IV-3
1.2.2.2	Deficiencies under Rule 77(2)	IV-5
1.3	Issue of communications by the formalities officer as a result of examination for deficiencies	IV-6
1.3.1	Communication in the event of deficiencies as described in IV, 1.2.1, which, if not remedied, will lead to the opposition being deemed not to have been filed	IV-6
1.3.2	Communication in the event of deficiencies as described in IV, 1.2.2, which, if not remedied, will lead to rejection of the opposition as inadmissible	IV-6
1.3.3	Extent of the formalities officer's obligation to issue the above communications	IV-6
1.4	Subsequent procedure in the event of deficiencies which may no longer be remedied	IV-7
1.4.1	Deficiencies which may no longer be remedied, as a result of which the opposition is deemed not to have been filed	IV-7
1.4.2	Deficiencies which may no longer be remedied in accordance with Rule 77(1) and (2), resulting in the opposition being rejected as inadmissible	IV-7
1.5	Notifications to and observations by the proprietor	IV-8
1.6	Subsequent procedure	IV-8
2.	Activity of the Opposition Division	IV-8
3.	Rejection of the opposition as inadmissible by the Opposition Division, the proprietor of the patent not being a party	IV-9
4.	Termination of opposition proceedings in the event of inadmissible opposition	IV-9
5.	Preparation of substantive examination	IV-10
5.1	Inadmissibility at a later stage	IV-10
5.2	Invitation to the proprietor of the patent to submit comments and communication of opposition to the other parties concerned by the formalities officer	IV-10
5.3	Filing of amended documents in reply to the notice of opposition	IV-11
5.4	Communication of observations from one of the parties to the other parties	IV-12
5.5	Decision concerning the admissibility of an opposition, the proprietor of the patent being a party	IV-12
5.6	Examination of the admissibility of an intervention and preparations in the event of an intervention	IV-13

Chapter V – Substantive examination of opposition V-1

1.	Beginning of the examination of the opposition	V-1
2.	Extent of the examination	V-1
2.1	Extent to which the patent is opposed	V-1
2.2	Examination of the grounds for opposition	V-1

3.	Non-patentability pursuant to Art. 52 to 57	V-2
3.1	State of the art made available to the public "by use or in any other way"	V-3
3.1.1	Types of use and instances of state of the art made available in any other way	V-3
3.1.2	Matters to be determined by the Opposition Division as regards use	V-3
3.1.3	Ways in which subject-matter may be made available	V-4
3.1.3.1	General principles	V-4
3.1.3.2	Agreement on secrecy	V-5
3.1.3.3	Use on non-public property	V-5
3.1.3.4	Example of the accessibility of objects used	V-5
3.1.3.5	Example of the inaccessibility of a process	V-5
3.2	State of the art made available by means of oral description	V-6
3.2.1	Cases of oral description	V-6
3.2.2	Non-prejudicial oral description	V-6
3.2.3	Matters to be determined by the Opposition Division in cases of oral description	V-6
3.3	State of the art made available to the public in writing or by any other means	V-6
4.	Insufficient disclosure of the invention	V-7
4.1	Required form of disclosure	V-7
4.2	Disclosure of inventions relating to biological material	V-7
4.3	Burden of proof as regards the possibility of performing and repeating the invention	V-7
4.4	Cases of partially insufficient disclosure	V-7
4.4.1	Only variants of the invention are incapable of being performed	V-7
4.4.2	Absence of well-known details	V-8
4.4.3	Difficulties in performing the invention	V-8
5.	Subject-matter of the European patent extending beyond the original disclosure	V-8
5.1	Basis of this ground for opposition	V-8
5.2	Distinction between allowable and unallowable amendments	V-9
6.	Extension of protection	V-9
6.1	General remarks	V-9
6.2	Examination of amendments to the claims	V-10
6.3	Change of category of claim	V-11

Chapter VI – Procedure for the examination of the opposition VI-1

1.	General remarks	VI-1
2.	Adherence to the text of the European patent submitted or approved by the proprietor	VI-2
2.1	Basis for the examination	VI-2
2.2	Revocation of the patent	VI-2
3.	Invitation to file observations	VI-2
3.1	Examiners' communications	VI-2
3.2	Summons to oral proceedings	VI-2
4.	Communications from the Opposition Division to the proprietor of the patent	VI-3
4.1	Communications from the Opposition Division; reasoned statement	VI-3

4.2	Invitation to file amended documents	VI-3
5.	Additional search	VI-3
6.	Examination of the opposition during oral proceedings	VI-4
7.	Preparation of the decision	VI-4
7.1	General remarks	VI-4
7.2	Preparation of a decision to maintain a European patent in amended form	VI-4
7.2.1	Procedural requirements	VI-4
7.2.2	Decision on the documents on the basis of which the patent is to be maintained	VI-6
7.2.3	Request for publishing fee and translations	VI-6

Chapter VII – Details and special features of the proceedings VII-1

1.	Sequence of proceedings	VII-1
1.1	Basic principle	VII-1
1.2	Exceptions	VII-1
2.	Request for documents	VII-2
3.	Unity of the European patent	VII-2
3.1	Basic principle	VII-2
3.2	Factors affecting the unity of the European patent	VII-3
4.	Texts of the European patent which are different for different Contracting States	VII-3
4.1	Different texts where the entitled person takes part in the proceedings	VII-3
4.2	Different text where the state of the art is different pursuant to Art. 54(3) and (4) under EPC 1973	VII-3
4.3	Different text where a partial transfer of right by virtue of a final decision pursuant to Art. 61 and Rule 18(1) and (2) has taken place	VII-3
4.4	Different text where national rights of earlier date exist	VII-3
5.	Procedure where the proprietor is not entitled	VII-4
5.1	Stay of proceedings	VII-4
5.2	Continuation of proceedings	VII-4
5.3	Interruption of time limits	VII-5
5.4	Department responsible	VII-5
6.	Continuation of the opposition proceedings in the cases covered by Rule 84	VII-5
6.1	Continuation in the case of surrender or lapse of the patent	VII-5
6.2	Continuation on the death or legal incapacity of the opponent	VII-6
6.3	Continuation after the opposition has been withdrawn	VII-6
7.	Intervention of the assumed infringer	VII-6
8.	Publication of a new specification of the patent	VII-7

Chapter VIII – Decisions of the Opposition Division VIII-1

1.	Final decisions on an admissible opposition	VIII-1

1.1	General remarks	VIII-1
1.2	Revocation of the European patent	VIII-1
1.2.1	Revocation on substantive grounds	VIII-1
1.2.2	Revocation for failure to pay the prescribed fee for printing or to file a translation	VIII-1
1.2.3	Revocation for failure to notify the appointment of a new representative	VIII-1
1.2.4	Revocation in the event of requirements not being met until after expiry of time limits	VIII-2
1.2.5	Revocation of the patent in the event that the proprietor no longer wishes the patent to be maintained as granted	VIII-2
1.3	Rejection of the opposition	VIII-2
1.4	Maintenance of the European patent as amended	VIII-2
1.4.1	Taking of a final decision	VIII-2
1.4.2	Statement in the decision of the amended form of the European patent	VIII-2
2.	Other decisions	VIII-3
2.1	Decision on the inadmissibility of an opposition or intervention	VIII-3
2.2	Decisions which do not terminate proceedings	VIII-3
2.3	Decision on a notified loss of rights at the request of the person concerned	VIII-3
2.4	Decision on re-establishment of rights	VIII-3
2.5	Decision on closure of the opposition proceedings	VIII-3

Chapter IX – Costs **IX-1**

1.	Charging of costs	IX-1
1.1	General principle	IX-1
1.2	Decisions on the apportionment of costs	IX-1
1.3	Costs to be taken into consideration	IX-2
1.4	Principle of equity	IX-2
2.	Procedure for the fixing of costs	IX-3
2.1	Fixing of costs by the Opposition Division	IX-3
2.2	Appeal against the fixing of costs by the Opposition Division	IX-3
3.	Enforcement of the fixing of costs	IX-3

Chapter X – Limitation and revocation procedure **X-1**

1.	Introduction	X-1
2.	Examination for deficiencies in the request	X-1
2.1	Deficiencies which lead to the request being deemed not to have been filed	X-1
2.2	Deficiencies which, if not remedied, lead to the request being rejected as inadmissible	X-2
3.	Decision on request for revocation	X-3
4.	Substantive examination (limitation)	X-3
4.1	Department responsible	X-3
4.2	Basis for the examination	X-3
4.3	Scope of the examination	X-3

4.4	Further stages of the examination	X-4
4.5	Third-party observations during the examination	X-4
5.	Formal procedure for limitation when the request is allowable	X-5
6.	Rejection of the request	X-5
7.	Precedence of opposition proceedings	X-6
8.	Legal status of decisions	X-6
9.	Withdrawal of the request	X-6
10.	Different sets of claims	X-6
10.1	Limitation results in the claims becoming different in different Contracting States	X-7
10.2	Limitation is different for different Contracting States because the claims as granted were different for different Contracting States	X-7
11.	Multiple requests	X-7

Chapter I

General remarks

(A notice on the opposition procedure before the EPO was published in OJ 3/2001, 148)

1. The meaning of opposition

The public may oppose a granted European patent on the basis of one or more of the grounds mentioned in Art. 100. The grounds on which the opposition is based may arise for example from circumstances of which the EPO was not aware when the patent was granted (e.g. prior use or a publication which was not contained or not found among the material available to the EPO). Opposition is therefore a means by which any person may obtain the limitation or revocation of a wrongly granted patent.

2. Opposition after surrender or lapse

An opposition may be filed even if the European patent has been surrendered or has lapsed for all the designated States. This is relevant in that in such cases the rights acquired with the patent remain in existence during the period up to surrender or lapse and claims arising from such rights may subsist after that date. *Rule 75*

3. Territorial effect of the opposition

The opposition applies to the European patent in all the Contracting States in which that patent has effect. Thus the opposition should formally be in respect of all the designated States. If an opposition is filed in respect of only some of the designated States it will be treated as if it were in respect of all the designated States. *Art. 99(2)*

Nevertheless, the effect of an opposition may differ as between Contracting States. This may arise where the patent contains different claims for different Contracting States in accordance with Rule 18(2) or Rule 138, or where the claims must take account of different art under the provisions of Art. 54(3) and (4) EPC 1973 (see VII, 4.2). Thus the patent may be differently amended in respect of different Contracting States and may be revoked in respect of one or more Contracting States and not in respect of others.

4. Entitlement to oppose

"Any person" may give notice of opposition without specifying any particular interest. "Any person" is to be construed in line with Art. 58 as meaning any natural person (private individual, self-employed persons, etc.), any legal person or any body assimilated to a legal person under the law governing it. "Any person" does not include the proprietor of the patent (as was decided in G 9/93 (OJ 12/1994, 891), reversing G 1/84 (OJ 10/1985, 299)). *Art. 99(1)*

Notice of opposition may also be filed jointly by more than one of the persons mentioned above. In order to safeguard the rights of the patent proprietor and in the interests of procedural efficiency, it has to be clear throughout the procedure who belongs to the group of common opponents. If a common opponent (including the common representative) intends to withdraw from the proceedings, the EPO must be notified accordingly by the common representative or by a new common representative determined under Rule 151(1) in order for the withdrawal to take effect (see also G 3/99, OJ 7/2002, 347).

Oppositions are not assignable but may be inherited or succeeded to as part of an overall succession in law, e.g. in the event of the merger of legal persons. Acquiring companies may also take over oppositions filed by acquired companies. However, a legal person who was a subsidiary of the opponent when the opposition was filed and who carries on the business to which the opposed patent relates cannot acquire the status as opponent if all its shares are assigned to another company (as was decided in G 2/04 (OJ 11/2005, 549)).

The European Patent Office has to examine, ex officio, the validity of any purported transfer of opponent status to a new party at all stages of the proceedings (T 1178/04, OJ EPO 2/2008, 80).

5. Intervention of the assumed infringer

Art. 105(1) and (2)
Rule 89

Under certain conditions (see VII, 7) any third party who proves that proceedings for infringement of the opposed patent have been instituted against him or that the proprietor of the patent has requested him to cease alleged infringement of the patent and that he has instituted proceedings for a court ruling that he is not infringing the patent may, after the opposition period has expired, intervene in the opposition proceedings. Once the notice of intervention has been filed in good time and in due form, the intervention is to be treated as an opposition (see IV, 5.6). For accelerated processing of oppositions on request, see E-VIII, 4.

6. Parties to opposition proceedings

Art. 99(3)
Art. 105(2)
Art. 115

The proprietor of the patent, the opponent and, where applicable, the intervener will be parties to the opposition proceedings. However, an opponent who has withdrawn notice of opposition or whose opposition has been rejected as inadmissible will remain a party to the proceedings only until the date of such withdrawal or the date on which the decision on rejection has become final. The same will apply in the case of interveners. Third parties who have presented observations concerning the patentability of the invention in respect of which an application has been filed are not parties to opposition proceedings (see E-VI, 3).

Art. 118

Where the proprietors of a European patent are not the same in respect of different designated Contracting States, they are to be regarded as joint proprietors for the purposes of opposition

proceedings (see VII, 3.1, concerning the unity of the European patent).

Where a person provides evidence that in a Contracting State, following a final decision, he has been entered in the patent register of that State instead of the previous proprietor, he is entitled on request to replace the previous proprietor in respect of that State. In this event, by derogation from Art. 118, the previous proprietor and the person making the request are not deemed to be joint proprietors unless both so request. The aim of this provision is to afford the new proprietor the opportunity of defending himself against the opposition as he sees fit (see VII, 3.2, as regards the conduct of the opposition proceedings in such cases).

Art. 99(4)
Art. 61(1)(a)

The Legal Division is responsible for decisions in respect of entries in the Register of European Patents (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, G.1).

Art. 20(1)

7. Representation

As regards the requirements relating to representation of opponents and patent proprietors, reference is made to A-IX, 1. Deficiencies in the representation of an opponent when filing the opposition and their remedy are treated in IV, 1.2.1(ii) and 1.2.2.2(iv).

8. Information to the public

As soon as an opposition has been received, the date of filing of the opposition is entered in the Register of European Patents and published in the European Patent Bulletin. The same applies to the date on which opposition proceedings are concluded and to the outcome of the proceedings.

Chapter II

The Opposition Division

1. Administrative structure

Each Opposition Division is part of an EPO directorate comprising several Examining and Opposition Divisions. *Rule 11(1)*

2. Composition

2.1 Technically qualified examiners

An Opposition Division consists of three technical examiners, at least two of whom must have taken no part in the proceedings for grant of the patent to which the opposition relates. *Art. 19(2)*

2.2 Legally qualified examiners

If the Opposition Division considers that the nature of the decision so requires, it is enlarged by the addition of a legally qualified examiner who has taken no part in the proceedings for grant. *Art. 19(2)*

The principles established for inclusion of a legally qualified member and for consultation of the Directorate Patent Law, the department responsible for providing legally qualified members for Examining and Opposition Divisions, by the Examining Division apply mutatis mutandis to the Opposition Division (see C-VI, 7.8). In addition to this, difficult legal questions may arise during the examination as to whether an opposition is to be rejected as inadmissible. Consultation of a legally qualified member should also be envisaged in cases where it is questionable whether or not a disclosure by means other than a document was made available to the public.

2.3 Chairman

The Chairman must be a technically qualified examiner who has taken no part in the grant proceedings.

3. Allocation of duties and appointment of members of the Opposition Division

C-VI, 1.2 applies mutatis mutandis. *Rule 11(1)*

4. Tasks of the Opposition Divisions

4.1 Examination of oppositions

The Opposition Divisions are responsible for the examination of oppositions against European patents. *Art. 19(1)*

The examination of newly submitted documents for compliance with physical requirements will essentially be the task of the competent formalities officers (see II, 7, A-I, 2, A-III, 3.2, and C-VI, 2.1).

4.2 Decision concerning the awarding of costs by the Opposition Division

Art. 104(2)
Rule 88(3) and (4)

The Opposition Division will decide on requests to have the costs fixed by the formalities officer reviewed (see II, 7 and IX, 2.1).

4.3 Ancillary proceedings

Art. 122(2)
Rule 136(4)
Rule 112(2)

It will be incumbent upon the Opposition Division to conduct ancillary proceedings arising in the course of opposition proceedings, such as the processing of requests for re-establishment of rights in respect of a time limit which was not observed vis-à-vis the EPO during the opposition proceedings or of requests for a decision concerning a finding arrived at by the formalities officer that a right has been lost. Additional tasks may be entrusted to the Opposition Divisions by the President of the EPO in accordance with Rule 11(2).

5. Allocation of tasks to members

Art. 19(2)
Rule 119(1)

An Opposition Division will normally entrust one of its members with the examination of the opposition, but not with the conduct of oral proceedings, up to the time of the final decision on the opposition (see also IV, 2). If need be, he may also be entrusted with the examination of the evidence adduced (see E-IV, 1.3). He will be referred to as the primary examiner.

6. Duties and powers of members

The primary examiner will conduct the examination of the opposition. In this work he will issue communications to the parties without consulting the other members. However, if the primary examiner believes that the other members may have reservations concerning the procedure which he intends to follow, he must submit the communication to the Opposition Division before despatch. If he considers that the matter is ready for a decision or that oral proceedings should be arranged, possibly in conjunction with the taking of evidence (see E-III, 1 to 4, and E-IV, 1.6.1), he must submit an opinion in writing to the Opposition Division.

In the light of this opinion, the other members of the Opposition Division will give their own opinions in writing, which may simply be a short confirmation of agreement.

If there are differences of opinion, the Chairman must fix a date for a meeting at which the primary examiner will report on the matter. The Chairman will preside at the meeting and, following a discussion, will take a vote on the decision or the further course of the procedure.

Art. 19(2)

Voting will be on the basis of a simple majority. In the event of parity of votes, the vote of the Chairman of the Division is decisive.

Any further measures necessary will as a rule be entrusted to the primary examiner. If no further measures are necessary, the primary examiner will draft a decision on the opposition and will distribute the draft to the other members of the Opposition Division for examination

and signature. If any changes are proposed by a member and there are differences of opinion on such changes, the Chairman must arrange a meeting.

Where reference is made hereinafter to the Opposition Division, this should be taken to mean the primary examiner where such a member has been appointed and insofar as he is entitled to act alone under the EPC.

7. Allocation of individual duties

Rule 11(3)

The President of the EPO may entrust to employees who are not technically or legally qualified examiners the execution of individual duties falling to the Examining Divisions or to the Opposition Divisions and involving no technical or legal difficulties. Insofar as such duties affect the public, their allocation will be notified in the Official Journal of the EPO (see Special edition No. 3, OJ EPO 2007, F.2).

The formalities officers entrusted with these duties are also in charge of fixing the amount of the costs (see IX, 2.1).

Chapter III

Opposition

1. Time allowed for filing notice of opposition

Within nine months from the publication of the mention of the grant of the European patent, notice of opposition has to be given to the EPO in Munich, The Hague or Berlin. *Art. 99(1)*

For expiry of the time limit see E-VIII, 1.4. Re-establishment of rights in respect of unobserved time limits for opposition is not possible in the case of an opponent (see, however, E-VIII, 2.2.2).

2. Opposition fee

The amount of the opposition fee specified in the Rules relating to Fees under the EPC must be paid before expiry of the time limit for opposition. *Art. 99(1)*

An opposition filed in common by two or more persons, which otherwise meets the requirements of Art. 99 and Rules 3 and 76, is admissible on payment of only one opposition fee (see G 3/99, OJ 7/2002, 347).

As regards the legal consequences and the procedure where the fee is not paid in good time, see IV, 1.2.1(i) and IV, 1.4.1.

For reduction of the opposition fee, see A-XI, 9.2.4.

3. Submission in writing

3.1 Form of the opposition

The notice of opposition must be filed in writing and should be typewritten or printed, with a margin of about 2.5 cm on the left hand side of each page. It would be appropriate if the notice of opposition also satisfied the requirements laid down in Rule 49(3). *Rule 86* *Rule 50(2)* *Rule 49(3)*

3.2 Notices of opposition filed by fax

Notice of opposition may also be filed by fax. At the invitation of the EPO, written confirmation reproducing the contents of the fax and complying with the requirements of the Implementing Regulations - in particular properly signed - must be supplied. If the opponent fails to comply with this invitation in due time, the fax is deemed not to have been received (see A-IX, 2.5). The opposition fee must in any case be paid within the opposition period. *Rule 2*

3.3 Signature of the notice of opposition

The notice of opposition must be signed by the person responsible, i.e. by the opponent or, where appropriate, by his representative (see also IV, 1.2.1(ii), and A-IX, 1). *Rule 50(3)* *Rule 2*

Initials or other abbreviated forms will not be accepted as a signature.

Where the notice of opposition is filed by fax, the reproduction on the facsimile of the signature of the person filing the notice of opposition will be considered sufficient.

If the signature is omitted, the formalities officer must request the party, or where appropriate his representative, to affix his signature within a time limit to be laid down by the formalities officer. If signed in due time, the document retains its original date of receipt; otherwise it is deemed not to have been received (see IV, 1.2.1(ii) and 1.4.1).

4. Derogations from language requirements

Derogations from language requirements for written opposition proceedings are dealt with in A-VIII, 2, and for oral opposition proceedings in E-V.

5. Grounds for opposition

Art. 99(1)
Rule 76(1)

A written reasoned statement of the grounds for opposition must be filed within the opposition period.

Art. 100

Opposition may only be filed on the grounds that:

Art. 100(a)

(i) the subject-matter of the European patent is not patentable within the terms of Art. 52 to 57, because it

- is not new (Art. 52(1), 54, 55),
- does not involve an inventive step (Art. 52(1), 56),
- is not susceptible of industrial application (Art. 52(1), Art. 57),
- is not regarded as an invention under Art. 52(1) to (3), or
- is not patentable under Art. 53;

Art. 100(b)

(ii) the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (cf. Art. 83);

Art. 100(c)

(iii) the subject-matter of the European patent extends beyond the content of the application as filed, or, if the patent was granted on a divisional application or on a new application filed in accordance with Art. 61 (new application in respect of the invention by the person adjudged in a final decision to be entitled to the grant of a European patent), beyond the content of the earlier application as filed (cf. Art. 123(2)).

(See also V, 3 to 5, and C-IV.)

Note that each single condition mentioned above forms an individual legal basis for objection to the maintenance of the patent. Consequently, each such condition is to be regarded as a separate ground of opposition (see G 1/95 and G 7/95, OJ 11/1996, 615 and 626).

The following allegations, for example, do not constitute grounds for opposition: that national rights of earlier date exist which put the patentability of the invention in question (see, however, IV, 5.3, and VII, 4.4), that the proprietor of the patent is not entitled to the European patent, that the subject-matter of the patent lacks unity, that the claims are not supported by the description (unless it is also argued that the claims are so broadly worded that the description in the specification does not sufficiently disclose the subject-matter within the meaning of Art. 100(b)), that the form and content of the description or drawings of the patent do not comply with the provisions as to formal requirements as set forth in Rules 42 and 46, or that the designation of the inventor is incorrect. Nor does the simple allegation that priority has been wrongly claimed constitute a ground for opposition. However, the matter of priority must be subjected to a substantial examination in the course of opposition proceedings if prior art is invoked in connection with a ground for opposition under Art. 100(a) in relation to which the priority date is of decisive importance (see C-IV, 6 and 7, and C-V, 2).

6. Content of the notice of opposition

The notice of opposition must contain:

(i) the name, address and nationality of the opponent and the State in which his residence or principal place of business is located. Names of natural persons must be indicated by the person's family name and given name(s), the family name being indicated before the given name(s). Names of legal entities, as well as companies considered to be legal entities by reason of the legislation to which they are subject, must be indicated by their official designations. Addresses must be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address. They must comprise all the relevant administrative units, including the house number, if any. It is recommended that the telephone and fax number be indicated (see IV, 1.2.2.2(i), and IV, 1.4.2); *Rule 76(2)(a)* *Rule 41(2)(c)*

(ii) the number of the European patent against which opposition is filed, the name of the proprietor and the title of the invention (see IV, 1.2.2.2(ii), and IV, 1.4.2); *Rule 76(2)(b)*

(iii) a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based as well as an indication of the facts, evidence and arguments presented in support of these grounds (see IV, 1.2.2.1(iii), (iv), (v), and IV, 1.4.2). However, in order to streamline opposition *Rule 76(2)(c)*

procedure it is recommended that a single copy of any written evidence be submitted as soon as possible and ideally with the notice of opposition (see IV, 1.2.2.1(v), last two paragraphs);

Rule 76(2)(d) (iv) if the opponent has appointed a representative, his name and the address of his place of business in accordance with the provisions of sub-paragraph (i) as set out above (see IV, 1.2.2.2(iii), and IV, 1.4.2).

IV, 1, sets out further details and explains how to deal with the opposition if one of these requirements is not fulfilled.

Chapter IV

Procedure up to substantive examination

1. Examination for deficiencies in the notice of opposition and communications from the formalities officer arising from this examination

1.1 Forwarding of the notice of opposition to the formalities officer

The notice of opposition must be forwarded directly to the formalities officer, who then places it in the files of the European patent concerned in accordance with the relevant administrative instructions and communicates it without delay to the proprietor for information. If a notice of opposition is received prior to the publication of the mention of the grant of the European patent, the formalities officer informs the opponent that for that reason his document cannot be treated as an opposition. This document becomes part of the files and, as such, is also available for inspection under Art. 128(4), and is brought to the attention of the applicant for or the proprietor of the patent as an observation by a third party in accordance with Art. 115 (for details, see E-VI, 3). If an opposition fee has been paid, it will in this case be refunded.

Examinations, observations, communications and, where appropriate, invitations to the parties will be the responsibility of the formalities officer who has been entrusted with this task of the Opposition Division (see II, 7).

1.2 Examination for deficiencies in the notice of opposition

After notice of opposition has been given, the formalities officer examines whether any deficiencies exist.

1.2.1 Deficiencies which, if not remedied, lead to the opposition being deemed not to have been filed

The following deficiencies fall into this category:

(i) the opposition fee or a sufficient amount of the fee has not been paid in the course of the opposition period (Art. 99(1)). However, if the opposition fee, apart from a small amount (e.g. deducted as bank charges), has been paid within the opposition period, the formalities officer examines whether the amount lacking can be overlooked where this is justified. If the formalities officer concludes that the amount lacking can be overlooked, the opposition fee is deemed to have been paid and there is no deficiency in the present sense;

Art. 7 RFees
Art. 8(1) RFees

(ii) the document giving notice of opposition is not signed and this is not rectified within the period set by the formalities officer,

which is fixed at two months as a rule (see E-VIII, 1.2) (Rule 50(3)).

In the case of Art. 133(2) (see also IV, 1.2.2.2(iv)), the above applies where a professional representative has been appointed within the prescribed time limit but the notice of opposition has not been signed by the representative and he has failed to remedy such deficiency either by signing it or by approving it in writing;

(iii) where a notice of opposition is filed by fax and written confirmation reproducing the contents of the fax, if requested by Formalities, is not supplied in due time (Rule 2(1) and Decision of the President of the EPO, Special edition No. 3, OJ EPO 2007, A.3);

(iv) where a notice of opposition is filed by the representative or employee of an opponent, and the authorisation, if any is required (see A-IX, 1.5, and the Decision of the President of the EPO in Special edition No. 3, OJ EPO 2007, L.1), is not supplied in due time (Rule 152(1) to (3) and (6)); and

(v) the Opposition is submitted within the opposition period but not in an official language of the EPO, as specified in Rule 3(1), or if Art. 14(4) applies to the opponent, the translation of the elements referred to in Rule 76(2)(c) is not submitted within the opposition period (see also A-VIII, 2, G 6/91, OJ 9/1992, 491, and T 193/87, OJ 4/1993, 207). This period is extended where the one-month period as required under Rule 6(2) expires later. This deficiency is present if the opposition is not filed in English, French or German or if, for example, an opponent from Belgium files his opposition in time in Dutch but fails to file the translation of the essential elements into English, French or German within the above-mentioned time limits.

For oppositions which, upon submission, are deemed not to have been filed because of deficiencies as described above, see the further procedure as described in IV, 1.3.1, 1.3.3 and 1.4.1.

1.2.2 Deficiencies which, if not remedied, lead to the opposition being rejected as inadmissible

Only such oppositions as are deemed to have been filed will be examined for deficiencies under Rule 77(1) and (2).

If the formalities officer is not sure whether the opposition in question contains a deficiency under Rule 76(2)(c), he will submit the file to the Opposition Division for checking. He will do this in particular if the opposition alleges non-patentability under Art. 52, 54 and 56 and the relevant prior art has been made available to the public by means other than by written description, or if taking of evidence has been requested in accordance with Rule 117.

In this connection the Opposition Division will also examine the extent to which it is necessary for the formalities officer to request the opponent to submit evidence (see IV, 1.2.2.1(v)).

1.2.2.1 Deficiencies under Rule 77(1)

The following deficiencies fall into this category:

(i) the notice of opposition is not filed in writing with the EPO in Munich or its branch at The Hague or its sub-office in Berlin within the nine-month opposition period, calculated from the date of publication of the mention of the grant of the European patent in the European Patent Bulletin (Art. 99(1));

Accordingly, the opposition is deficient if, for example, notice of opposition is submitted to the EPO belatedly, i.e. after expiry of the nine-month period, or where the opposition is notified within the opposition period but only verbally in a telephone call officially noted in the files. This category of deficiency also includes oppositions which, notwithstanding Art. 99(1), are filed with the central industrial property office of a Contracting State or an authority thereunder and not forwarded by these offices either at all or in time for them to be received by the EPO before the expiry of the opposition period. There is no legal obligation upon these offices or authorities to forward oppositions to the EPO.

(ii) the notice of opposition does not provide sufficient identification of the European patent against which opposition is filed;

Such a deficiency exists if the EPO is unable to identify the relevant patent on the basis of the particulars in the notice of opposition; for example, if only the proprietor of the contested patent and perhaps the title of the invention for which the patent was granted are mentioned in the notice of opposition. Such particulars alone are not an adequate description of the contested European patent, unless the proprietor of the patent who alone is named possesses only one patent or possesses several patents, the subject-matter of only one of which fits the title of the invention given in the notice of opposition, being clearly distinct from the subject-matter of the other patents which this proprietor holds. A mere indication of the number of the contested European patent in the notice of opposition constitutes sufficient identification of the patent concerned, provided that no conflicting information is given, e.g. an inconsistent name for the proprietor, and the conflict cannot be resolved from the information given.

(iii) the notice of opposition contains no statement of the extent to which the European patent is opposed; *Rule 76(2)(c)*

Such a deficiency is present if it is not clear from the requisite statement whether the opposition is directed against the entire subject-matter of the patent or only a part of it, i.e. whether it is directed against all the claims or only against one or a part of one claim, such as an alternative or embodiment;

Rule 76(2)(c) (iv) the notice of opposition contains no statement of the grounds on which the opposition is based;

A notice of opposition contains such a deficiency if it does not mention at least one of the grounds for opposition referred to in Art. 100 (see III, 5). If non-patentability is given as a ground for opposition, the statement of grounds must at least implicitly indicate which conditions for patentability (Art. 52 to 57) are considered not to have been fulfilled.

Art. 99(1)
Rule 76(2)(c) (v) the notice of opposition does not indicate the facts, evidence and arguments presented in support of the opposition;

An opposition is adequately substantiated only if in respect of at least one of his grounds for opposition the opponent adduces facts, evidence and arguments establishing a possible obstacle to patentability under the EPC. He must indicate the technical context and the conclusions he has drawn from it. The content of the statement of grounds must be such as to enable the patent proprietor and the Opposition Division to examine the alleged ground for revocation without recourse to independent enquiries. Unsubstantiated assertions do not meet this requirement. Nor as a rule is mere reference to patent documents enough; unless the document is very short the opponent must indicate on which parts his opposition is based. Where there are allegations that use or oral description are comprised in the state of the art, the Opposition Division must be supplied with an indication of the facts, evidence and arguments necessary for determination of the matters set out under V, 3.1.2 and 3.2.3. See also in this respect T 328/87, OJ 12/1992, 701.

If, where there are multiple grounds for opposition, the facts, evidence and arguments for one ground are sufficiently indicated, the opposition is admissible, even if the facts, evidence and arguments in support of the other grounds for opposition are submitted belatedly. Such belated facts, evidence and arguments are in that event dealt with in accordance with E-VI, 2.

It is immaterial, as far as the question of admissibility of an opposition is concerned, whether and to what extent the facts, evidence and arguments submitted in due time actually warrant revocation of the contested European patent or its maintenance in amended form. On the one hand, an unconvincing ground of opposition may have been clearly

presented and argued (making the opposition admissible), whereas conversely a deficient submission may have been rejected as inadmissible even though, if properly drafted, it could have succeeded (see also T 222/85, OJ 4/1988, 128).

An indication of at least one ground of opposition and of the facts, evidence and arguments on which it is based fulfils the prerequisites for admissibility of the opposition in this respect. The evidence itself can also be produced after the expiry of the opposition period. Because of the long opposition period (9 months) it is however recommended, in order to expedite the opposition proceedings, that a single copy of any written evidence indicated in the notice of opposition be submitted as soon as possible and ideally with the notice of opposition. *Rule 76(2)(c)* *Rule 83*

Otherwise, if his opposition is admissible, the opponent will be invited to supply such evidence as soon as possible and as a rule within two months. If the documents thus requested are neither enclosed nor filed within the time limit set, the Opposition Division may decide not to take into account any arguments based on them. (As regards facts or evidence not submitted in due time and arguments presented at a late stage see E-VI, 2, and E-III, 8.6.)

(vi) the opposition does not indicate beyond any doubt the identity of the person filing the opposition (Art. 99(1), Rule 76(2)(a)). *Art. 99(1)* *Rule 76(2)(a)*

1.2.2.2 Deficiencies under Rule 77(2)

The following deficiencies fall within this category:

(i) the notice of opposition does not state the name, address and nationality of the opponent and the State in which his residence or principal place of business is located in the prescribed manner (see III, 6(i)); *Rule 76(2)(a)*

(ii) the number of the European patent against which the opposition is filed or the name of the proprietor of the patent or the title of the invention is not indicated; *Rule 76(2)(b)*

Each of the particulars listed in (ii) above must be supplied within the time limit set by the formalities officer (see IV, 1.3.2), even if the contested European patent may be identified by means of one of these or other particulars within the opposition period (see IV, 1.2.2.1(ii)). If the name of the proprietor of the patent as indicated by the opponent is not the same as that recorded in the Register, the formalities officer will inform the opponent of the proprietor's correct name.

(iii) where the opponent has appointed a representative, the name or the address of the place of business of such representative *Rule 76(2)(d)*

is not indicated in the notice of opposition in the prescribed manner (see III, 6(iv));

(iv) the opponent has neither his residence nor his principal place of business in one of the Contracting States (Art. 133(2)) and has not communicated the appointment of a professional representative (Art. 134). In the communication requesting him to remedy such deficiency the opponent must also be asked to arrange for the signature or approval of the notice of opposition by the representative to be appointed; and

Rule 86

(v) the notice of opposition fails to satisfy further formal requirements other than those mentioned in Rule 77(1). For instance, it may fail to comply with the provisions of Rule 50(2) without due justification.

1.3 Issue of communications by the formalities officer as a result of examination for deficiencies

Art. 14(4)
Rule 2(1)
Rule 3(1)
Rule 6(2)
Rule 50(3)
Rule 77(1) and (2)
Rule 152(1) to (3)

If, in the course of his examination as described in IV, 1.2, the formalities officer notes deficiencies which may still be remedied, and if there are no deficiencies which may no longer be remedied (in the case of deficiencies which may no longer be remedied see IV, 1.4), he will issue the communications described in IV, 1.3.1 and/or 1.3.2, to the opponent, if possible in a single communication.

1.3.1 Communication in the event of deficiencies as described in IV, 1.2.1, which, if not remedied, will lead to the opposition being deemed not to have been filed

The communication will indicate the deficiencies noted in accordance with IV, 1.2.1, and will state that the opposition will be deemed not to have been filed unless the deficiency or deficiencies are remedied within the time limits indicated in IV, 1.2.1.

1.3.2 Communication in the event of deficiencies as described in IV, 1.2.2, which, if not remedied, will lead to rejection of the opposition as inadmissible

The communication will indicate the deficiencies noted in accordance with IV, 1.2.2.1 or 1.2.2.2, and will state that the opposition will be rejected as inadmissible unless the deficiencies as described in IV, 1.2.2.1, are remedied within the opposition period and unless the deficiencies as described in IV, 1.2.2.2, are remedied within the period stipulated by the formalities officer.

1.3.3 Extent of the formalities officer's obligation to issue the above communications

Although the formalities officer is not obliged to do so, he should notify the opponent of deficiencies as described in IV, 1.2.1(i), (iii) and (iv), and IV, 1.2.2.1, in good time before the expiry of the time-limits within which it is still possible to remedy the deficiencies. However, the opponent can seek no legal remedy against failure to issue these communications, which should be regarded merely as a service

afforded the opponent by the EPO so as largely to obviate any adverse legal consequences. Deficiencies as described in IV, 1.2.1(ii) and 1.2.2.2, must in any event be officially notified to the opponent, since this is a statutory requirement. Should this communication inadvertently be omitted notwithstanding deficiencies of this type in the notice of opposition, the opponent may submit the missing particulars on his own initiative at any time, even after the expiry of the opposition period without suffering adverse legal consequences.

1.4 Subsequent procedure in the event of deficiencies which may no longer be remedied

Rule 112(1)

1.4.1 Deficiencies which may no longer be remedied, as a result of which the opposition is deemed not to have been filed

If the formalities officer establishes that the deficiencies referred to in IV, 1.2.1, have not been remedied within the time limits laid down in the EPC or by the EPO, he will inform the opponent in accordance with Art. 119 that the notice of opposition is deemed not to have been filed and that a decision may be applied for under the terms of Rule 112(2) (see E-VIII, 1.9.3). If no such application is made within the prescribed period of two months after notification of this communication, and if there is no other valid opposition pending, the proceedings are closed and the parties informed accordingly. Any opposition fees which have been paid are refunded. The file is returned to the patent registry.

Documents submitted with a notice of opposition which is deemed not to have been filed will form part of the file and will thus be available for inspection in accordance with Art. 128(4). They will be regarded as observations by third parties under Art. 115 (see in this connection V, 2, and E-VI, 3). If a further admissible opposition is pending, the proceedings are continued in respect of it.

1.4.2 Deficiencies which may no longer be remedied in accordance with Rule 77(1) and (2), resulting in the opposition being rejected as inadmissible

If there are no deficiencies of the type referred to in IV, 1.4.1, but a notice of opposition which is deemed to have been filed reveals deficiencies under the terms of Rule 77(1) (see IV, 1.2.2.1) which may no longer be remedied and which have not been communicated to the opponent in accordance with IV, 1.3.2 (because the opposition period has already expired), the formalities officer must, by virtue of Art. 113(1), notify the opponent of these deficiencies, allowing him time in which to submit comments (normally two months), and point out to him that the notice of opposition is likely to be rejected as inadmissible.

If the opponent does not refute the opinion expressed by the formalities officer on the existence of deficiencies which may no longer be corrected or has failed to remedy in good time deficiencies which may be corrected (Rule 77(2)) and which were communicated

to him pursuant to IV, 1.3.2, the formalities officer will reject the notice of opposition as inadmissible, except in the case mentioned in IV, 1.2.2.1(v) (for which the Opposition Division is competent to decide, see the Decision of the President of the EPO concerning the entrustment to non-examining staff of certain duties normally the responsibility of the examining or opposition divisions, dated 12 July 2007, Special edition No. 3, OJ EPO 2007, F.2). As regards the form of the decision, see E-X, 4 and 5.

In all other cases the formalities officer will submit the opposition documents to the directorate responsible for the European patent in suit (for designation of an Opposition Division, see IV, 2).

The decision declaring the opposition inadmissible under Rule 77(1) or (2) can be taken without the participation of the proprietor of the patent in accordance with Rule 77(3). However, for reasons of procedural economy, the substantive examination is in fact initiated if at least one further admissible opposition is pending. The proprietor of the patent may also comment on the admissibility of the former opposition in the course of that examination.

When the decision declaring the opposition inadmissible has become final the opponent concerned is no longer a party to the proceedings.

1.5 Notifications to and observations by the proprietor

Communications and decisions in the course of the examination as to whether the opposition is deemed to have been filed and is admissible are also notified to the proprietor of the patent. If he files observations on his own initiative concerning such a communication, they may be taken into account in the decision.

1.6 Subsequent procedure

For the subsequent procedure in the event of one or more oppositions with no deficiencies see IV, 5.2.

2. Activity of the Opposition Division

Art. 19(2)

The formalities officer submits the files to the competent directorate on expiry of the periods specified in IV, 5.2, 5.3 and 5.5 and in the remaining cases (see IV, 1.4.2) immediately.

The director responsible will then designate the three technical members of the competent Opposition Division. The Opposition Division will decide whether one of its members – and if so, which – is to be entrusted with the examination of the opposition up to the taking of a decision (see II, 5). The technical members of the Division should not be designated if the opposition is rejected as inadmissible by the formalities officer and no further admissible opposition has been filed (see IV, 1.4.2).

3. Rejection of the opposition as inadmissible by the Opposition Division, the proprietor of the patent not being a party

(For rejection of the opposition as inadmissible at a later stage, the proprietor of the patent being a party, see IV, 5.1 and 5.5)

In cases of insufficient substantiation, where the formalities officer is not competent to decide on the inadmissibility (see IV, 1.2.2.1(v)), the Opposition Division will either:

(i) issue the decision rejecting the opposition as inadmissible (when the formalities officer has already informed the opponent of this deficiency pursuant to IV, 1.3.2); or

(ii) consider the opposition admissible and continue with examination of the opposition (see V); or

(iii) communicate its findings to the opponent in question and at the same time request him to submit observations.

If the opponent does not refute the opinion expressed by the Opposition Division on the existence of these deficiencies which may no longer be corrected, the Opposition Division will reject the notice of opposition as inadmissible. As regards the form of the decision, see E-X, 4 and 5.

The decision will be communicated to the other parties. An inadmissible opposition or documents produced in support of an inadmissible opposition will be placed in the files and will therefore be available for inspection in accordance with Art. 128(4). As regards the possibility of taking them into consideration as observations by third parties, see V, 2, and E-VI, 3. If there are further admissible oppositions, for reasons of procedural economy this decision to reject the opposition as inadmissible will normally be taken at the end of the procedure together with the decision on the admissible oppositions.

For the possibility of appeal by the opponent and other possible means of redress, see E-XI, 1 and 7.

4. Termination of opposition proceedings in the event of inadmissible opposition

Under the terms of Art. 101(1) and Rule 79(1), the examination as to whether the European patent can be maintained can only be performed if at least one admissible opposition has been filed. This means that the Opposition Division has to refrain from commenting on the substantive merits of the opposition when expressing an opinion on its inadmissibility if there is no further admissible opposition (see T 925/91, OJ 7/1995, 469). Opposition proceedings are terminated once all notices of opposition filed against a European patent have been rejected as inadmissible and the last decision in this respect has become final. This will be communicated to the parties.

5. Preparation of substantive examination

5.1 Inadmissibility at a later stage

Since the admissibility of an opposition is always open to question by the proprietor, no separate communication that the opposition is admissible will be sent to the opponent or the proprietor of the patent. Where deficiencies on the basis of which the notice of opposition is likely to be regarded as inadmissible, but of which the opponent has not been informed by the formalities officer, come to the attention of the Opposition Division in the opposition documents submitted to it or because the proprietor has raised the issue at any stage of the proceedings, it will inform the parties about its reservations in a communication and at the same time request the opponent in question to submit observations. If deficiencies within the meaning of Rule 77(2) are involved, it is sufficient to specify a period for the opponent to remedy such deficiencies.

If the opponent does not refute the opinion expressed by the Opposition Division on the existence of these deficiencies which may no longer be corrected or fails to remedy in good time deficiencies which may be corrected, the Opposition Division will reject the notice of opposition as inadmissible. As regards the form of the decision, see E-X, 4 and 5. For subsequent procedure, see the last two paragraphs of IV, 3.

5.2 Invitation to the proprietor of the patent to submit comments and communication of opposition to the other parties concerned by the formalities officer

Rule 79(1) and (2)

If the formalities officer considers that no further ex-officio objection to the admissibility of each or the only opposition remains, he will invite the proprietor of the patent, immediately after expiry of the opposition period or the period laid down by the formalities officer for the remedying of the deficiencies in accordance with Rule 77(2) (see IV, 1.2.2.2), or for the presentation of evidence (see IV, 1.2.2.1(v)), to file his observations concerning the oppositions communicated earlier and to file amendments, where appropriate, to the description, claims and drawings within a period to be fixed by the formalities officer (normally four months). This also applies to oppositions where a decision to the effect that they are deemed not to have been filed or are inadmissible has not yet been taken or has not yet become final.

If several notices of opposition have been filed, the formalities officer will communicate them to the other opponents at the same time as the communication provided for in the previous paragraph. This will not be combined with an invitation to file observations or the setting of a time limit.

5.3 Filing of amended documents in reply to the notice of opposition

Rule 80

Any amendments made in opposition proceedings must be occasioned by the grounds for opposition specified in Art. 100. That is to say, amendments are admissible only if they are required in order to meet a ground for opposition. However, the ground for opposition does not actually have to have been invoked by the opponent. For example, in opposition proceedings admissibly opened on grounds of non-patentability, the patent proprietor can also submit amendments to remove added subject-matter. Opposition proceedings cannot be used merely to tidy up and improve the disclosure in the patent specification (see T 127/85, OJ 7/1989, 271). The mere addition of new claims to the claims as granted is inadmissible because such amendments cannot be said to meet a ground of opposition. However, the replacement of one independent claim as granted by multiple, e.g. two, independent claims each directed to a respective specific embodiment covered by the independent claim as granted is admissible if such a replacement is occasioned by grounds of opposition specified in Art. 100 (T 223/97, not published). Apart from the above, amendments occasioned by national rights of earlier date are admissible pursuant to Rule 138 (see also C-IV, 8, with the exception of withdrawing the designation, and the reference in VII, 4.4, to C-III, 8.4).

If the proprietor proposes amendments to the patent in reply to the grounds of opposition and the Opposition Division intends to maintain the patent in amended form, pursuant to those grounds, other amendments, not related to the grounds of opposition (e.g. corrections, clarifications), may be allowed provided that the patent thus amended still fulfils the requirements of the EPC. Such amendments, however, should not be proposed by the Opposition Division and they can only be taken into consideration up to the pronouncement of the decision (in oral proceedings) or until the date the decision is handed over to the EPO's internal postal service for transmittal to the parties (in written proceedings) (see G 12/91, OJ 5/1994, 285).

The amended documents should, provided that it is not irrelevant at the stage reached in the procedure, be as complete as possible and drawn up in such a way as to allow the European patent, where appropriate, to be maintained without further delay in the amended version.

These considerations apply also to documents of second preference in which the proprietor proposes amendments for consideration by the Opposition Division only if the Division is unable to grant his main request, for example that the opposition should be rejected. In both cases, however, it will be more convenient in certain circumstances to determine first the form of the claims, leaving purely consequential amendments in the description to be dealt with later.

Care must be taken to ensure that any amendments do not offend against Art. 123(2) and (3) (see V, 5 and 6). The proprietor of the patent should, where this is not obvious, indicate the points in the original application documents or claims of the granted patent from which the amendments may be derived (Art. 100(c) and Art. 123(2)). In addition, he should file observations as regards the patentability of the subject-matter of the patent as amended (with reference to Art. 100(a) and 100(b)), taking into account the state of the art and objections raised in the opposition notice together, where appropriate, with the evidence presented in support. It must also be checked that the patent, by the amendments **themselves**, does not contravene the requirements of the EPC (with the exception of Art. 82, see V, 2). For the form of amended documents, see E-II.

5.4 Communication of observations from one of the parties to the other parties

Rule 79(3)
Rule 81(2)

The formalities officer will, at any stage in the procedure, immediately communicate the observations of any of the parties to the other parties for information.

If the proprietor of the patent files amended documents with his observations, where applicable as part of an alternative request, the formalities officer will invite the other parties to submit observations within a period to be fixed by him (normally four months).

If the Opposition Division considers that observations are called for in the course of the further procedure, a separate invitation is issued and a period is fixed (normally four months), with or without a communication stating the grounds.

5.5 Decision concerning the admissibility of an opposition, the proprietor of the patent being a party

If the proprietor of the patent, when replying to the notice of opposition, contends that the opposition is inadmissible pursuant to Rule 77(1) and (2), because of deficiencies which are to be specified, the opponent concerned must be given the opportunity to submit his comments within a period fixed by the formalities officer (two months).

If the Opposition Division concludes that the opposition is inadmissible, it must as a rule first take a reasoned decision, which is appealable. If, on the other hand, on the basis of another – admissible – opposition, an immediate decision can be taken on the rejection of the opposition or oppositions or on the revocation of the patent, the decision on admissibility is to be taken together with this final decision.

If, despite the observations of the proprietor of the patent, the Opposition Division concludes that the opposition is admissible, the decision on admissibility is normally to be taken together with the final decision, especially where at least one other admissible opposition exists. If there are only oppositions where the admissibility is doubtful,

a reasoned intermediate decision should be issued, which is appealable, provided that this will not unduly delay the proceedings.

An opponent whose opposition has been finally rejected as inadmissible is no longer a party to the subsequent proceedings once this decision becomes final.

5.6 Examination of the admissibility of an intervention and preparations in the event of an intervention

When examining whether an intervention is admissible, the formalities officer and the Opposition Division should proceed as for the examination as to admissibility of an opposition (see IV, 1, 3 and 5.5) but on the basis of the requirements for intervention under Art. 105 and Rule 89. *Rule 79(4)*

Paragraphs IV, 5.2 and 5.4 may, however, be disregarded in the case of an application for intervention in opposition proceedings. *Rule 86*

Accordingly, particularly in the case of proceedings which are at an advanced stage, the formalities officer will inform third parties who have intervened of the progress of the proceedings and request them to indicate within one month whether they will also require the documents received from the parties in accordance with Rule 79(1), (2) and (3), together with the communications from the Opposition Division and the observations of the parties under Rule 81(2), for the preceding period. If this is the case, the formalities officer should send them with the relevant communications from the Opposition Division or the formalities officer to the intervening third party.

Chapter V

Substantive examination of opposition

1. Beginning of the examination of the opposition

Once the preparations for the examination of the opposition have been completed pursuant to Rule 79, the Opposition Division examines whether the grounds for opposition (see III, 5) laid down in Art. 100 prejudice the maintenance of the European patent. The examination may also begin if a single admissible opposition has been withdrawn in the interim (see VII, 6.3). If the opponent has died or is legally incapacitated, the examination may begin even without the participation of the heirs or legal representatives (see VII, 6.2).

Art. 101(1)

2. Extent of the examination

2.1 Extent to which the patent is opposed

In the unusual case where an opposition is limited to only a certain part of the patent, the Opposition Division has to limit its examination to the part opposed. However, if the opposition is directed only to an independent claim, the dependent claims are considered to be implicitly covered by the extent of the opposition and may be examined by the Opposition Division, provided their validity is prima facie in doubt on the basis of the information already available (see G 9/91, OJ 7/1993, 408). Similarly, if only a process claim is opposed, a product-by-process claim making reference to the same process is considered to be implicitly covered by the extent of opposition and may be examined under the same conditions as above (see T 525/96, not published in OJ).

2.2 Examination of the grounds for opposition

As a general rule, the Opposition Division will confine its examination to those grounds for opposition brought forward by the opponent. If, for example, the opposition is filed only on the grounds that the subject-matter of the European patent is not adequately disclosed or that it extends beyond the content of the patent application as filed, the Opposition Division will examine the patentability of the subject-matter of the European patent pursuant to Art. 52 to 57 only if facts have come to its notice which, **prima facie**, wholly or partially prejudice the maintenance of the patent (see G 10/91, OJ 7/1993, 420).

If, therefore, once the proceedings for examining the opposition(s) have been initiated, because an admissible opposition has been filed (although it may have been withdrawn in the interim), there is reason to believe that other grounds exist which, prima facie, in whole or in part prejudice the maintenance of the European patent, these grounds should generally be examined by the Opposition Division of its own motion pursuant to Rule 81(1). Such other grounds may result from facts emerging from the search report or the examination

Rule 81(1)
Art. 114

procedure, the examiner's personal knowledge or observations presented by third parties pursuant to Art. 115 (see also E-VI, 3). Such grounds may also have been put forward in another opposition which has been rejected as inadmissible, or in another opposition deemed not to have been filed. They may also be any grounds submitted belatedly (see E-VI, 1.1 and 2). Under Art. 114(1), such prejudicial grounds put forward in an opposition which has been withdrawn should also generally be examined by the Opposition Division of its own motion. In carrying out such examination the Opposition Division should, however, take the interests of procedural expediency into account (see E-VI, 1.2). If the decision is to be based on grounds to be taken into account pursuant to Art. 114(1) or Rule 81(1), the parties must be given the opportunity to comment (see E-X, 1).

Pursuant to Art. 100, the absence of unity of invention is not a ground for opposition (see III, 5).

Art. 82

Since unity of invention under Art. 82 is only required for the European patent application, the unity of the subject-matter of the European patent may not be examined by the Opposition Division, even of its own motion. In particular, where the facts, evidence and arguments which come to light in the opposition proceedings lead to the maintenance of the European patent in amended form, there should be no further examination as to whether the remaining subject-matter of the patent contains a single invention or more than one. Any lack of unity must be accepted (see G 1/91, OJ 6/1992, 253).

The grounds for opposition laid down in Art. 100 are examined in greater detail below.

3. Non-patentability pursuant to Art. 52 to 57

Art. 100(a)

The same substantive requirements apply in the opposition procedure regarding patentability pursuant to Art. 52 to 57 as in the examination procedure. Part C, Chapter IV, should therefore also be applied in opposition proceedings. However, it will be more common in opposition proceedings than in examination procedure for the examination as to patentability to be based on the state of the art as made available to the public not by written description but "by means of an oral description, by use, or in any other way" (see Art. 54(2)). The above-mentioned ways in which the state of the art may be made available to the public will accordingly be considered in more detail below.

3.1 State of the art made available to the public "by use or in any other way"

3.1.1 Types of use and instances of state of the art made available in any other way

Use may be constituted by producing, offering, marketing or otherwise exploiting a product, or by offering or marketing a process or its application or by applying the process. Marketing may be effected, for example, by sale or exchange.

The state of the art may also be made available to the public in other ways, as for example by demonstrating an object or process in specialist training courses or on television.

Availability to the public in any other way also includes all possibilities which technological progress may subsequently offer of making available the aspect of the state of the art concerned.

3.1.2 Matters to be determined by the Opposition Division as regards use

When dealing with an allegation that an object or process has been used in such a way that it is comprised in the state of the art, the Opposition Division will have to determine the following details:

(i) the date on which the alleged use occurred, i.e. whether there was any instance of use before the relevant date (prior use);

(ii) what has been used, in order to determine the degree of similarity between the object used and the subject-matter of the European patent; and

(iii) all the circumstances relating to the use, in order to determine whether and to what extent it was made available to the public, as for example the place of use and the form of use. These factors are important in that, for example, the details of a demonstration of a manufacturing process in a factory or of the delivery and sale of a product may well provide information as regards the possibility of the subject-matter having become available to the public.

On the basis of the submissions and the evidence already submitted, e.g. documents confirming sale, or affidavits related to the prior use, the Opposition Division will first establish the relevance of the alleged prior use. If on the basis of this assessment it is of the opinion that the prior use is sufficiently substantiated and relevant, it may decide on the opposition using the submissions and the evidence, if the patentee does not contest the prior use. If the patentee does contest it or certain circumstances of it, the Division will need to take further evidence, if offered (e.g. hearing witnesses or performing an inspection) for those facts which are relevant to the case and which cannot yet be considered proven on the basis of the evidence already

submitted. Evidence is always taken under participation of the parties, normally in oral proceedings. For details concerning means of evidence see E-IV, 1.2.

3.1.3 Ways in which subject-matter may be made available

The publication dates of internet disclosures submitted by a party to opposition proceedings are assessed according to the same principles as are applied in examination proceedings, i.e. they should be assessed in view of the specific circumstances of the case. In particular, the timing of the submission as well as the interests of the party submitting the disclosure should also be taken into account.

3.1.3.1 General principles

Subject-matter should be regarded as made available to the public by use or in any other way if, at the relevant date, it was possible for members of the public to gain knowledge of the subject-matter and there was no bar of confidentiality restricting the use or dissemination of such knowledge (see also C-IV, 6.1 with reference to written descriptions). This may, for example, arise if an object is unconditionally sold to a member of the public, since the buyer thereby acquires unlimited possession of any knowledge which may be obtained from the object. Even where in such cases the specific features of the object may not be ascertained from an external examination, but only by further analysis, those features are nevertheless to be considered as having been made available to the public. This is irrespective of whether or not particular reasons can be identified for analysing the composition or internal structure of the object. These specific features only relate to the intrinsic features. Extrinsic characteristics, which are only revealed when the product is exposed to interaction with specifically chosen outside conditions, e.g. reactants or the like, in order to provide a particular effect or result or to discover potential results or capabilities, therefore point beyond the product per se as they are dependent on deliberate choices being made. Typical examples are the first or further application as a pharmaceutical product of a known substance or composition (cf. Art. 54(4) and (5)) and the use of a known compound for a particular purpose, based on a new technical effect (cf. G 2/88, OJ 4/1990, 93). Thus, such characteristics cannot be considered as already having been made available to the public (see G 1/92, OJ 5/1993, 277).

If, on the other hand, an object could be seen in a given place (a factory, for example) to which members of the public not bound to secrecy, including persons with sufficient technical knowledge to ascertain the specific features of the object, had access, all knowledge which an expert was able to gain from a purely external examination is to be regarded as having been made available to the public. In such cases, however, all concealed features which could be ascertained only by dismantling or destroying the object will not be deemed to have been made available to the public.

3.1.3.2 Agreement on secrecy

The basic principle to be adopted is that subject-matter has not been made available to the public by use or in any other way if there is an express or tacit agreement on secrecy which has not been broken (reference should be made to the particular case of a non-prejudicial disclosure arising from an evident abuse in relation to the applicant, in accordance with Art. 55(1)(a)), or if the circumstances of the case are such that such secrecy derives from a relationship of good faith or trust. Good faith and trust are factors which may occur in contractual or commercial relationships.

3.1.3.3 Use on non-public property

As a general rule, use on non-public property, for example in factories and barracks, is not considered as use made available to the public, because company employees and soldiers are usually bound to secrecy, save in cases where the objects or processes used are exhibited, explained or shown to the public in such places, or where specialists not bound to secrecy are able to recognise their essential features from the outside. Clearly the above-mentioned "non-public property" does **not** refer to the premises of a third party to whom the object in question was unconditionally sold or the place where the public could see the object in question or ascertain features of it (see the examples in V, 3.1.3.1 above).

3.1.3.4 Example of the accessibility of objects used

A press for producing light building (hard fibre) boards was installed in a factory shed. Although the door bore the notice "Unauthorised persons not admitted", customers (in particular dealers in building materials and clients who were interested in purchasing light building boards) were given the opportunity of seeing the press although no form of demonstration or explanation was given. An obligation to secrecy was not imposed as, according to witnesses, the company did not consider such visitors as a possible source of competition. These visitors were not genuine specialists, i.e. they did not manufacture such boards or presses, but were not entirely laymen either. In view of the simple construction of the press, the essential features of the invention concerned were bound to be evident to anyone observing it. There was therefore a possibility that these customers, and in particular the dealers in building materials, would recognise these essential features of the press and, as they were not bound to secrecy, they would be free to communicate this information to others.

3.1.3.5 Example of the inaccessibility of a process

The subject of the patent concerns a process for the manufacture of a product. As proof that this process had been made available to the public by use, a similar already known product was asserted to have been produced by the process claimed. However, it could not be clearly ascertained, even after an exhaustive examination, by which process it had been produced.

3.2 State of the art made available by means of oral description

3.2.1 Cases of oral description

Art. 54(2)

The state of the art is made available to the public by oral description when facts are unconditionally brought to the knowledge of members of the public in the course of a conversation or a lecture or by means of radio, television or sound reproduction equipment (tapes and records).

3.2.2 Non-prejudicial oral description

Art. 55(1)(a)

The state of the art will not be affected by oral descriptions made by and to persons who were bound to, and preserved, secrecy, nor by an oral disclosure which was made no earlier than six months before the filing of the European patent application and which derives directly or indirectly from an evident abuse in relation to the applicant or his legal predecessor. In determining whether evident abuse has occurred, note C-IV, 10.3.

3.2.3 Matters to be determined by the Opposition Division in cases of oral description

Once again, in such cases the following details will have to be determined:

(i) when the oral description took place;

(ii) what was described orally; and

(iii) whether the oral description was made available to the public; this will also depend on the type of oral description (conversation, lecture) and on the place at which the description was given (public meeting, factory hall; see also D-V, 3.1.2(iii)).

3.3 State of the art made available to the public in writing or by any other means

For this state of the art, details equivalent to those defined in V, 3.2.3 have to be determined if they are not clear from the written or other disclosure itself or if they are contested by a party.

If information is made available by means of a written description and use or by means of a written and oral description, but only the use or the oral description is made available before the relevant date, then in accordance with C-IV, 6.1, the subsequently published written description may be deemed to give a true account of that oral description or use, unless the proprietor of the patent can give good reason why this should not be the case. In this case, the opponent must adduce proof to the contrary in respect of the reasons given by the proprietor of the patent. Caution should be exercised when considering the type of evidence presented to substantiate the content of an oral description. For example, a report of a lecture written by the lecturer himself may not be an accurate account of

what was in fact conveyed to the public. Similarly, a script from which the lecturer purportedly read may not actually have been completely and comprehensibly read (see T 1212/97, not published in OJ).

4. Insufficient disclosure of the invention

4.1 Required form of disclosure

Determination of whether the disclosure of an invention in a European patent application is sufficient is dealt with in C-II.

The principles set out there will also apply mutatis mutandis to the opposition procedure. The overriding consideration in this context is the disclosed content of the European patent specification, that is to say what a person skilled in the art is able to infer from the patent claims, description and drawings, if any, without reflection as to inventiveness. Pursuant to Art. 100(b), the patent has to disclose the invention in a manner sufficiently clear and complete for it to be carried out by persons skilled in the art. If the patent specification does not disclose the invention sufficiently clearly to enable it to be carried out in accordance with Art. 100(b), this may be remedied, provided the original documents contained a sufficient disclosure, but subject to the condition that, as required under Art. 123(2), the subject-matter of the European patent does not extend beyond the content of the application as filed and, as required under Art. 123(3), the protection conferred is not extended.

Art. 100(b)

4.2 Disclosure of inventions relating to biological material

The relevant details in this connection can be found in C-II, 6.

Rule 31

4.3 Burden of proof as regards the possibility of performing and repeating the invention

If the Opposition Division has serious doubts as regards the possibility of performing the invention and repeating it as described, the burden of proof as regards this possibility, or at least a demonstration that success is credible, rests with the proprietor of the patent. This may be the case where, for example, experiments carried out by the opponent suggest that the subject-matter of the patent does not achieve the desired technical result. As regards the possibility of performing and repeating the invention, see also C-II, 4.11.

4.4 Cases of partially insufficient disclosure

4.4.1 Only variants of the invention are incapable of being performed

The fact that only variants of the invention, e.g. one of a number of embodiments of it, are not capable of being performed should not immediately give rise to the conclusion that the subject-matter of the invention as a whole is incapable of being performed, i.e. is incapable of resolving the problem involved and therefore of achieving the desired technical result.

Those parts of the description relating to the variants of the invention which are incapable of being performed and the relevant claims must, however, then be deleted at the request of the Opposition Division if the deficiency is not remedied. The patent specification must then be so worded that the remaining claims are supported by the description and do not relate to embodiments which have proved to be incapable of being performed.

Any failure to rectify these deficiencies without good reason will result in the patent being revoked.

4.4.2 Absence of well-known details

For the purposes of sufficient disclosure the patent does not need to describe all the details of the operations to be carried out by the person skilled in the art on the basis of the instructions given, if these details are well-known and clear from the definition of the class of the claims or on the basis of common general knowledge (see also C-II, 4.9 and C-III, 4.5).

4.4.3 Difficulties in performing the invention

An invention should not be immediately regarded as incapable of being performed on account of a reasonable degree of difficulty experienced in its performance ("teething troubles", for example).

1st example: The difficulties which could, for example, arise from the fact that an artificial hip joint could be fitted to the human body only by a surgeon of great experience and above-average ability would not prevent manufacturers of orthopaedic devices from deriving complete information from the patent with the result that they could reproduce the invention with a view to making an artificial hip joint.

2nd example: A switchable semiconductor which, according to the invention, is used for switching electrical circuits on and off without using contacts, thereby making for smoother operation, suffers from teething troubles in that a residual current continues to flow in the circuit when switched off. However, this residual current adversely affects the use of the electrical switch in certain fields only, and can otherwise be reduced to negligible proportions by routine further development of the semiconductor.

5. Subject-matter of the European patent extending beyond the original disclosure

5.1 Basis of this ground for opposition

Art. 100(c)

This ground for opposition under Art. 100(c) refers back to Art. 123(2) and stipulates that the subject-matter of a European patent may not extend beyond the content of the application as filed. In the case of a patent granted on the basis of a European divisional application (Art. 76(1)), two criteria apply: the subject-matter must not extend beyond the content of the earlier application as filed (Art. 76(1)), and it must not extend beyond the content of the divisional application as filed

(Art. 123(2)) (see T 434/97, not published in OJ). Similar considerations apply to applications filed under Art. 61. In the case of a patent granted on an application filed in a language other than an official language of the EPO either in accordance with Art. 14(2) or in accordance with Rule 40 (cf. Rule 40(3)), the original text will, as provided for in Art. 70(2), constitute the basis for determining whether the subject-matter of the European patent extends beyond the content of the application as filed. However, unless, for example, the opponent adduces proof to the contrary the Opposition Division may, under Rule 7, assume that the translation referred to in Art. 14(2) or Rule 40(3) is in conformity with the original text of the application.

5.2 Distinction between allowable and unallowable amendments

The distinction between allowable amendments to the content of a European patent application and amendments which are at variance with Art. 123(2) or Art. 76(1) has already been set forth in C-VI, 5.3 and 9.1.4. These guidelines should be applied mutatis mutandis in the course of opposition proceedings in cases where the subject-matter of the European patent as granted or as amended during the opposition proceedings extends beyond the content of the application as filed.

6. Extension of protection

6.1 General remarks

The European patent as granted or as amended in opposition proceedings determines retroactively the protection conferred by the European patent application, insofar as such protection is not thereby extended. *Art. 69(2)*

Opposition proceedings will frequently give rise to amendments to the claims, following from grounds for opposition raised under Art. 100. Reasoned requests filed independently by the proprietor of the patent for an amendment to the claims, e.g. for limitation of the patent in view of an aspect of the state of the art which has come to his knowledge, may also result in amendments to the claims after examination by the Opposition Division.

In such cases the claims of the European patent may not be amended in such a way as to extend the protection conferred by the patent. *Art. 123(3)*

The extent of protection conferred by a European patent is determined by the claims. Nevertheless, the description and drawings are to be used to interpret the claims. *Art. 69(1)*

The Protocol on the Interpretation of Art. 69, which is, pursuant to Art. 164(1), an integral part of the EPC, specifies how Art. 69 is to be interpreted.

Since, pursuant to Art. 69(1), amendments to the description and drawings will also influence the interpretation of the claims, and may therefore extend the protection conferred, any such amendments extending protection in this way are not allowable (see G 1/93, OJ 8/1994, 541).

6.2 Examination of amendments to the claims

In view of the above considerations, all amendments made to claims and any connected amendments to the description and drawings in the course of opposition proceedings, such as a change in the technical features of the invention, must be examined to determine whether such amendments could result in the extension of the subject-matter beyond the content of the application as originally filed (Art. 123(2)) or in the extension of the protection conferred (Art. 123(3)).

If, in view of Art. 84 and Art. 69, the application documents have been adapted to amended claims before grant, thereby deleting part of the subject-matter originally disclosed in order to avoid inconsistencies in the patent specification, as a rule, subject-matter deleted for this reason cannot be reinserted either into the patent specification or into the claims as granted without infringing Art. 123(3) (the cut-off effect). An analogous finding applies to subject-matter retained in the patent specification during such adaptation for reasons of comprehensibility, but indicated as not relating to the claimed invention (see T 1149/97, OJ 6/2000, 259).

A possible conflict between the requirements of Art. 123(2) and (3) may occur where, in the procedure before grant, a feature was added to the application which is considered unallowable under Art. 123(2) in opposition proceedings. In that case, Art. 123(2) would require deletion of such a feature whereas Art. 123(3) would not allow deletion, as this would extend the protection conferred by the patent as granted. In such a case the patent will have to be revoked under Art. 100(c). However, where this feature can be **replaced** by a feature for which there is a basis in the application as filed **and** which does not extend the protection conferred by the patent as granted, maintenance in this amended form can be allowed. If the added feature, **without providing a technical contribution to the subject-matter of the claimed invention**, merely limits the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, this feature may be maintained (see G 1/93, OJ 8/1994, 541). The technical significance of a feature in a claim is governed by its contribution to the technical definition of the claimed subject-matter, and that contribution is to be assessed by the skilled person in the light of the original disclosure (see T 518/99).

Other requirements of the EPC may also interact with Art. 123(3) after grant. For instance, if a patent as granted only contains claims that in fact define a "method for treatment of the human or animal body by therapy or surgery practised on the human or animal body" or contain

such a method step, and such a patent is opposed under Art. 53(c), then Art. 53(c) and 123(3) may operate in combination so that the patent must inevitably be revoked, in that:

– the patent cannot be maintained as granted because its claims define subject-matter which is excluded from patentability under Art. 53(c); and

– the patent cannot be maintained in amended form because amendment of the claims as granted by deletion of such "method features" would be contrary to Art. 123(3) (see T 82/93, OJ 5/1996, 274).

6.3 Change of category of claim

Rule 80
Art. 123(3)

An amendment can be in the form of a change in the category of a claim, possibly combined with a change in the technical features of the invention. Firstly it must be clear that this amendment is necessitated by grounds of opposition (see IV, 5.3). If that is not the case a change of category should be refused.

Even if this condition is fulfilled, the Opposition Division should exercise great caution in allowing a change of claim category, because the protection as conferred by the claims may be extended (Art. 123(3)). The change of category requested could involve a change from:

(i) "product" to "use"

If a patent is so amended that a claim to a product (a physical entity) is replaced by a claim to the use of this product, the degree of protection is not extended, provided that the use claim in reality defines the use of a particular physical entity to achieve an effect and does not define such a use to produce a product (G 2/88, OJ 4/1990, 93);

(ii) "product" to "method"

If a patent is so amended that a claim to a product is replaced by a claim to a method for producing the product, this change of category is allowable, provided that the method now claimed only results in the product previously claimed. As it is a fundamental principle of European patent law that the protection conferred by a product claim covers all methods for production of the product, the limitation to one of these methods cannot extend the protection conferred originally (see T 5/90 and T 54/90, neither published in OJ);

(iii) "method" to "product"

If a patent is so amended that a claim to a method of operating a device is replaced by a claim directed to the device itself, this change of category is allowable, provided that the original claim

contains the claimed features of the device exhaustively, whether in structural or functional terms (see T 378/86, OJ 10/1988, 386, and T 426/89, OJ 4/1992, 172).

If, however, the device as now claimed is for its features no longer dependent on the circumstances of its operation whereas it depended on them under the terms of the prior method claim, then such a change of category should not be allowed (T 82/93, OJ 5/1996, 274);

By contrast, the change in claim category from a method in which an apparatus is used to the apparatus itself is not allowable (T 86/90, not published in OJ).

(iv) "method" to "use"

The change from a process for the preparation of a product to the use of the product for a purpose other than previously described is also not allowable (T 98/85 and T 194/85, both not published in OJ).

On the other hand, the change in a claim from a method in which a certain product is used to a claim to the use of that product in performing that same method is allowable (see T 332/94, not published in OJ).

Chapter VI

Procedure for the examination of the opposition

(oral proceedings: see E-III; taking and conservation of evidence: see E-IV)

1. General remarks

The Opposition Division will first of all endeavour to reach a decision in written proceedings. Taking account of the investigations usually conducted beforehand by a primary examiner (see II, 5 and 6), the Opposition Division will base itself on the written submissions of the parties and, where appropriate, on other written evidence obtained, in particular, through the production of documents, requests for information and sworn statements in writing.

The evidence should be submitted as soon as possible (see IV, 1.2.2).

Art. 116

However, if the Opposition Division considers it expedient, or if any party requests oral proceedings, oral proceedings in accordance with Art. 116(1) will be held before the Opposition Division after suitable preparation. In the oral proceedings, the parties may state their cases and put forward and argue submissions in order to clarify outstanding questions. Members of the Opposition Division may put questions to the parties.

Rules 117 to 120

In special, less common cases it will occasionally prove necessary in opposition proceedings for oral evidence to be taken by the Opposition Division as part of oral proceedings or for the conservation of evidence, or by a primary examiner outside the oral proceedings. The Opposition Division is not obliged to take oral evidence if it does not consider it necessary, even if a party has so requested. Oral evidence may be taken, where appropriate under oath, before the competent court in the country of residence of the person to be heard. A member of the Opposition Division may, at the request of the Opposition Division, attend such court hearings (see E-IV, 1.3).

The principal means of taking oral evidence will be the hearing of witnesses and parties (see E-IV, 1.6).

Only in exceptional cases will evidence be obtained at the initiative of the Opposition Division by means of oral and/or written reports by experts (see E-IV, 1.8.1) or by carrying out an inspection (see E-IV, 1.2, last paragraph). In view of the specialised knowledge of the members of the Opposition Division – and of the costs involved – such means should be used only as a last resort.

2. Adherence to the text of the European patent submitted or approved by the proprietor

2.1 Basis for the examination

Art. 113(2)

If the proprietor of the patent submits amendments to the description, claims or drawings after the notice of opposition has been communicated to him (see IV, 5.3), the Opposition Division must take as a basis for its examination the text of the European patent submitted by the proprietor. This principle, that the Opposition Division must concern itself solely with the text most recently "submitted or agreed by the proprietor", also applies to the rest of the opposition procedure. (As regards the possibility of amending texts, see V, 6.1, second paragraph.)

2.2 Revocation of the patent

If the proprietor states that he no longer approves the text in which the patent was granted and does not submit an amended text, the patent must be revoked. This also applies when the proprietor requests that the patent be revoked (Legal Advice No. 11/82, OJ 2/1982, 57).

3. Invitation to file observations

3.1 Examiners' communications

Art. 101(1)
Rule 81(2)

In examining the opposition, the Opposition Division will invite the parties, as often as is necessary, to clarify the substance of the case, to file observations on communications from another party or issued by itself (see E-I, 1) and, where appropriate, to adduce evidence in respect of matters under dispute. Rule 81(2) does not require the Opposition Division to set a period for replying to this invitation. Such a period will, however, be set whenever the Opposition Division considers this expedient. As regards the length of the period see E-VIII, 1.2, as regards the extension of a period see E-VIII, 1.6 and as regards late submission of observations see E-VIII, 1.7 and 1.8, as well as Art. 114(2).

Rule 81(2)

Communications from the Opposition Division and all replies thereto must be communicated to all parties.

3.2 Summons to oral proceedings

Art. 116(1)
Rule 115(1)

If oral proceedings have to be arranged, the parties must be summoned to them as quickly as possible at reasonable notice (see E-III, 6).

Rule 116(1)

Together with the summons, the Opposition Division will draw attention to and in an annexed note explain the points which in its opinion need to be discussed for the purposes of the decision to be taken; where this has already been done sufficiently in a prior communication it is appropriate to refer to that communication. Normally, the annex will also contain the provisional and non-binding opinion of the Opposition Division on the positions adopted by the

parties and in particular on amendments filed by the proprietor of the patent. At the same time, a date will be fixed up to which written submissions may be made or amendments meeting the requirements of the EPC may be filed. Normally this date will be one month before the date of the oral proceedings. However, an earlier date may be advisable if it is anticipated that a party will reasonably need more time, for example to consider the results of comparative tests filed by the other party. With respect to this date, Rule 132 does not apply, i.e. this time limit cannot be extended on request of the parties.

4. Communications from the Opposition Division to the proprietor of the patent

4.1 Communications from the Opposition Division; reasoned statement

Where necessary, any communication to the proprietor of the European patent should contain a reasoned statement. This also applies to any communication to other parties which is communicated to the proprietor of the patent for information only. A reasoned statement will usually not be required if the communication concerns only matters relating to form or if it contains no more than self-explanatory proposals. Where appropriate, all the grounds against the maintenance of the European patent are to be given in the communication.

Rule 81(3)

4.2 Invitation to file amended documents

If the Opposition Division considers that the European patent cannot be maintained in an unamended form, but that a more limited text might be acceptable, it must inform the proprietor of the patent accordingly, stating the grounds, and in appropriate cases invite him "to file, where necessary, the description, claims and drawings in amended form." As regards the time limit here, see E-VIII, 1.2. Where necessary, the description adjusted in line with the new claims should also deal with the state of the art as set out in the opposition proceedings, the technical purpose and the advantages of the invention as it will then stand. The Opposition Division may itself make proposals for amendments to the documents and in this case it should point out to the proprietor of the patent that they are no more than proposals, which he is free to accept on his own responsibility and as he sees fit, but that the patent may be revoked if it remains in a form that is open to objection on the grounds set forth.

Rule 81(2) and (3)

Proposals for amendment filed at a late stage in the proceedings may be disregarded (see T 406/86, OJ 7/1989, 302).

For amended documents, see E-II.

5. Additional search

In exceptional cases, the Opposition Division, like the Examining Division, may on its own initiative cite new material relating to the state of the art and take it into account in its subsequent decision

(see C-VI, 8.3). In the normal course of events, however, since the grant of the patent will have been preceded by a search into the subject-matter of the application by the Search Division, by the Examining Division and generally by the opponents, no additional search will be made. Only in exceptional cases should an additional search by the Search Division be set in train. Such a case might arise, for example, if in the opposition the main subject covered by the patent shifts to elements of a dependent claim which were originally of subsidiary importance, to elements which were previously not set out in the claims, but only in the description, to individual features of a combination, or to sub-combinations, and there are grounds for believing that the original search did not extend to such elements or features and if no relevant document can be found quickly in the circumstances set out in C-VI, 8.3.

6. Examination of the opposition during oral proceedings

For details regarding the examination shortly before and during oral proceedings and the conduct thereof, see E-III, 8.

7. Preparation of the decision

7.1 General remarks

Art. 116(1)
Rule 117

If the Opposition Division does not consider it expedient to arrange for oral proceedings of its own motion (see E-III, 4) or for the taking of evidence even where the latter is requested (see E-IV), and if no admissible request for oral proceedings has been received from a party (see E-III, 2), the decision must be reached on the basis of written proceedings. In this case there is no obligation to arrange for oral proceedings before a decision is reached.

If the case is decided on the basis of written proceedings, submissions filed after the decision has been handed over to the EPO internal postal service for remittal to the parties can no longer be considered, as from that moment the Division cannot amend the decision (see G 12/91, OJ 5/1994, 285), except to the limited extent provided for in Rule 140 (cf. E-X, 10).

The decision, whether or not preceded by oral proceedings or the taking of evidence, may be to revoke the patent (see VIII, 1.2), to reject the opposition (see VIII, 1.3) or to maintain the patent as amended (see VIII, 1.4).

7.2 Preparation of a decision to maintain a European patent in amended form

7.2.1 Procedural requirements

Art. 113

A decision may be delivered only when the patent proprietor has approved the text in which the Opposition Division proposes to maintain the patent and the opponent has had sufficient opportunity to comment on the proposed new text.

Both prerequisites can be fulfilled during oral proceedings. In written proceedings, the necessary opportunity to comment on the new text proposed by the Opposition Division can also be given to the opponent when a communication is issued to the parties. Once these requirements have been met, a separate communication under Rule 82(1) is neither necessary nor appropriate (see G 1/88, OJ 6/1989, 189).

If the patent can be maintained in the amended form, the Opposition Division should immediately try to obtain the patent proprietor's approval of the text in which the patent can be maintained and give the opponent an opportunity to comment on it. An interlocutory decision can then be delivered straight away.

If these requirements have still not been met and no oral proceedings are being held, a communication under Art. 101(1) must be issued. This also applies when it has been established in principle that the patent can be maintained in a particular form but a complete text expressly approved by the patent proprietor is not yet available.

The patent proprietor's approval of an amended version of the patent need not be given in a separate, express declaration; it may also be apparent from the circumstances, in particular from the fact that he has filed or requested the amended version. This applies equally to versions which have been filed as a subsidiary request. (For the wording of documents in oral proceedings, see E-III, 8.9 and 9.)

Rule 82(1)

The patent proprietor's approval can also be obtained through a communication under Rule 82(1) in which the Opposition Division informs the parties that it "intends to maintain the patent as amended" and invites them to "state their observations within a period of two months if they disapprove of the text in which it is intended to maintain the patent". If the patent proprietor fails to file objections to the text thus notified, he is considered to approve of it.

Generally speaking, this communication is useful only if the Opposition Division considers that the complete document expressly approved by the patent proprietor, on which the opponent has been able to comment, still requires amendments. However, these must not go beyond such editorial changes to the wording as appear absolutely necessary by comparison with the text most recently submitted or approved by the patent proprietor. The Opposition Division should draw attention to such amendments and state why they are required if they are not self-explanatory.

If within the period specified in the communication, or in a communication under Rule 82(1), the patent proprietor objects to the text in which the patent is to be maintained, the proceedings are continued. The European patent can be revoked in the subsequent proceedings if the patent proprietor objects to the text and fails to

submit new, properly amended documents despite having been requested to do so.

If an opponent objects to the text communicated to him in which it is intended to maintain the patent, the Opposition Division will continue examining the opposition if it considers that the EPC prejudices the maintenance of the patent in the text initially envisaged.

7.2.2 Decision on the documents on the basis of which the patent is to be maintained

If the Opposition Division considers that the patent can be maintained on the basis of the text submitted or approved by the patent proprietor, and the opponent has had sufficient opportunity to comment on this text – either in writing or during oral proceedings – as well as on the reasons decisive to the patent's maintenance, the Opposition Division will issue an interlocutory decision to the effect that the patent and the invention to which it relates meet the requirements of the EPC following the amendments made by the patent proprietor during the opposition proceedings. If the patent can only be maintained on the basis of an auxiliary request, the decision has to contain a reasoned statement why the version of the main request (and any preceding auxiliary request) does not meet the requirements of the EPC (see T 234/86, OJ 3/1989, 79).

A separate appeal under Art. 106(2) is allowed against this decision, which must be reasoned having regard to the grounds for opposition maintained by the opponent or taken up by the Opposition Division. The decision is delivered in all cases where a European patent is maintained in amended form, even if the opponent has approved of the text communicated by the Opposition Division or has not commented on it. If this decision is not contested, the ruling enshrined in it becomes final and as a result the documents can no longer be amended.

This interlocutory decision is intended to save the patent proprietor unnecessary translation costs arising from an amendment to the text in appeal proceedings.

7.2.3 Request for publishing fee and translations

Rule 82(2)

Once the interlocutory decision becomes final or the amended texts in which the patent is to be maintained have been drawn up in opposition appeal proceedings, the formalities officer requests the proprietor of the patent to pay, within three months, the fee for publishing a new specification of the European patent and to file a translation of any amended claims in the two official languages of the EPO other than the language of the proceedings.

Rule 74

In the communication under Rule 82(2), the proprietor of the patent is asked whether he requests a paper copy of the new patent specification to be supplied to him with the new certificate for the amended European patent. This paper copy of the new specification

is supplied free of charge if requested within the time limit of Rule 82(2) or (3). See also C-VI, 14.10.

If the European patent in the amended form contains different claims for different Contracting States, a translation of all sets of claims – in the text communicated to the proprietor of the patent – into all official languages other than the language of the proceedings must be filed.

The communication under the previous paragraph must contain a reference to the relevant pages on the EPO website where information concerning translation requirements of the Contracting States under Art. 65(1) is published.

Rule 82(2)

If the request under the first paragraph above is not complied with "in due time", the acts may still be validly performed within two months of notification of a communication pointing out the failure to observe the time limit, provided that within this two-month period the prescribed surcharge is paid. If any of the acts is not performed within the period of grace, the formalities officer will issue a decision for revocation of the patent in accordance with Rule 82(3).

Rule 82(2) and (3)
Art. 2, No. 9, RFees

Chapter VII

Details and special features of the proceedings

1. Sequence of proceedings

1.1 Basic principle

Examination of the admissibility of the opposition and preparation of the examination of the opposition should be commenced immediately after the notice of opposition has been received by the formalities officer or the Opposition Division (see IV, 1 and 3, and V, 1 and 2).

If during the rest of the proceedings the Opposition Division, on account of the amount of work in hand, is unable to process immediately all the oppositions submitted, the reference date for the sequence of tasks will, in principle, be the date on which the last observations in respect of which a time limit had been laid down were submitted by any of the parties, but may not be later than the date on which the time limit expired. Documents received unsolicited or not subject to a previously stipulated official time limit, in connection with official communications setting a time limit, will not affect the sequence of tasks unless they require a further early notification setting a time limit.

1.2 Exceptions

Notwithstanding VII, 1.1 above, oppositions are to be given priority:

(i) if the earlier examination proceedings were of considerably longer duration than usual;

(ii) if the opposition proceedings have already extended over a considerably longer period than usual;

(iii) if a party to the proceedings has submitted a reasoned request for accelerated processing in a case where an infringement action in respect of the European patent is pending before a national court of a Contracting State, or if the EPO is informed by a national court or competent authority of a Contracting State that infringement actions are pending (Notice from the EPO dated 17 March 2008, OJ 4/2008, 221);

(iv) if other matters to be dealt with, e.g. divisional applications, hinge upon the final decision concerning the opposition; or

(v) if the next procedural step can be dealt with relatively quickly.

2. Request for documents

Rule 83

Documents referred to by a party to opposition proceedings must be filed together with the notice of opposition or the written submissions. A single copy of these documents is sufficient. If such documents are neither enclosed nor filed in due time upon invitation by the formalities officer, the Opposition Division may decide not to take any arguments based on them into account.

In implementing this provision the desired aim of speeding up the procedure should be borne in mind as much as the common interest in taking obviously relevant submissions into account.

Rule 53(3)

If during the opposition proceedings it becomes apparent that the previous application from which the opposed patent claims priority is not in an official language of the European Patent Office and the validity of the priority claim is relevant to the determination of the patentability of the subject-matter of the patent concerned, the Opposition Division will invite the proprietor of the European patent to file a translation of that application into one of the official languages within a period to be specified. Alternatively, a declaration may be submitted that the European patent application on the basis of which the opposed patent was granted is a complete translation of the previous application. For the procedure for inviting the patent proprietor to file such a translation or declaration see parts A-III, 6.8 and C-V, 3.4. Such an invitation is not to be issued if the translation of the previous application or the declaration was available to the European Patent Office and is to be included in the file of the European patent application under Rule 53(2).

Failure by the proprietor of the European patent to supply a required translation or declaration in due time will lead to the intermediate document(s) which resulted in the validity of the priority claimed becoming relevant for the assessment of patentability being considered to belong to the prior art under Art. 54(2) or Art. 54(3), as applicable.

3. Unity of the European patent

3.1 Basic principle

Art. 118

If the proprietors of the patent are not the same for different designated Contracting States, the unity of the European patent in opposition proceedings will not be affected, since such persons are to be regarded as joint proprietors (see I, 6, second and third paragraphs).

In particular, the text of the European patent will be uniform for all designated Contracting States unless otherwise provided for in the EPC (see VII, 3.2 and 4).

3.2 Factors affecting the unity of the European patent

The unity of the European patent in opposition proceedings will be affected if the previous proprietor of the patent and the person replacing him pursuant to Art. 99(4) in respect of a particular Contracting State are not deemed to be joint proprietors (see I, 6). In this event, the opposition proceedings involving the different proprietors must be conducted separately. Since different requests may be submitted by the two proprietors (e.g. as regards amendments to the claims), the two sets of opposition proceedings may lead to different conclusions, e.g. as regards the text of the European patent or the scope of protection.

4. Texts of the European patent which are different for different Contracting States

4.1 Different texts where the entitled person takes part in the proceedings

Where a third party has, in accordance with Art. 99(4), replaced the previous proprietor for one or some of the designated Contracting States (see I, 6, third paragraph), the patent as maintained in opposition proceedings may for those States contain claims, a description and drawings which are different from those for the other designated Contracting States, without, of course, going beyond the original disclosure. *Rule 78(2)*

4.2 Different text where the state of the art is different pursuant to Art. 54(3) and (4) under EPC 1973

C-III, 8.1, applies mutatis mutandis. The transitional provisions to the EPC 2000 require that, if the underlying application for a patent was filed before the date of entry into force of the EPC 2000, the conflicting prior art under Art. 54 be treated in accordance with EPC 1973, e.g. taking into account Art. 54(3) and (4) of EPC 1973 with the system of common designations. However for patents for which the underlying application was filed on or after the date of entry into force of the EPC 2000, the provisions of the latter apply, in which the system of common designations for conflicting prior art under Art. 54(3) no longer exists. Accordingly, different texts for different states are not acceptable any more for such patents (see C-II, 4.3, C-III, 8.1 and C-IV, 7.3). *Rule 138*

4.3 Different text where a partial transfer of right by virtue of a final decision pursuant to Art. 61 and Rule 18(1) and (2) has taken place

C-III, 8.2, applies mutatis mutandis.

4.4 Different text where national rights of earlier date exist

C-III, 8.4, applies mutatis mutandis.

5. Procedure where the proprietor is not entitled

5.1 Stay of proceedings

Rule 78(1)

If a third party provides proof, e.g. a certificate from the court concerned, to the EPO during opposition proceedings or during the opposition period that he has opened proceedings against the proprietor of the European patent for the purpose of seeking a judgment that he is entitled to the European patent, the Opposition Division must stay the opposition proceedings unless the third party consents to their continuation. Such consent must be communicated in writing to the EPO and is irrevocable. However, stay of the proceedings may not be ordered until the Opposition Division has deemed the opposition admissible. The parties are to be informed of the order staying the proceedings.

5.2 Continuation of proceedings

Rule 14(3)
Rule 78(1)

When giving a decision on the stay of proceedings or thereafter, the Opposition Division may set a date on which it intends to continue the proceedings pending before it, regardless of the stage reached in the proceedings opened against the proprietor of the patent, as referred to in VII, 5.1. The date is to be communicated to the third party, the proprietor of the patent and any other party. If no proof has been provided by that date that a decision which has become final has been given, the Opposition Division may continue proceedings.

If a date is set for the resumption of proceedings, it should be chosen, with due consideration for the interests of the third party who only becomes a party to the proceedings after a judgment has been given in his favour, on the basis of the probable duration of the court proceedings so as to enable them to be concluded within that period of time. If, by the date set, the court has not given a judgment, the opposition proceedings must at all events be further stayed if the judgment is expected in the near future. However, the opposition proceedings should be resumed if it is evident that delaying tactics are being employed by the third party or if the proceedings in the court of first instance have concluded with a judgment in favour of the proprietor of the patent and the legal procedure is extended by the filing of an appeal. Opposition proceedings may also be resumed in the absence of a judgment if the patent can be maintained unamended.

Rule 14(2)
Rule 78(1)

Where proof is provided to the Opposition Division that a decision which has become final has been given in the proceedings concerning entitlement to the European patent, the Opposition Division must communicate to the proprietor and any other party that the opposition proceedings are to be resumed as from the date stated in the communication. If the decision is in favour of the third party, the proceedings may only be resumed after a period of three months of that decision becoming final unless the third party requests the resumption of the opposition proceedings.

5.3 Interruption of time limits

The time limits in force at the date of stay other than time limits for payment of renewal fees are interrupted by stay of the proceedings. The time which has not yet elapsed begins to run as from the date on which proceedings are resumed; however, the time still to run after the resumption of the proceedings must not be less than two months. *Rule 14(4)*

Example:

The three-month time limit under Rule 82(2) begins on 4 January 2006; proceedings are stayed on 24 January 2006 and resumed on 26 September 2006. Of the first month (ending 3 February 2006) there are still 11 days left (24 January - 3 February). The total time which has not elapsed then amounts to 11 days and 2 months.

The time limit ends on 6 December 2006.

5.4 Department responsible

The Legal Division is responsible for questions concerning the stay and resumption of proceedings (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, G.1). *Art. 20*

6. Continuation of the opposition proceedings in the cases covered by Rule 84

6.1 Continuation in the case of surrender or lapse of the patent

If the European patent has been surrendered or has lapsed for all the designated States, the opposition proceedings may be continued at the request of the opponent filed within two months after the date on which the Opposition Division informed the opponent of the surrender or lapse. Evidence of the lapse must generally be provided by submitting extracts from the Patent Registers of the designated Contracting States. *Rule 84(1)*

If, in the case of a request for continuation of the proceedings, the proprietor of the patent has renounced before the competent authorities in the designated states all rights conferred by the patent with ab initio and universal effect, or if no request for continuation has been received within the time limit, the opposition proceedings will be closed. The decision to close the proceedings will be communicated to the parties.

If, instead, the proprietor of the patent declares to the EPO that he surrenders/abandons/renounces the patent, the EPO will interpret this as a request for revocation of the patent. For details of the procedure to be followed, see VIII, 1.2.5.

6.2 Continuation on the death or legal incapacity of the opponent

Rule 84(2)

In the event of the death or legal incapacity of an opponent, the opposition proceedings may be continued by the Opposition Division of its own motion, even without the participation of the heirs or legal representatives, for example if the legal proceedings in connection with the will or the appointment of a new legal representative would inordinately prolong the opposition proceedings. This provision will apply not only where only one opposition has been filed: it will also apply in cases where not all those who have filed opposition are deceased or legally incapacitated.

The Opposition Division should continue the proceedings if, for instance, the proprietor of the patent has submitted amendments to the patent in response to the notice of opposition (see T 560/90, not published in OJ). The Opposition Division should also continue the proceedings if it considers that the stage reached in the opposition proceedings is such that they are likely to result in a limitation or revocation of the European patent without further assistance from the opponent(s) concerned and without the Opposition Division itself having to undertake extensive investigations (see T 197/88, OJ 10/1989, 412).

The proprietor of the patent and any other parties are to be informed that the proceedings will be continued. Otherwise the proceedings are closed and the decision to close the proceedings is communicated to the parties.

6.3 Continuation after the opposition has been withdrawn

Rule 84(2)

The opposition proceedings can be continued even if every opposition has been withdrawn. The principles set forth in VII, 6.2, apply mutatis mutandis in deciding whether the proceedings are to be continued or closed.

7. Intervention of the assumed infringer

Art. 105
Rule 89

The assumed infringer of a patent (see I, 5) may file notice of intervention in the opposition proceedings within three months of the date on which infringement proceedings were instituted against him or on which he instituted proceedings for a court ruling that he is not infringing the patent. Notice of intervention must be filed in a written reasoned statement. It is not deemed to have been filed until the opposition fee has been paid in the amount prescribed in the Rules relating to Fees under the EPC.

Intervention is permissible as long as opposition or appeal proceedings are pending. A third party can only become a party to the proceedings if a party to the proceedings in which the decision was given files an appeal pursuant to Art. 107; otherwise the decision of the Opposition Division will become final on expiry of the appeal period (see G 4/91, OJ 6/1993, 339 and G 1/94, OJ 11/1994, 787). For accelerated processing of oppositions and accelerated

processing before the Boards of Appeal on request, see E-VIII, 4 and 5.

The notice of intervention, filed in a written reasoned statement, must contain: *Rule 89(2)*

(i) a statement of the grounds for intervention and corresponding evidence *Article 105(1)*

(ii) the name, address and nationality of the assumed infringer and the State in which his residence or principal place of business is located. Names of natural persons must be indicated by the person's family name and given name(s), the family name being indicated before the given name(s). Names of legal entities, as well as companies considered to be legal entities by reason of the legislation to which they are subject, must be indicated by their official designations. Addresses must be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address. They must comprise all the relevant administrative units, including the house number, if any. It is recommended that the telephone and fax number be indicated (see IV, 1.2.2.2(i), and IV, 1.4.2); *Rule 76(2)(a)* *Rule 41(2)(c)*

(iii) the number of the European patent at issue in the opposition proceedings in which intervention is made, the name of the proprietor and the title of the invention (see IV, 1.2.2.2(ii), and IV, 1.4.2); *Rule 76(2)(b)*

(iv) a statement of the extent to which the European patent at issue is opposed by way of intervention and of the grounds on which the opposition by way of intervention is based, as well as an indication of the facts, evidence and arguments presented in support of these grounds (see IV, 1.2.2.1(iii), (iv) and (v), and IV, 1.4.2); *Rule 76(2)(c)*

(v) if the assumed infringer has appointed a representative, his name and the address of his place of business in accordance with sub-paragraph (ii) as set out above (see IV, 1.2.2.2(iii), and IV, 1.4.2). *Rule 76(2)(d)*

IV, 1, sets out further details and explains how to deal with the intervention if one of these requirements is not fulfilled. *Rule 77(1)*

8. Publication of a new specification of the patent

If a European patent is maintained in an amended form, the EPO must, as soon as possible after it publishes the mention of the opposition decision, publish a new specification of the European patent containing the description, the claims and any drawings, in the amended form. *Art. 103*

Rule 87 Rule 74 applies mutatis mutandis to the new specification of the European patent.

Chapter VIII

Decisions of the Opposition Division

General remarks on decisions appear in E-X.

1. Final decisions on an admissible opposition

1.1 General remarks

The Opposition Division has to take a final decision on the opposition, by revoking the European patent or rejecting the opposition or ruling that the European patent is to be maintained as amended. If the only admissible opposition or all the admissible oppositions are withdrawn and the Opposition Division takes the view that as the case stands there is no reason for the Office to continue the proceedings of its own motion, the proceedings are closed by means of a formal decision (Rule 84(2), second sentence).

1.2 Revocation of the European patent

1.2.1 Revocation on substantive grounds

If the Opposition Division is of the opinion that at least one ground for opposition as set out in Art. 100 prejudices the maintenance of the European patent, it will revoke the patent under Art. 101(2). Analogously, if the Opposition Division is of the opinion that the patent as amended during the course of the opposition proceedings does not meet the requirements of the Convention, it will revoke the patent under Art. 101(3)(b).

Art. 101(2)
Art. 101(3)(b)

For revocation because the proprietor of the patent has not given his agreement, see VI, 2.2, 4.2 and 7.2.2.

1.2.2 Revocation for failure to pay the prescribed fee for printing or to file a translation

If the proprietor of the patent fails in due time to pay the prescribed fee for the printing of a new specification of the European patent or to file a translation of the amended claims in the two official languages of the EPO other than the language of the proceedings (see VI, 7.2.3), the European patent will be revoked.

Rule 82(3)

1.2.3 Revocation for failure to notify the appointment of a new representative

If opposition proceedings are interrupted according to Rule 142(1)(c) and the patent proprietor, who is not resident in one of the Contracting States, does not forward a notification of the appointment of a new representative within the two-month period laid down in Rule 142(3)(a) (see E-VII, 1.2(i)), the European patent will be revoked.

Rule 142(3)(a)

1.2.4 Revocation in the event of requirements not being met until after expiry of time limits

In the cases referred to in VIII, 1.2.2 and 1.2.3, the European patent will be revoked even if the omitted acts have been completed during the period between expiry of the time limit and the taking of a final decision, unless a request for re-establishment of rights has been filed, in which case a decision must first be given on the application.

1.2.5 Revocation of the patent in the event that the proprietor no longer wishes the patent to be maintained as granted

If the proprietor states that he no longer approves the text in which the patent was granted and does not submit an amended text, the patent must be revoked. This also applies when the proprietor requests the patent to be revoked.

If a proprietor unambiguously declares to the EPO the surrender (or abandonment or renunciation) of the patent, this is interpreted as equivalent to a request that the patent be revoked (see T 237/86, OJ 7/1988, 261). If the request of the proprietor is not unambiguous, he is given the opportunity to request that the patent be revoked or to declare that he no longer approves of the patent being maintained as granted. This results in the patent being revoked (see Legal Advice 11/82, OJ 2/1982, 57).

1.3 Rejection of the opposition

Art. 101(2)

If the Opposition Division is of the opinion that the grounds for opposition mentioned in Art. 100 do not prejudice the maintenance of the European patent unamended, it will reject the opposition.

1.4 Maintenance of the European patent as amended

1.4.1 Taking of a final decision

Art. 101(3)(a)
Rule 82(1) and (2)

If the Opposition Division is of the opinion that, taking into consideration the amendments made by the proprietor of the patent during the opposition proceedings, the patent and the invention to which it relates meet the requirements of the EPC, it will issue a decision to maintain the European patent as amended.

The procedure specified in VI, 7.2.1 to 7.2.3, will precede the decision.

1.4.2 Statement in the decision of the amended form of the European patent

Rule 82(4)

The decision must state which text of the European patent forms the basis for maintaining it.

2. Other decisions

2.1 Decision on the inadmissibility of an opposition or intervention

See IV, 3, and IV, 5.5, with reference to the notice of opposition and IV, 5.6, and VII, 7, for the intervention of an assumed infringer.

2.2 Decisions which do not terminate proceedings

Such decisions are dealt with in E-X, 6.

See VI, 7.2.2, with reference to the maintenance of a patent with amended documents.

2.3 Decision on a notified loss of rights at the request of the person concerned

This decision is dealt with in E-VIII, 1.9.3. *Rule 112(2)*

2.4 Decision on re-establishment of rights

This decision is dealt with in E-VIII, 2.2.7.

2.5 Decision on closure of the opposition proceedings

This decision is dealt with in VII, 6 and VIII, 1.1.

Chapter IX

Costs

1. Charging of costs

1.1 General principle

Each party to the proceedings must bear the costs it has incurred. However, an Opposition Division may, for reasons of equity, order a different apportionment of such costs, which may have been incurred during the taking of evidence, in oral proceedings or under other circumstances. *Art. 104(1)*

The phrase "taking of evidence" refers generally to the receiving of evidence by an Opposition Division, whatever the form of such evidence. It includes among other things the production of documents and sworn statements in writing as well as hearing witnesses (see T 117/86, OJ 10/1989, 401).

1.2 Decisions on the apportionment of costs

Apportionment of costs must be dealt with in the decision on the opposition. This apportionment will form part of the main decision and will be incorporated in the operative part of the decision. *Rule 88(1)*

The decision will deal only with the obligation on the party or parties concerned to bear costs. The actual amounts to be paid by one party to another must be dealt with in the decision on the award of costs (see IX, 2).

A statement that the parties will bear their own costs may be incorporated in the grounds for the decision on the opposition and should be included in cases where one of the parties to the proceedings has submitted a request for a decision on the award of costs which the Opposition Division does not consider justified.

A decision to award costs may be made by the Opposition Division of its own motion, even if no application for the award of costs has been made.

In the absence of an express decision on the award of costs, each of the parties concerned must bear his own costs.

1.3 Costs to be taken into consideration

Rule 88(1) Apportionment of costs may relate only to those expenses necessary to assure proper protection of the rights involved.

Art. 104(1) Examples of such expenses are:

(i) expenditure incurred in respect of witnesses and experts, together with other costs arising in connection with the taking of evidence;

(ii) remuneration of the representatives of the parties in respect of oral proceedings or the taking of evidence;

(iii) remuneration of the representatives of the parties in respect of undue delaying of the procedure by one of the parties or in respect of the late filing of documents; and

(iv) expenditure incurred directly by the parties, i.e. their travel expenses in coming to oral proceedings or the taking of evidence.

Costs incurred in respect of superfluous or irrelevant evidence, etc., cannot be covered by a decision on costs.

1.4 Principle of equity

Reasons of equity will require a decision on the apportionment of costs when the costs arise in whole or in part as a result of conduct of one party which is not in keeping with the care required to assure proper protection of the rights involved, in other words when the costs are culpably incurred as a result of irresponsible or even malicious actions. Each party may of course defend his rights or interests (e.g. the proprietor his patent) by any legally admissible means within the framework of the opposition proceedings; he may, for example, request oral proceedings or the taking of evidence.

Accordingly, costs incurred as a result of default or of inappropriate legal means used by either party may be charged to the party responsible, even if he has been successful in the opposition proceedings.

The following are examples where the principle of equity may be applied:

The costs incurred by the opponent in preparing oral proceedings which have been appointed may be charged to the proprietor of the patent if he surrenders the patent just before the date appointed for the oral proceedings, although it was clear when the proceedings were being arranged, from a document put forward by the opponent, that the proprietor of the patent had no case and he alone therefore was liable for his irresponsible conduct.

If an aspect of the state of the art is adduced as an argument at a late stage and it can be shown, or it is evident, that the party concerned knew of it earlier, e.g. in that he had made prior use of it, the additional costs of further oral proceedings unnecessarily incurred by the other parties may be charged to the party which caused them by submitting his argument at so late a stage.

If relevant facts or evidence are submitted by a party only at a late stage of the proceedings without any good reason and if, as a consequence, unnecessary costs are incurred by another party, the Opposition Division may decide on the apportionment of costs.

2. Procedure for the fixing of costs

2.1 Fixing of costs by the Opposition Division

At the request of at least one party, the Opposition Division must fix the amount of the costs to be paid under a decision apportioning them. The request is admissible only if the decision apportioning the costs has become final. *Art. 104(2)* *Rule 88(2)*

A bill of costs, with supporting evidence in respect of each amount involved, must be attached to the request. Costs may be fixed once their credibility is established. *Rule 88(2)*

The parties will be notified of the costs as fixed by the Opposition Division. *Art. 119*

For the allocation of the duty of fixing the costs, see II, 7.

2.2 Appeal against the fixing of costs by the Opposition Division

The fixing of costs by the Opposition Division may be reviewed by a decision of the Opposition Division.

The request for such a decision, stating the reasons on which it is based, must be filed with the EPO in writing within one month after the date of notification of the awarding of costs by the Opposition Division. It is not deemed to be filed until the fee for the awarding of costs has been paid at the rate prescribed in the Rules relating to Fees under the EPC. *Rule 88(3)*

The Opposition Division will take a decision on the request without oral proceedings. *Rule 88(4)*

3. Enforcement of the fixing of costs

Any final decision of the EPO fixing the amount of costs must be dealt with, for the purpose of enforcement in the Contracting States, in the same way as a final decision given by a civil court of the State in the territory of which enforcement is to be carried out. Verification of any such decision must be limited to its authenticity. *Art. 104(3)*

"Decision" as referred to above also covers the final fixing of costs by the Opposition Division.

Chapter X

Limitation and revocation procedure

1. Introduction

This procedure enables a patent proprietor to request revocation or limitation of his patent. Unlike in the opposition procedure, there is no restriction on the period between the grant of the patent and the filing of the request. Accordingly, the request can be filed at any time after grant, after opposition proceedings, or even after expiry of the patent.

Certain aspects of this procedure are entrusted to formalities officers (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, F.2).

2. Examination for deficiencies in the request

2.1 Deficiencies which lead to the request being deemed not to have been filed

On receipt of a request for revocation or limitation of a patent, the formalities examiner will examine whether: *Art. 105a*

(i) the request is filed with the EPO (Art. 105a(1))

(ii) opposition proceedings in respect of the patent are not pending at the time of filing the request (Art. 105a(2) and Rule 93(1))

(iii) the relevant fee is paid (Art. 105a(1), and Art. 2, No. 10a, RFees); note that the amount of the fee for limitation or revocation may qualify for a reduction in accordance with the RFees if the request for limitation or revocation is filed in an admissible non-EPO language (Rule 6(3), see A-XI, 9.1 and 9.2)

(iv) where the request is filed in a language according to Art. 14(4), the translation has been filed in due time (Rule 6(2))

(v) where the requester is required by Art. 133(2) to appoint a representative, this was done in due time (Rule 152 (3) and (6)).

If any of these requirements are not met, the request is deemed not to have been filed. This finding is notified to the requester (Art. 119), and the fee is refunded.

Otherwise, the request is considered to have been filed, and the limitation/revocation procedure commences.

2.2 Deficiencies which, if not remedied, lead to the request being rejected as inadmissible

Rule 92

The formalities officer will furthermore examine whether:

(i) the request is filed in writing (Rule 92(1))

(ii) the request includes the particulars of the requester required by Rule 92(2)(a), referring to Rule 41(2)(c)

(iii) the request indicates in which Contracting States the requester is the proprietor of the patent (Rule 92(2)(a))

(iv) the request indicates the number of the patent to be limited or revoked (Rule 92(2)(b))

(v) the request indicates in which Contracting States the patent has taken effect, even if in the meantime it has lapsed in one or more of those Contracting States (Rule 92(2)(b))

(vi) in cases (iii) and (v), and if the requester is not the proprietor for all these Contracting States, the requester provides the names and addresses of the other proprietors, and evidence that he is entitled to act on their behalf (Rule 92(2)(c)); due to the retroactive effect of a limitation/revocation (Art. 68), such evidence is required also in the case where the patent has lapsed in one or more of the Contracting States referred to under (v) in the meantime. Note that in the case of joint proprietors, whether for the same or different Contracting States, the requirements of Rule 151 for appointment of a common representative also apply in the limitation or revocation procedure (see A-IX, 1.3).

(vii) where limitation is sought, the request includes the complete version of the amended claims (and of the description and drawings where applicable) (Rule 92(2)(d))

(viii) if the requester has appointed a representative, the particulars according to Rule 41(2)(d) (Rule 92(2)(e)) have been filed.

Rule 94

If any of the above requirements are not met, the requester is invited to correct the deficiencies within a period to be specified.

If the deficiencies are not corrected within this period, the request is to be rejected as inadmissible. This decision is notified to the requester (Art. 119). Re-establishment of rights under Art. 122 is, however, available. The decision rejecting the request is open to appeal (Art. 106(1)).

Otherwise, the request is deemed admissible.

3. Decision on request for revocation

If the request is for revocation, and is admissible, the Examining Division will revoke the patent and communicate this to the requester (Art. 105b(2) and Rule 95(1)). The decision takes effect on the date on which it is published in the Bulletin (Art. 105b(3)). In accordance with Art. 68, the effect of the decision is that the patent is revoked ab initio, conferring no rights under Art. 64 or 67. As stated in Art. 105b(3), the decision applies to all Contracting States in respect of which the patent was granted. It is not possible for the patent to be revoked only for some Contracting States, and not for others.

Art. 105b(2)
Rule 95

4. Substantive examination (limitation)

4.1 Department responsible

If a request for limitation is deemed to be admissible, then the file will be forwarded to the Examining Division, as the department responsible for the examination of the request.

Rule 91

4.2 Basis for the examination

The basis for the examination is the patent as granted or amended in opposition or limitation proceedings (Rule 90). In cases in which there have already been both opposition and limitation procedures, or more than one limitation procedure, the basis for the examination is the patent as amended in the most recent of those procedures.

Rule 90

The requester has the option of providing information (with the request, or later in the procedure) as to why the request is allowable, and/or as to the purpose behind the request, but he is not obliged to do so. The purpose underlying the request is, however, of no relevance to the question whether it is allowable.

4.3 Scope of the examination

The scope of the examination is limited by Rule 95(2). The Examining Division is required to decide only whether the amended claims of the request constitute a limitation with respect to the claims as granted or amended (i.e. those referred to in X, 4.2), and whether they comply with the requirements of Art. 84 and Art. 123(2) and (3).

Rule 95(2)

The term "limitation" is to be interpreted as meaning a reduction in the extent of protection conferred by the claims. Mere clarifications or changes made to protect a different subject ("aliud") are not to be considered as limitations.

Amendments in a claim leading to an extent of protection which is smaller, but falls partly outside the extent of protection conferred by the claim previously on file, should be dealt with cautiously. Even if the amendment constitutes a limitation, such a claim would generally contravene Art. 123(3) (see also V, 6.3 for Art. 123(3) in the case of a change of category of a claim).

Rule 92(2)(d)
Art. 69(1)

Rule 95(2) requires the Examining Division to examine only the amended claims. According to Rule 92(2)(d), however, the request for limitation may also comprise an amended description and drawings. In this case such amendments should also be examined with respect to the above requirements.

For interpretation of Art. 84 and Art. 123(2), see C-III, 4 and C-VI, 5.3. The description and drawings are used to interpret the claims in accordance with Art. 69(1) and its Protocol on Interpretation. Amendments made to these parts might therefore introduce matter contrary to Art. 123(3) (see V, 6.1).

There should be no examination as to whether the subject-matter of the limited patent is patentable under Art. 52 to 57 or whether the supposed aim, if indicated, of the limitation (e.g. delimitation with respect to particular prior art) is actually achieved by the requested amendment of the claims.

Rule 139

Errors of transcription or obvious mistakes can, however, be rectified on request or by the EPO of its own motion.

4.4 Further stages of the examination

If the examination under X, 4.3 above leads to the conclusion that the request is allowable, then the next stage of the procedure - the establishment of the formal requirements for limitation as described under X, 5 - can begin. Otherwise, in accordance with Rule 95(2), a communication must be sent to the requester identifying the deficiencies and giving him the opportunity to correct them within a period to be specified. The normal period is two months (Rule 132(2)). It is, in principle, extendable, but only under exceptional circumstances.

If the requester responds in due time in a manner such that no objections remain, then the procedure continues as in X, 5. Otherwise it continues as described in X, 6.

Rule 95(2) specifies that the Examining Division must give the requester one opportunity to correct the deficiencies. However, any request for oral proceedings according to Art. 116 must be granted if the request for limitation is not allowable.

4.5 Third-party observations during the examination

Art. 115
Rule 114

Art. 115 explicitly covers all proceedings before the EPO, not just pre-grant proceedings. Accordingly, its provisions also apply in principle to revocation and limitation proceedings. However, such third-party observations are restricted by virtue of Art. 115 to the issue of patentability. In accordance with Rule 95(2), patentability is not to be taken into account in the examination of the request for limitation (see-X, 4.3). Consequently, the Examining Division should not take these observations into account. The requester could, however, when responding to an invitation under Rule 95(2), introduce further

restrictions intended to address such observations. If he wishes to do this, and no invitation under Rule 95(2) is issued, his only option is to file a further request for limitation.

5. Formal procedure for limitation when the request is allowable

If the request for limitation is allowable, then according to Rule 95(3) the Examining Division must communicate this to the requester and invite him to pay the prescribed fee and file translations of the amended claims into the other two official languages within a period of three months. As in opposition proceedings, the requester benefits from a two-month period of grace for reply with payment of a surcharge (Art. 2, No. 9, RFees). Re-establishment of rights is available.

Rule 95(3)
Art. 2, No. 8 and No. 9, RFees

The communication under the previous paragraph must contain a reference to the relevant pages on the EPO website where information concerning translation requirements of the Contracting States under Art. 65(1) is published.

Rule 95(3)

If the requester pays the fee and files the required translations in due time, the Examining Division will decide to limit the patent (Art. 105b(2) and Rule 95(3), last sentence). This takes effect on the date on which the mention of the decision is published in the Bulletin.

Art. 105b(2) and (3)

As soon as possible after this, the amended specification will be published by the EPO. The form of publication of the amended patent specification is defined in Rule 96, Rule 73(2) and (3) and Rule 74. The procedure for this is the same as in opposition proceedings.

Art. 105c

As for revocation (see X, 3.), the effect of the decision to limit the patent is that the patent is limited ab initio.

Art. 68

6. Rejection of the request

If:

(i) the requester does not respond in due time to the invitation under Rule 95(2) (see X, 4.4 above); or

(ii) he responds in due time, but the request is still not allowable; or

(iii) he fails to pay the fee(s) and file the translation according to Rule 95(3) (see X, 5 above),

then the Examining Division will reject the request (Art. 105b(2), last sentence and Rule 95(4)).

The decision to reject the request will be notified in accordance with Art. 119 to the requester.

Rule 111(2)
Art. 106(1)

In case (ii), the decision is a reasoned decision taken by the Examining Division, and is subject to appeal.

7. Precedence of opposition proceedings

Rule 93(1)

The case in which opposition proceedings are already pending when the request for revocation or limitation is filed has been mentioned in X, 2.1. In the opposite case, i.e. where an opposition is filed while revocation or limitation proceedings are pending, the procedure depends on whether the pending proceedings relate to a request for revocation or for limitation.

Rule 93(2)

According to Rule 93(2), if the pending proceedings relate to a request for limitation, the Examining Division will terminate those proceedings and order the reimbursement of the limitation fee. If the requester has already paid the fee referred to in Rule 95(3) (see X, 5), this fee will also be refunded. The opposition procedure will then continue in the normal manner.

The decision to terminate the limitation proceedings is notified to the requester (Art. 119).

Rule 93(2) is restricted to limitation proceedings. Therefore, in the case of revocation proceedings, there is no precedence of opposition. Revocation proceedings continue after an opposition is filed, and the case proceeds to opposition only if the request for revocation is deemed not to have been filed, is rejected as inadmissible or is withdrawn. Otherwise, if the patent is revoked, the opponent(s) will be informed of this situation and the opposition proceedings will be terminated.

8. Legal status of decisions

Art. 106(1)

The decisions rejecting the request for limitation or revocation as either inadmissible or not allowable (see X, 2 and 6) are open to appeal, as they are decisions of the Examining Division terminating a procedure. Accordingly they are decisions listed as such in Art. 21(3)(a).

9. Withdrawal of the request

In the absence of any provision to the contrary and in accordance with normal legal principles, the requester may withdraw his request for limitation or revocation at any time, provided that the request is still pending. In this case, however, the limitation or revocation fee will not be refunded.

10. Different sets of claims

Art. 105b(3)

Art. 105b(3) specifies that the decision to limit or revoke will apply to the patent in all Contracting States for which it has been granted. There is thus a single decision, covering all Contracting States, but this decision may include different sets of claims for different Contracting States, or determine that the limitation is in other ways

different for different Contracting States. Such situations could arise in two different sets of circumstances.

10.1 Limitation results in the claims becoming different in different Contracting States

The limitation could result in the claims becoming different in different Contracting States if the requester wishes to restrict the claims with respect to one or more, but not all, Contracting States in order to avoid conflict with national prior rights. Such different sets of claims can be allowed, provided that the substantive requirements are met for all sets.

It follows from Rule 138 that a prerequisite for the introduction of different claims for different Contracting States during the limitation procedure is that the requester informs the EPO of the existence of the national prior rights when filing the different sets of claims. If he files different sets of claims without informing the EPO of the national prior rights, then the request is to be refused under Art. 105b(3) and Rule 138. *Rule 138*

Under the EPC 2000, different sets of claims can no longer be justified on the basis of prior art under Art. 54(3) (for transitional provisions, however, see VII, 4.2). *Art. 54(3)*

10.2 Limitation is different for different Contracting States because the claims as granted were different for different Contracting States

The limitation is different in different Contracting States because the claims forming the basis of the limitation procedure were different in different Contracting States. This situation would occur where the patent has different claims for different Contracting States, because of national prior rights or prior art under Art. 54(3) (for patents granted before the date of entry into force of the EPC 2000 or for patents granted in respect of European patent applications pending at that time), or where under Art. 61 a partial transfer of rights has taken place (Rule 18(2)).

The requester might wish to apply a limitation already introduced for one or more Contracting States to the other Contracting States, or to bring the claims into line with each other for a different reason. If this results in a single set of claims for all Contracting States, and the substantive requirements are met separately for each different set of original claims, then the request would be allowable.

Note that it would also be possible that the circumstances of this paragraph and paragraph 10.1 coexist in a single request.

11. Multiple requests

Rule 90 defines that the basis for the request can be the claims as amended in limitation proceedings, thus providing for multiple *Rule 90*

subsequent requests, i.e. a request for limitation or revocation following one or more earlier requests for limitation.

Part E

Guidelines on General Procedural Matters

Contents

Introduction 1

Chapter I – Communications and notifications I-1

1.	Communications	I-1
1.1	General remarks	I-1
1.2	Number of communications	I-1
1.3	Form of decisions, communications and notices	I-1
2.	Notification	I-2
2.1	General remarks	I-2
2.2	Method of notification	I-2
2.3	Notification by post	I-2
2.4	Notification to representatives	I-3
2.5	Irregularities in the notification	I-3

Chapter II – Procedure for amendments to documents II-1

1.	Amendment by submitting missing documents or by filing replacement pages	II-1
2.	Amendments using copies	II-1
3.	Amendments made by the EPO at the request of a party and amendments made by a party at the EPO	II-2

Chapter III – Oral proceedings III-1

1.	General	III-1
2.	Oral proceedings at the request of a party	III-1
3.	Request for further oral proceedings	III-2
4.	Oral proceedings at the instance of the EPO	III-2
5.	Preparation of oral proceedings	III-2
6.	Summons to oral proceedings	III-3
7.	Requests for the postponement of oral proceedings	III-3
8.	Conduct of oral proceedings	III-4
8.1	Admission of the public to proceedings	III-4
8.2	Conduct of oral proceedings	III-4
8.3	Opening of oral proceedings: non-appearance of a party	III-4
8.4	Opening of the substantive part of the proceedings	III-6
8.5	Submissions by the parties	III-6
8.6	Facts, evidence or amendments introduced at a late stage	III-7
8.7	Discussion of the facts and of the legal position	III-9
8.8	Right of the other members of the Examining or Opposition Division to put questions	III-9
8.9	Closure of oral proceedings	III-10
9.	Delivery of the decision	III-10
10.	Minutes of oral proceedings	III-11

10.1	Formal requirements	III-11
10.2	Subject-matter of minutes	III-12

Chapter IV – Taking and conservation of evidence **IV-1**

1.	Taking of evidence by the departments of the EPO	IV-1
1.1	General remarks	IV-1
1.2	Means of evidence	IV-1
1.3	Taking of evidence in substantive examination and opposition proceedings	IV-3
1.4	Order to take evidence	IV-3
1.5	Summoning of parties, witnesses and experts	IV-3
1.6	Hearing of parties, witnesses and experts	IV-4
1.6.1	General remarks	IV-4
1.6.2	Witnesses and experts not summoned	IV-4
1.6.3	Guidance to persons heard	IV-5
1.6.4	Separate hearings	IV-5
1.6.5	Examination as to personal particulars	IV-5
1.6.6	Examination as to res gestae	IV-5
1.6.7	Entitlement of parties to put questions at hearings	IV-5
1.7	Minutes of taking of evidence	IV-6
1.8	Commissioning of experts	IV-6
1.8.1	Decision on the form of the opinion	IV-6
1.8.2	Objection to an expert	IV-7
1.8.3	Terms of reference of the expert	IV-7
1.9	Costs arising from oral proceedings or taking of evidence	IV-7
1.10	Entitlements of witnesses and experts	IV-8
1.10.1	Expenses for travel and subsistence	IV-8
1.10.2	Loss of earnings, fees	IV-8
1.10.3	Details of the entitlements of witnesses and experts	IV-8

2.	Conservation of evidence	IV-8
2.1	Requirements	IV-8
2.2	Request for the conservation of evidence	IV-8
2.3	Competence	IV-9
2.4	Decision on the request and the taking of evidence	IV-9

3.	Taking of evidence by courts or authorities of the Contracting States	IV-9
3.1	Legal co-operation	IV-9
3.2	Means of giving or taking evidence	IV-10
3.2.1	Taking of evidence on oath or in equally binding form	IV-10
3.2.2	Cases where evidence is taken by a competent court	IV-10
3.3	Letters rogatory	IV-10
3.4	Procedures before the competent authority	IV-10
3.5	Costs of taking evidence	IV-11
3.6	Taking of evidence by a person appointed by the competent authority	IV-11

4.	Evaluation of evidence	IV-11
4.1	General remarks	IV-11
4.2	Evaluation of the testimony of a witness	IV-11
4.3	Evaluation of the testimony of parties	IV-12

4.4	Evaluation of an expert opinion	IV-13
4.5	Evaluation of an inspection	IV-13

Chapter V – Derogations from the language of the proceedings in oral proceedings **V-1**

1.	Use of an official language	V-1
2.	Language of a Contracting State or other language	V-1
3.	Exceptions from sections 1 and 2	V-1
4.	Language used in the taking of evidence	V-1
5.	Language used by employees of the EPO	V-2
6.	Language used in the minutes	V-2

Chapter VI – Examination by the EPO of its own motion; facts, evidence or grounds not submitted in due time; observations by third parties **VI-1**

1.	Examination by the EPO of its own motion	VI-1
1.1	General remarks	VI-1
1.2	Limits on the obligation to undertake examination	VI-1
2.	Facts, evidence or grounds for opposition not submitted in due time or arguments presented at a late stage	VI-1
3.	Observations by third parties and examination thereof	VI-2

Chapter VII – Interruption and suspension of the proceedings **VII-1**

1.	Interruption	VII-1
1.1	Cases in which the proceedings may be interrupted	VII-1
1.2	Resumption of proceedings	VII-1
1.2.1	Resumption of time limits	VII-2
1.3.	Department responsible	VII-2
2.	Stay of proceedings when entitlement proceedings are pending	VII-2
3.	Stay of proceedings when a referral to the Enlarged Board of Appeal is pending	VII-2

Chapter VIII – Time limits, loss of rights, further and accelerated processing and re-establishment of rights **VIII-1**

1.	Time limits and loss of rights resulting from failure to respond within a time limit	VIII-1
1.1	Determination of time limits	VIII-1
1.2	Duration of the time limits to be determined by the EPO on the basis of EPC provisions	VIII-1
1.3	Time limits which may be freely determined	VIII-2
1.4	Calculation of time limits	VIII-2
1.5	Effect of change in priority date	VIII-2
1.6	Extension of a time limit	VIII-2
1.7	Late receipt of documents	VIII-3
1.8	Failure to respond within a time limit	VIII-4

1.9	Loss of rights	VIII-4
1.9.1	Cases of loss of rights	VIII-4
1.9.2	Noting and communication of loss of rights	VIII-4
1.9.3	Decision on loss of rights	VIII-5
2.	Further processing and re-establishment of rights	VIII-5
2.1	Request for further processing of the European patent application	VIII-5
2.2	Re-establishment of rights	VIII-5
2.2.1	General remarks	VIII-5
2.2.2	Extension of re-establishment of rights to opponents	VIII-6
2.2.3	Relevant time limits	VIII-6
2.2.4	Time limits not covered	VIII-7
2.2.5	Request for re-establishment of rights	VIII-7
2.2.6	Special considerations in proceedings with more than one party	VIII-8
2.2.7	Decision on re-establishment of rights	VIII-8
3.	Accelerated prosecution of European patent applications	VIII-8
4.	Accelerated processing of oppositions	VIII-8
5.	Accelerated processing before the Boards of Appeal	VIII-8
6.	Renunciation of rights	VIII-9
6.1	Withdrawal of application or designation	VIII-9
6.2	Withdrawal of priority claim	VIII-9
6.3	Statement of withdrawal	VIII-9
6.4	Surrender of patent	VIII-9

Chapter IX – Applications under the Patent Cooperation Treaty (PCT) IX-1

1.	General remarks	IX-1
2.	The EPO as a receiving Office	IX-2
3.	The EPO as an International Searching Authority (ISA)	IX-3
3.1	General remarks	IX-3
3.2	Limitations	IX-4
4.	The EPO as an International Preliminary Examining Authority (IPEA)	IX-4
4.1	General remarks	IX-4
4.2	The international preliminary examination report (IPER)	IX-5
4a.	Response to the WO-ISA, IPER or search opinion	IX-5
5.	The EPO as a designated Office	IX-6
5.1	General remarks	IX-6
5.2	Communication to the EPO as a designated Office	IX-6
5.3	Publication of the translation of the international application	IX-7
5.4	Supplementary European search report	IX-7
5.5	Delaying of the procedure before the EPO	IX-8
5.6	Review by the EPO as a designated Office	IX-8
5.7	Examination and processing	IX-8
5.8	Inspection of files	IX-9

6.	The EPO as an elected Office	IX-9
6.1	General remarks	IX-9
6.2	Opening of the European phase and of substantive examination	IX-9
6.3	Substantive examination of a Euro-PCT application accompanied by an international preliminary examination report (IPER)	IX-10
6.3.1	Comparative test results	IX-10
6.3.2	Documents forming the basis for substantive examination	IX-10
6.3.3	Consideration of the contents of the international preliminary examination report during substantive examination	IX-11
6.4	Inspection of files	IX-11

Chapter X – Decisions **X-1**

1.	Basis of decisions	X-1
1.1	General remarks	X-1
1.2	Examples	X-1
2.	Consideration of time limits	X-2
3.	Authoritative text of documents	X-2
4.	Written form of decisions	X-3
4.1	General remarks	X-3
4.2	Order	X-4
4.3	Facts and submissions	X-4
4.4	Decision on the file as it stands	X-4
5.	Reasoning of decisions	X-5
6.	Decisions which do not terminate proceedings – interlocutory decisions	X-6
7.	Binding nature of decisions on appeals relating to the same case	X-7
8.	Information as to means of redress	X-7
9.	Notification	X-8
10.	Correction of errors in decisions	X-8

Chapter XI – Appeals **XI-1**

1.	Suspensive effect	XI-1
2.	Appeals after surrender or lapse of the patent	XI-1
3.	Appeals against the apportionment of costs	XI-1
4.	Appeals against the decision of the Opposition Division on the fixing of costs	XI-1
5.	Persons entitled to appeal and to be parties to appeal proceedings	XI-1
6.	Time limit and form of appeal	XI-1
7.	Interlocutory revision	XI-2
7.1	General remarks	XI-2
7.2	Remittal to the Board of Appeal	XI-3
7.3	Reimbursement of appeal fees	XI-3
8.	Rules of Procedure for the departments of second instance	XI-3

Chapter XII – Request from a national court for a technical opinion concerning a European patent **XII-1**

1.	General	XII-1
2.	Scope of the technical opinion	XII-1
3.	Composition and duties of the Examining Division	XII-2
3.1	Composition	XII-2
3.2	Duties	XII-2
4.	Language to be used	XII-2
5.	Procedure	XII-3
5.1	Formalities check	XII-3
5.2	Preliminary examination	XII-3
5.3	Withdrawal of the request	XII-3
5.4	Establishment and issue of the technical opinion	XII-4
5.5	File inspection	XII-4
5.6	Appearance before the national court	XII-4

Chapter XIII – Registering transfers, licences, other rights, etc. **XIII-1**

1.	Transfer of the European patent application	XIII-1
2.	Transfer of the European patent	XIII-1
3.	Licences and other rights	XIII-2
4.	Change of name	XIII-2

Introduction

Part E contains guidelines for those procedural steps in respect of the examination of European patent applications and patents which without major variations may, insofar as the EPC permits, occur at a number of stages in the procedure. Attention is also drawn to Art. 125, which states: "In the absence of procedural provisions in this Convention, the EPO shall take into account the principles of procedural law generally recognised in the Contracting States".

With the exception of Chapter IX, Part E does not apply to international applications which the EPO processes under the Patent Cooperation Treaty (PCT), unless stated otherwise.

Chapter I

Communications and notifications

1. Communications

1.1 General remarks

Communications should be sent, inter alia:

(i) if a party has to be informed of deficiencies, together, where appropriate, with a request to remedy those deficiencies, e.g. in accordance with Rule 55, 58, 59, 64(1), 77(2), 95(2) or 108(2);

(ii) if a party is to be invited to file observations on particular questions or to submit documents, evidence, etc., to clarify the issues involved;

(iii) if, in the opinion of the Examining or Opposition Division, the patent cannot be granted or maintained in the text requested by the applicant or proprietor of the patent, but could possibly be granted or maintained in an amended text of more limited scope;

(iv) if information necessary to the conduct of the proceedings has to be communicated to the parties, e.g. in accordance with Rule 14(2) and (3), 35(4), or 142(2) and (3);

(v) for preparing oral proceedings, (see III, 5); or

(vi) if a decision is to be based on grounds on which the parties have not yet had an opportunity to comment (see X, 1).

1.2 Number of communications

Since each communication issued may entail prolonging the proceedings, the proceedings should be conducted in such a way as to manage with as few communications as possible. If a communication has to be issued, it should cover all the points which are necessary, or likely to be of importance, for the particular stage of the proceedings, e.g. the preparation of oral proceedings or of a decision.

1.3 Form of decisions, communications and notices

Rule 113(1) and (2)

Any decision, communication or notice from the EPO is to be signed by and to state the name of the employee responsible. Where these documents are produced by the employee responsible using a computer, a seal may replace the signature. Where the documents are produced automatically by a computer the employee's name may also be dispensed with. The same applies to pre-printed notices and communications.

2. Notification

2.1 General remarks

Art. 119
Rule 125
Rule 126

The EPO as a matter of course notifies those concerned of decisions and summonses, and of any notice or other communication from which a time limit is reckoned, or of which those concerned must be notified under other provisions of the EPC, or of which notification has been ordered by the President of the EPO. Notifications may, where exceptional circumstances so require, be given through the intermediary of the central industrial property offices of the Contracting States. In proceedings before the EPO, any notification to be made must take the form either of the original document, a copy thereof certified by, or bearing the seal of, the EPO, or a computer print-out bearing such seal. Copies of documents emanating from the parties themselves do not require such certification.

2.2 Method of notification

Rule 125(2) and (3)
Rule 127

Notification is to be by post, by delivery on the premises of the EPO, by public notice or by such technical means of communication as determined by the President of the EPO and under the conditions laid down by him governing their use. Further details concerning notifications are given in Rules 126 to 129. Notification through the central industrial property office of a Contracting State competent to deal with the addressee must be made in accordance with the provisions applicable to that office in national proceedings.

2.3 Notification by post

Rule 126

Notification is usually made by post. Decisions incurring a period for appeal or a petition for review, summonses and other documents as decided on by the President of the EPO must be notified by registered letter with advice of delivery. All other notifications by post must be by registered letter. The President of the EPO has, so far, not named any other documents to be notified by registered letter with advice of delivery.

The letter is deemed to be delivered to the addressee on the tenth day following its posting, unless the letter has failed to reach the addressee or has reached him at a later date; in the event of any dispute, it is incumbent on the EPO to establish that the letter has reached its destination or to establish the date on which the letter was delivered to the addressee, as the case may be.

Notification is deemed to have been effected even if acceptance of the letter has been refused.

The law of the state on the territory of which the notification is made applies to other matters concerning notification, e.g. the question whether delivery to a person other than the addressee constitutes an effective notification to the latter.

2.4 Notification to representatives

Rule 130

If a representative has been appointed, notifications must be addressed to him. If several such representatives have been appointed for a single interested party, notification to any one of them is sufficient. If several persons are joint applicants for or proprietors of a patent or have acted in common in filing notice of opposition or intervention and have not appointed a common representative, notification of one person, viz. the person referred to in Rule 151, will again be sufficient. If several interested parties have a common representative, notification of a single document to the common representative is sufficient.

2.5 Irregularities in the notification

Rule 125(4)

Where a document has reached the addressee, if the EPO is unable to prove that it has been duly notified, or if provisions relating to its notification have not been observed, the document is deemed to have been notified on the date established by the EPO as the date of receipt. In cases where the EPO is not able to prove the actual date of notification, a letter for instance, sent by the addressee himself which indicates the date of receipt, is accepted as proof. If it is evident from a reply from the addressee that he has received the document, although he does not mention the date of its notification, the date on which that reply was written is to be regarded as the date of notification.

Chapter II

Procedure for amendments to documents

1. Amendment by submitting missing documents or by filing replacement pages

The content of a European patent application or patent may be amended within the limits laid down in Art. 123(2) and (3). (For the conditions governing amendments, see also A-V, 2, C-VI, 5 and D-V, 6.) This will normally be done by submitting missing documents or by filing replacement pages. Where replacement pages are filed the applicant or patent proprietor should, in the interests of procedural efficiency, identify clearly all amendments made, and indicate on which passages of the original application these amendments are based.

2. Amendments using copies

Amendments, particularly to the description or claims, may be made by using copies in accordance with the following procedure:

If he deems it expedient, the examiner or formalities officer may, on a copy of one or more pages of the documents to be amended, put forward suggestions as to how amendments should be made in such a way as to take account of the objections raised. The annotated copies (not the working documents which are to remain in the dossier) will then be forwarded to the applicant or, in opposition proceedings, to the proprietor of the patent and the other parties, in the communication setting out the objections. In this communication, the applicant or proprietor will not only be informed of the deficiencies recorded and invited to adopt a position or submit amendments within a fixed time limit, but will also be invited simultaneously to resubmit the said copy and – as an alternative to submitting replacement pages – to indicate on this copy, separately from the comments of the examiner (preferably typewritten and in such a way as to be well legible after photocopying), any amendments to be made to the pages concerned. Opponents may also be invited to submit their comments in the same way.

The parties may also submit copies of one or more amended pages on their own initiative. The filing of completely retyped documents should normally be objected to, for reasons of procedural economy, as these documents will have to be checked for correspondence with the original documents (see T 113/92, not published in OJ). Only where the amendments are so extensive as to affect the legibility of the copies, replacement pages must be filed. In this case such pages may also be requested by the examiner on his own initiative.

3. Amendments made by the EPO at the request of a party and amendments made by a party at the EPO

Where necessary, deficient documents may also be amended at the request of a party by the competent department of the EPO. This will be the procedure for minor amendments, e.g. where it is necessary to insert details which were omitted in the request for grant, and the number of amendments involved is not excessively large, or where whole pages or paragraphs are to be deleted. The party concerned should submit a list summarising the amendments to be undertaken by the EPO. This procedure is also to be followed for minor amendments to drawings, e.g. for amending a reference number or deleting one or more whole figures (as regards the removal of references following an amendment to the description, see C-II, 4.8). In the case of complicated amendments to drawings, where it is not immediately clear how the changes are to be made, the party concerned, who as a rule is the applicant or proprietor, must submit replacement pages. A party may also make amendments himself at the EPO, for example when he attends to sign documents.

Chapter III

Oral proceedings

1. General

By "oral proceedings" is meant formal proceedings within the meaning of Art. 116. The term therefore does not include informal personal interviews or telephone conversations, such as occur in examination proceedings and limitation/revocation proceedings (see C-VI, 6). In view of Rule 81(2), such informal personal interviews or telephone conversations are not allowed in opposition proceedings, in which more than one party is involved, unless the interview or telephone conversation concerns matters which do not affect the interests of other parties. An example is proceedings for examining the admissibility of opposition, provided this involves only the EPO and the opponent concerned.

Oral proceedings will take place before the competent body, e.g. within the Receiving Section before the competent formalities officer and during the examination and opposition procedure before the whole Division. *Art. 18(2)* *Art. 19(2)*

2. Oral proceedings at the request of a party

If, in the course of proceedings, a party requests oral proceedings, the competent department must grant this request. The EPO will not inform the party concerned of this right but will expect him – if he does not obtain satisfaction from the competent department – to request oral proceedings (if he so wishes) before a decision is reached. *Art. 116(1)*

Nevertheless, oral proceedings will take place before the Receiving Section at the request of the applicant only where the Receiving Section considers this to be expedient or where it envisages refusing the European patent application. Where the Receiving Section does not consider it necessary to hold oral proceedings, it must inform the applicant accordingly (J 16/02). *Art. 116(2)*

The competent department will decide on the most appropriate date for the oral proceedings, which should only be held after the issues to be determined are sufficiently clear (see III, 5).

If the competent department considers that a decision on the matter may be reached on the basis of the written evidence obtained and intends to take a decision (e.g. in accordance with Art. 97, Art. 101 or Art. 105b) which fully concurs with the case put forward by the party or parties which requested the oral proceedings, the party or parties concerned should be informed accordingly and asked whether the request or requests for oral proceedings will be maintained even though the decision concurs with the case put forward; this will not apply if the party concerned has indicated that the request for oral

proceedings has been made solely as a precaution to cover the eventuality of the case put forward by him not being accepted. If the request is not expressly withdrawn, oral proceedings must be held.

3. Request for further oral proceedings

Art. 116(1)

The EPO may reject a request for further oral proceedings before the same department where the parties and the subject of the proceedings are the same.

Oral proceedings, particularly in opposition, are held to give the opportunity to finally discuss all matters raised and are normally terminated with a decision announced orally. The Division is bound by that decision, once announced, and it cannot reopen the proceedings to allow further submissions to be filed or to take into account new facts (see the last two paragraphs of VI, 2). Only if the Division, in the oral proceedings, has not announced a decision, but has decided to continue the proceedings in writing, can further submissions be examined. Such may be the case e.g. when the Examining Division indicates that it intends to grant a patent (or to limit a granted patent in limitation proceedings) on the basis of the documents filed during the oral proceedings.

Thus, as a rule, in examination, limitation or opposition proceedings there will be no justification for further oral proceedings, for example where one of the parties wishes to re-examine from a different viewpoint a subject already discussed in the course of the proceedings, either before or during the original oral proceedings. However, if the oral proceedings are not terminated with a decision and after the oral proceedings the subject of the proceedings changes, for example where fresh evidence is admitted into the proceedings after the original oral proceedings, then further oral proceedings will generally have to be held if requested (see T 194/96, not published in OJ).

4. Oral proceedings at the instance of the EPO

Art. 116(1)

The competent department of the EPO may arrange for oral proceedings to take place without a request from a party if it considers this to be expedient.

Oral proceedings will normally only be expedient if after an attempt at written clarification there are still questions or doubts which have a crucial bearing on the decision to be reached and which may be more efficiently or surely settled by oral discussion with the party or parties or if it is necessary to take evidence as part of oral proceedings (see IV, 1.3 and 1.6.1). The competent department should also bear in mind the need for economy in such procedures, since oral proceedings give rise to costs for both the EPO and the party or parties.

5. Preparation of oral proceedings

The purpose of oral proceedings should be to settle as far as possible all outstanding questions relevant to the decision. To this end

proceedings should be carefully prepared after examination of all the written matter submitted and with this in mind the most appropriate date for conducting oral proceedings chosen.

Insofar as certain questions relevant to the decision are considered by the EPO to require discussion, it will in many cases be expedient to inform the party or parties in a notice and possibly also to invite one or more of the parties to submit written observations or to produce evidence, where appropriate. Parties may produce evidence in support of their arguments on their own initiative. Where, however, the evidence is such as should have been put forward at an earlier stage, e.g. in opposition proceedings pursuant to D-IV, 1.2.2.1(v) and 5.4, it is for the competent body to consider whether the evidence not filed in due time is to be admitted (see VI, 2). Any observations should be received in time for them to be communicated to the other parties at the latest one month before the oral proceedings. The time limit for submission of observations should be fixed accordingly, particularly where the invitation to file observations is issued at the same time as the summons to oral proceedings.

6. Summons to oral proceedings

All parties must be duly summoned to oral proceedings by notification. The summons must state the subject and the date and time of the oral proceedings. *Rule 115(1)* *Art. 119*

The summons will also be accompanied by a note drawing attention to the points which need to be discussed, will normally contain the provisional and non-binding opinion of the Division and will also fix a date up to which written submissions may be filed or amendments which meet the requirements of the EPC may be submitted (see also D-VI, 3.2). *Rule 116(1)*

At least two months' notice of the summons must be given unless the parties agree to a shorter period. The summons must state that if a party duly summoned does not appear as summoned, the proceedings may continue without him. *Rule 115(1)*

In opposition proceedings as a rule, even oral proceedings requested on the basis of totally different grounds for opposition should be conducted as a single set of proceedings.

7. Requests for the postponement of oral proceedings

A request for the postponement of oral proceedings is allowable only if the party concerned can advance serious reasons which justify the fixing of a new date (see T 1080/99, OJ 12/2002, 568, T 300/04, J 4/03 and T 178/03). The request to fix another date must be filed as soon as possible after the grounds preventing the party concerned from attending the oral proceedings have arisen. It must be accompanied by a sufficiently substantiated written statement indicating these reasons (see OJ EPO 1/2009, 68; see also T 178/03). A request to have oral proceedings held at an EPO site

other than that indicated in the summons is not allowable (see T 1012/03).

8. Conduct of oral proceedings

8.1 Admission of the public to proceedings

Art. 116(3) Oral proceedings before the Receiving Section, the Examining Divisions and the Legal Division are not public.

Art. 116(4) Oral proceedings, including delivery of the decision (see III, 9), are public before the Opposition Divisions insofar as the Opposition Division does not decide otherwise in cases where admission of the public could have serious and unjustified disadvantages, in particular for a party to the proceedings. This could, for example, be the case if one of the parties wishes to give information about sales figures or other commercial secrets in support of his case. Generally, the public will only be excluded whilst such information is being given.

8.2 Conduct of oral proceedings

Before the Receiving Section oral proceedings will be conducted by the formalities officer and before the Examining or Opposition Divisions by the Chairman of the Division concerned.

The responsibilities of the person conducting the proceedings will include keeping order and conducting the proceedings as regards their formal and substantive aspects.

The person conducting the proceedings must in particular ensure that, where necessary, a list is prepared of all disputed or unclear points relevant to the decision to be reached, that these are discussed and that the party or parties have the opportunity of commenting on them.

On the other hand, the oral proceedings are to be conducted strictly and efficiently, so that the submissions of the party or parties and the discussions are not unnecessarily digressive and do not deal with points which are of no relevance to the decision to be reached. Repetition should be avoided as far as possible. In particular, written material submitted at the appropriate time to the competent department and to the party or parties which has already been the subject of proceedings need not be read out in extenso. A simple reference to such written material may suffice.

8.3 Opening of oral proceedings: non-appearance of a party

The person conducting the proceedings will have the particulars of the persons taking part taken and their authorisations checked, where necessary, before the start of the oral proceedings. Parties and their representatives must identify themselves unless they are known to the person conducting the proceedings or any of the members of the Examining or Opposition Division. If parties do not appear or are not

represented, a check will be made that they were duly summoned. The oral proceedings are then opened.

The person conducting the proceedings will introduce the parties present. He will have the particulars of the persons taking part in the proceedings recorded and will establish in what capacity they are present. Details of these steps and any consequences thereof will be recorded in the minutes (see III, 10).

If an absent party was not duly summoned, this is noted in the minutes and the oral proceedings are closed. A new date must be fixed for further oral proceedings.

If a party who has been duly summoned to oral proceedings does not appear as summoned, the oral proceedings may be conducted without him, since a party should not be able to delay issuance of a decision by failing to appear. *Rule 115(2)*

If, however, an allowable request for the postponement of oral proceedings has been filed (see III, 7), the proceedings should be postponed and a new date fixed. If the filing of the request was delayed due to the carelessness of the party concerned, the proceedings may, depending on the circumstances, still be postponed; if this happens in opposition proceedings, a decision on the apportionment of costs may have to be taken (see D-IX, 1.4). *Art. 104(1)*

If new facts or evidence are submitted during inter-partes oral proceedings which a party, although duly summoned, fails to attend, it must first be examined whether these submissions may be disregarded (Art. 114(2); see also III, 8.6 and VI, 2).

Following G 4/92 (OJ 3/1994, 149), if new facts are taken into consideration, then at the end of the oral proceedings a decision based on these facts cannot be taken against the absent party. Further, new evidence can only be used against the absent party if it has been previously notified and merely supports the previous assertions of the party who submits it. However, new arguments may be used at any time, insofar as they do not change the grounds on which the decision is based.

In other words, what the Enlarged Board of Appeal ruled out in G 4/92 was the possibility of taking decisions against the absent party on the basis of a surprising course of events at the oral proceedings, which changes the legal and factual framework of the case in an unforeseeable way (see T 414/94, not published in OJ).

An absent party cannot be considered taken by surprise if during oral proceedings the other side attempts to overcome objections raised before the oral proceedings. In particular, a submission during oral proceedings of a more restricted and/or formally amended set of claims with a view to overcoming the objections of the opponent is not

considered a "new fact" (see T 133/92 and T 202/92, neither published in OJ). Nor is it unexpected that amended claims are examined for formal admissibility and for compliance with Art. 123(2) and (3) (see T 341/92, OJ 6/1995, 373).

In the particular case of an absent opponent, if new prior art is submitted for the first time during oral proceedings which may be an obstacle to the maintenance of the opposed patent, this new prior art can be taken into consideration despite the opponent's absence because it is in the opponent's favour (see T 1049/93, not published in OJ).

8.4 Opening of the substantive part of the proceedings

Insofar as necessary, the person conducting the proceedings will outline the stage reached in the proceedings and will indicate the most important matters in dispute according to the file. In examination or opposition proceedings this may also be done by the primary examiner.

8.5 Submissions by the parties

After the introduction referred to above, the party or parties will be allowed the floor in order to put their cases and to make applications on procedural matters and state the grounds thereof. In the normal course of events each party should have only one opportunity of making a comprehensive statement.

In opposition proceedings the opponents will generally speak first and the patent proprietor afterwards. Where there are a number of opponents, it may be expedient to grant the patent proprietor an opportunity of replying directly after the statement of each individual opponent. The opponents and the patent proprietor should be given the opportunity of making a final reply.

The submissions of the party or parties may be prepared in writing, although they should as far as possible be made extemporaneously. Passages from documents already introduced into the proceedings which are referred to again should only be read out where their precise wording is relevant.

Submissions by a person who is not qualified under Art. 133 and Art. 134 to represent parties to proceedings before the EPO may be admitted at oral proceedings when this person accompanies a professional representative representing that party. Such submissions, however, cannot be made as a matter of right, but only with the permission and at the discretion of the Examining or Opposition Division. In opposition proceedings the Division should consider in exercising its discretion whether (see G 4/95, OJ 7/1996, 412):

(i) the party on behalf of which the person is to speak has filed a request to this effect;

(ii) the party making the request has indicated the name of the person, the subject-matter of the submission and the person's qualification to speak on this matter;

(iii) the request has been filed sufficiently in advance of the oral proceedings;

(iv) in the case of a late-filed request, either there are exceptional circumstances justifying the admission of the submission or all the other parties agree to the making of the submission; and

(v) the submissions are made under the continuing responsibility and control of the professional representative.

If neither of the alternative conditions mentioned under (iv) are met, a late-filed request should be refused. The time limit to be applied when deciding whether a request was late-filed is that fixed in the summons under Rule 116.

If a party is represented by an authorised employee rather than a professional representative, the same considerations apply in respect of a person accompanying the authorised employee.

Parties are not to be considered as accompanying persons in the sense of G 4/95 (OJ 7/1996, 412) (see T 621/98, not published in OJ). They have the right to make submissions in oral proceedings by virtue of their status as party to the proceedings.

If written submissions are made during oral proceedings, it is the responsibility of the Division to make sure that the formal requirements such as readability, signature and dating of the submissions are met (see T 733/99).

8.6 Facts, evidence or amendments introduced at a late stage

With respect to facts and evidence not submitted in due time or arguments presented at a late stage in the proceedings in general, see VI, 2. Concerning facts and evidence not filed within the opposition period, see D-IV, 1.2.2.1(v).

Rule 116(1)

Rule 116(1), being an implementation of Art. 114(2) as a further development on the existing jurisprudence regarding facts or evidence not filed in due time, makes it clear that the Examining or Opposition Division has a discretion to disregard new facts or evidence for the reason that they have not been filed before the date indicated in the summons under Rule 116, unless they have to be admitted because the subject of the proceedings has changed. An example of such a change would be where, in timely response to the points raised in the note annexed to the summons, the proprietor files amendments which have the result that a new document becomes relevant; in such a case the opponent should be allowed to present this document and must be given a chance to comment on the

amendments (Art. 113(1)). A further example is where a new ground of opposition is introduced during oral proceedings: the opponent should always be granted the right to be heard, even where the arguments concern a late-filed ground of opposition and new arguments and evidence related to it (T 117/02).

Rule 116(2)

Rule 116(2) imposes the same obligations on the applicant or patent proprietor when submitting new documents which meet the requirements of the EPC (i.e. new amendments to the description, claims and drawings) as Rule 116(1) imposes on the parties in submitting new facts and evidence. Here the Division also has the discretion to disregard amendments because they are filed too late before the oral proceedings. However, where the opponent files, before the indicated date, pertinent new material, the patent proprietor must be given a chance to present his comments and submit amendments (Art. 113(1)).

Analogously, the proprietor should always be given the opportunity to submit amendments intended to overcome objections raised by the Division which depart from a previously notified opinion (T 273/04).

Rule 116(1) and (2)

In exercising this discretion, the Division will in the first place have to consider the relevance of the late-filed facts or evidence (see VI, 2) or the allowability of the late-filed amendments, on a **prima facie** basis. If these facts or evidence are not relevant or if these amendments are clearly not allowable, they will not be admitted. Before admitting these submissions, the Division will next consider **procedural expediency**, the **possibility of abuse of the procedure** (e.g. one of the parties is obviously protracting the proceedings) and the question whether the parties **can reasonably be expected** to familiarise themselves in the time available with the new facts or evidence or the proposed amendments.

As regards **procedural expediency:** where the late-filed facts or evidence are relevant, but their introduction would cause a prolonged adjournment of the proceedings, the Division may decide to not admit these facts or evidence in the proceedings. An example would be where the witness lives abroad and still has to be found or lengthy tests are still necessary. The Division may, however, also postpone the proceedings and in doing so may have to consider the apportionment of costs in opposition proceedings (Art. 104).

An example of possible **abuse of the proceedings** would be a proliferation of auxiliary requests, introduced at short notice by the patent proprietor, which are not a reaction to the course of the proceedings. Another example would be an opponent who files an assertion of public prior use, based on activities of the opponent himself, late in the absence of good reasons for the delay (see T 534/89, OJ 7/1994, 464). Another would be the filing of requests subject to conditions to be met by the Division. It is the duty of any

party to proceedings to make its own case and to formulate its own requests (see T 446/00).

In opposition proceedings the parties should be heard on such matters. If the Opposition Division approves the introduction of new facts or evidence and if the other parties have not had sufficient time to study them, it should, where easily comprehensible subject-matter is involved, grant the parties an opportunity of familiarising themselves with it, possibly by briefly interrupting the oral proceedings. If this is not feasible, the other parties must, upon request, be given the opportunity to comment in the proceedings subsequent to the oral proceedings, where appropriate in a further set of oral proceedings. Where possible, however, oral proceedings should not be adjourned. Where possible, legal commentaries, decisions (of a Board of Appeal, for example) and reports on legal decisions which are to be referred to in oral proceedings should be notified to the Opposition Division and the other parties in good time before the proceedings. They may, however, be quoted or submitted for the first time in the oral proceedings themselves if the Opposition Division agrees after consulting the parties.

As regards the costs which may be incurred for late submissions, see D-IX, 1.4.

8.7 Discussion of the facts and of the legal position

A discussion will be conducted with the party or parties concerning those technical or legal questions which are relevant to the decision and which, after the parties have made their submissions, do not appear to have been sufficiently clarified or discussed or are seemingly contradictory. Where necessary, it should be ensured that the party or parties file requests which are to the point and that the applicant or proprietor formulates the claims appropriately.

If the Examining or Opposition Division finds that some patentable subject-matter results from a limitation or an amendment of the claims, it should inform the applicant or proprietor of the fact and allow him an opportunity to submit amended claims based thereon.

If the competent department intends to depart from a previous legal assessment of the situation with which the parties are acquainted or from a prevailing legal opinion, or if facts or evidence already introduced into the proceedings are seen in a different light – e.g. during the deliberations of the Examining or Opposition Division (see III, 8.9) – so that the case takes a significant turn, the parties should be informed thereof.

8.8 Right of the other members of the Examining or Opposition Division to put questions

The Chairman must allow any member of the Examining or Opposition Division who so requests to put questions. He may

determine at which point in the proceedings such questions may be put.

In oral proceedings, questions may be put to the parties in connection with their statements or the discussion of the facts or of the legal position. When evidence is taken as part of oral proceedings questions may also be put to the witnesses, parties and experts called. As regards the right of the parties to put questions, see IV, 1.6.7.

8.9 Closure of oral proceedings

If the competent department considers that the matter has been sufficiently thoroughly discussed, it must decide on the subsequent procedure to be followed. Where the department consists of a number of members – as in the case of the Examining and Opposition Divisions – they must, if necessary, deliberate on the matter in the absence of the parties. If new aspects emerge during the discussion and require further questions to be put to the parties, the proceedings may be restarted. The person conducting the proceedings may thereafter give the decision of the department. Otherwise he should inform the party or parties of the subsequent procedure and then close the oral proceedings.

While the department is bound by the decision it issues on substantive matters (see III, 9), it is free, as a result of further reflection, to inform the parties that it intends to depart from the procedure which it has announced.

The subsequent procedure may, for example, consist in the department issuing a further communication, imposing certain requirements on one of the parties, or informing the parties that it intends to grant or maintain the patent in an amended form. As regards the delivery of a decision in the last case, see III, 9.

If the patent is to be granted or maintained in an amended form, it should be the aim to reach an agreement upon the final text in the oral proceedings. If, however, the Examining or Opposition Division indicates during the oral proceedings that it would be willing to grant or maintain a European patent provided that certain amendments are made which could not reasonably have been foreseen from the earlier procedure, the applicant or patent proprietor will be given a time limit of normally 2 to 4 months in which to submit such amendments. If the applicant or patent proprietor fails to do so, the application will be refused or the patent will be revoked.

9. Delivery of the decision

Rule 111(1) and (2)

The delivery of the decision will follow a statement by the person conducting the proceedings announcing the operative part of the decision (see also III, 8.9 and X, 4).

The operative part may, for example, read as follows:

"The patent application ... is refused." or

"The opposition to the patent ... is rejected." or

"The patent ... is revoked." or

"Taking account of the amendments made by the proprietor in the opposition proceedings, the patent and the invention to which it relates satisfy the requirements of the Convention." or

"The request for limitation of the patent .... is allowable." or

"The request for limitation of the patent .... is rejected."

Once a decision has been pronounced, submissions of the party or parties cannot be considered any longer and the decision stands, subject to the correction of errors in accordance with Rule 140. It may only be amended by appeal (see XI, 1, 7 and 8).

No pronouncement need be made at this point as to the reasons for the decision or the possibility of appeal. However, the Examining or Opposition Division may give a short explanation of the reasons for the decision.

Subsequently the decision in writing containing the reasoning and information as to right of appeal must be notified to the parties without undue delay. The period for appeal will only begin to run from the date of notification of the written decision.

Generally speaking it will not be possible to give a decision granting a European patent or maintaining it in amended or limited form in oral proceedings since, in the case of the grant of a patent, the requirements laid down in Rule 71(3)-(7), and in the case of a patent being maintained in amended or limited form, the requirements of Rule 82(1) and (2) or Rule 95(3) must be fulfilled.

10. Minutes of oral proceedings

(As regards the minutes of taking of evidence, see IV, 1.7.)

10.1 Formal requirements

Minutes of oral proceedings must be drawn up. *Rule 124(1)*

The person conducting the proceedings must ensure that during the whole proceedings an employee is available to keep minutes. If necessary, during oral proceedings different employees may carry out the task of minute-writing in sequence. In this case it must be made clear in the minutes which section was drawn up by which employee. The employees are normally members of the competent department, e.g. the Examining or Opposition Division. The minutes are normally taken down by hand by the member of the Division charged with this

task. Following the proceedings, the handwritten minutes are typed out.

Rule 124(3) and (4) The minutes must be signed by the employee responsible for drawing them up and by the employee who conducted the oral proceedings. The parties must be provided with a copy of the minutes. Copies must be notified to them as soon as possible after the oral proceedings.

Provided the parties have been informed, oral proceedings may be recorded on sound recording apparatus. However, no person other than an EPO employee is allowed to introduce any such apparatus into the hearing room (see Notice of the Vice-Presidents of the Directorates-General 2 and 3 dated 25 February 1986 concerning sound recording devices in oral proceedings before the EPO, OJ 2/1986, 63). The recording should be kept until the end of any possible proceedings. Copies of the recording will not be provided to the parties.

The minutes must first include the date of the proceedings, the names of the members of the department, e.g. the Opposition Division, present and the name or names of the minute-writer or writers. Minutes must also include the details referred to in III, 8.3.

10.2 Subject-matter of minutes

Rule 124(1) Minutes must contain the essentials of the oral proceedings and the relevant statements made by the parties.

Relevant statements are, for example, new or amended procedural submissions or the withdrawal thereof, the fresh submission or amendment or withdrawal of application documents, such as claims, description and drawings, and statements of surrender.

The essentials of the oral proceedings include new statements by the party or parties and by the member or members of the department concerning the subject-matter of the proceedings. In examination and opposition proceedings, the essentials are principally new statements arguing the presence or lack of novelty, inventive step and other patentability criteria.

If in the course of the procedure prior to oral proceedings the department has delivered an opinion – e.g. on patentability – and changes this opinion in response to arguments put forward by the parties, e.g. following the deliberations of the Examining or Opposition Division, this must be mentioned in the minutes, with a statement of the reasons for doing so. The minutes should also contain procedural information, such as how the proceedings are to be continued after closure of the oral proceedings.

If a decision is given, the wording of the operative part must be reproduced in the minutes.

If the exact wording of a statement or submission is not of importance, only a concise summary of the essentials should appear in the minutes.

The minutes with the result reached during the proceedings are communicated to the parties as soon as possible.

Chapter IV

Taking and conservation of evidence

1. Taking of evidence by the departments of the EPO

1.1 General remarks

Formal taking of evidence in accordance with Rule 117 will occur mainly in opposition proceedings and hardly ever before the Examining Division. The following Sections of this Chapter are therefore based primarily on opposition proceedings. However, they also apply mutatis mutandis to other proceedings and particularly to substantive examination.

Art. 117
Rule 117

1.2 Means of evidence

The party or parties may at any time during proceedings submit evidence in support of alleged facts (see III, 5, X, 1.2, D-IV, 5.3 and 5.4, and D-VI, 3). This should be done at the earliest opportunity. When such evidence is such as should have been put forward at an earlier stage it is for the competent department to consider whether it is expedient (see VI, 2) to allow the new evidence to be introduced.

Art. 117(1)

It would generally be desirable for a party to produce evidence in respect of all the facts alleged in support of his case, in order, for example, to show whether a particular technique was generally known to industry or whether there was any prejudice against a particular technique.

Facts adduced by a party will, however, normally be deemed true, even without supporting evidence, if it is clear that no doubts exist concerning them, if they do not contradict one another or if no objection is raised. In such cases the facts need not be supported by evidence.

There will however be occasions, particularly in opposition proceedings, in which the arguments of the party or parties must be supported by evidence. This will for example be the case where reference is made to prior art, for instance in the form of an oral description, a use or perhaps a company publication and there is some doubt as to whether, and if so when, such prior art was made available to the public.

The means of evidence which are admissible in proceedings before the EPO are (non-exhaustively) listed in Art. 117(1):

– production of documents;

– hearing the parties;

– hearing witnesses;

– sworn statements in writing;

– requests for information, for instance from a publisher concerning the date of publication of a book

– opinions by experts (see IV, 1.8.1); and

– inspection.

The most appropriate way of obtaining evidence in the individual case depends on the facts which have to be proven and on the availability of the evidence. To prove prior use in an opposition, the opponent usually offers as evidence the production of documents, the hearing of witnesses or parties, or he presents sworn statements in writing. It is at the Opposition Division's discretion to evaluate this evidence, there being no fixed rules as to how any category of evidence should be judged (for the evaluation of evidence, see IV, 4).

If the documents produced (e.g. patent documents) leave no doubt as to their contents and date of availability to the public and are more relevant for the patent in suit than other evidence offered, reasons of procedural efficiency may lead the Opposition Division to not pursue the other evidence at first.

If the testimony of a witness is offered, the Opposition Division may decide to hear this person in order to verify the facts for which this witness is brought forward, e.g. the prior use of the claimed product in an undertaking or the existence of an obligation to secrecy. For adequate substantiation the notice of opposition should make clear these facts, as witnesses are meant to serve for corroboration of facts brought forward, not for supplying these facts in place of the opponent. The above applies likewise to hearing the parties (see also IV, 1.6)

Whether a written statement ("affidavit") is made under oath or not is only one of the criteria applied by the Opposition Division in its evaluation of the evidence adduced. Apart from its relevance for the case, other criteria are the relationship between the person making the statement and the parties to the proceedings, the personal interest of that person, the context in which the statement was made, etc. Such a statement does not go beyond its literal content and does not allow the Opposition Division to assess the associated or background factors. If the alleged facts are contested by the other party, the Opposition Division does not generally base its decision on such a statement, but summons the person making the statement as a witness, if so offered by the party. The ensuing hearing of the witness allows the Opposition Division and the parties to put questions to the witness and thus enables the Opposition Division to establish the facts on the basis of that person's testimony. If that person is not offered as a witness, the Opposition Division will not pursue this evidence further.

Inspection will enable direct observations to be made and direct impressions to be formed of the object or process concerned. It may, for example, involve the demonstration of a product or process requested by the applicant or proprietor of the patent to substantiate the method of operation of the subject-matter of the patent where this is disputed by the Examining or Opposition Division.

1.3 Taking of evidence in substantive examination and opposition proceedings

Art. 117(2)
Rules 118 to 120

The department responsible for the taking of evidence in the form of a hearing of witnesses, parties and experts will, in substantive examination and opposition proceedings, be the Division before which the taking of evidence as part of oral proceedings would normally take place. However the Division may commission one of its members to examine the evidence adduced. Generally, he will be the primary examiner under Art. 18(2) or Art. 19(2). A member may, for example, be commissioned pursuant to Rule 119(1), for the purposes of an inspection, such as in the form of a demonstration of a process or the investigation of an object, particularly in undertakings located far away.

A member may also be commissioned to attend a court hearing pursuant to Rule 120(3), and put questions to the witnesses, parties and experts.

1.4 Order to take evidence

Rule 117

Where the competent department of the EPO considers it necessary to hear the oral evidence of parties, witnesses or experts or to carry out an inspection, it must make a decision to this end (order to take evidence), setting out the investigation which it intends to carry out, relevant facts to be proved and the date, time and place of the investigation. If oral evidence of witnesses and experts is requested by a party but the witnesses and experts are not simultaneously named, the party is requested, either prior to the issue of the order to take evidence or in the order itself, to make known within a specified time limit the names and addresses of the witnesses and experts whom it wishes to be heard. The time limit to be computed in accordance with Rule 132(2) will be not less than two months and not more than four months, since the party concerned will normally know beforehand whom he wishes to be heard as a witness or expert.

Art. 119

The order to take evidence must be notified to the parties. It may be appealed only together with the final decision, unless it allows separate appeal (see X, 6).

1.5 Summoning of parties, witnesses and experts

Art. 119
Rule 118(1) and (2)

The parties, witnesses and experts to be heard must be invited to appear to give evidence on the date fixed. The summons must be notified. At least two months' notice of a summons issued to a party, witness or expert to give evidence must be given, unless they agree to a shorter period. The summons must contain:

Rule 118(2)(a) (i) an extract from the order to take evidence, indicating in particular the date, time and place of the investigation ordered and stating the facts regarding which parties, witnesses and experts are to be heard;

Rule 118(2)(b) (ii) the names of the parties to the proceedings and particulars of the rights which the witnesses or experts may invoke (see IV, 1.10); and

Rule 118(2)(c) (iii) an indication that the party, witness or expert may request to be heard by the competent court of his country of residence and a requirement that he informs the EPO within a time limit to be fixed by the EPO whether he is prepared to appear before it (see IV, 3.2.2 (iii) and (iv)).

Rule 119(3) Even if evidence is not taken in oral proceedings, all parties to the proceedings may attend an investigation. Parties not summoned should be informed thereof within the period laid down in Rule 118(2), together with a statement that they may attend.

1.6 Hearing of parties, witnesses and experts

1.6.1 General remarks

Where the Examining or Opposition Division holds hearings for the purpose of taking evidence (see IV, 1.3) and if the case in question is expected to give rise to particular legal issues, it is advisable that the Division should be enlarged by the addition of a legally qualified examiner, if this is not already the case (see D-II, 2.2).

Where a hearing is held in connection with oral proceedings, the considerations set out in III, 8.2, 8.3, 8.8 and 8.9 are directly applicable, and where this is not the case they apply mutatis mutandis.

The hearing of an "expert" in the sense of Rule 117 requires as a precondition a decision to take evidence (see IV, 1.4). This is different from hearing oral submissions by a person accompanying the representative during oral proceedings, which can be allowed at the discretion of the Division (see G 4/95, OJ 7/1996, 412 and III, 8.5).

1.6.2 Witnesses and experts not summoned

After opening the proceedings for the taking of evidence, the official in charge of the taking of evidence, i.e. in substantive examination and opposition proceedings the Chairman of the Division concerned or the member commissioned for the taking of evidence, will determine whether any party requests that any other person present but not summoned should be heard. If a party makes such a request he should briefly state why and to what purpose the person concerned should give testimony. The department in question will then decide on whether or not to grant the request (for the admission of facts or evidence not filed in due time see VI, 2).

1.6.3 Guidance to persons heard

Before a party, witness or expert may be heard, he must be informed that the EPO may request the competent court in the country of residence of the person concerned to re-examine his evidence on oath or in an equally binding form. *Rule 119(2)*

1.6.4 Separate hearings

Normally each witness must be heard separately, i.e. any other witnesses to be heard subsequently must not be present. This rule does not apply to experts and to the parties. Witnesses whose statements conflict may be confronted with one another, i.e. each heard in turn in the presence of the other. The same applies to experts.

1.6.5 Examination as to personal particulars

The hearing will begin by the person giving evidence being asked his given names, family name, age, occupation and address. Witnesses and experts must also be asked whether they are related by blood or marriage with any of the parties and whether they have a material interest in a particular party being successful in the proceedings.

1.6.6 Examination as to res gestae

The examination as to personal particulars will be followed by the examination as to res gestae. The person testifying should be instructed to give a full and logical account of what he knows concerning the subject-matter of the hearing. Further questions may have to be put to clarify and supplement statements and to establish on what the knowledge of the person testifying is based. Such questions may be put by the member commissioned for the taking of evidence, where applicable, the Chairman or any other member of the department concerned. As regards the entitlement of other members of the Division to put questions, see III, 8.8. When formulating questions the same considerations apply as for the parties (see IV, 1.6.7).

1.6.7 Entitlement of parties to put questions at hearings

The parties may put relevant questions to the testifying parties, witnesses and experts including, e.g. in opposition proceedings, witnesses and experts testifying on behalf of other parties. The official in charge of the taking of evidence will determine at what point in the proceedings such questions may be put. *Rule 119(3)*

Any doubts on the part of the competent department, e.g. the Opposition Division, or a party as to the admissibility of a question must be settled by the competent department. "Leading questions", i.e. questions which already contain the statement which one would like to hear from the witness, practically only requiring him to answer by "yes" or "no", should be avoided, because they do not allow to properly establish the witness' own recollection of the facts. Questions may further not be directed to facts which require no further discussion, which are in no way relevant to the subject-matter

for which the taking of evidence has been ordered, or if they aim at establishing facts in respect of which no evidence has been offered. A decision to reject a question cannot be challenged. As regards the entitlement of other members of the Division to put questions, see III, 8.8.

1.7 Minutes of taking of evidence

Rule 124(1)

Minutes of the taking of evidence must be drawn up as described in III, 10, subject to the following qualifications:

The minutes of the taking of evidence must, in addition to the essentials of the taking of evidence, also record as comprehensively as possible (almost verbatim as far as the essential points are concerned) the testimony of the parties, witnesses or experts.

Rule 124(2)

The minutes will normally be taken down by a member of the competent department carrying out the taking of evidence. The most efficient way of noting testimony is by way of dictation on to a dictating machine, in the process of which the person hearing the evidence will summarise the testimony in small sections, taking into account any objections raised by the person being heard, and dictate it in this form on to a dictating machine. If the dictated passage does not correspond in full to his testimony, the person being heard should raise any objections immediately. This should be pointed out to him at the beginning of his testimony. At the end of his testimony, he will be asked to approve the dictated minutes, which he will have listened to as they were dictated. His approval or any objections should be included in the dictated text. The dictated minutes are typed out and the parties are provided with a copy as soon as possible. It is not necessary to play back the minutes or to obtain approval of them if the testimony has been recorded verbatim and directly, using technical means.

Where the taking of evidence includes an inspection, the minutes must record, in addition to the essentials of the proceedings, the results of the inspection.

In addition, the taking of evidence as well as oral proceedings (see III, 10.1) may be recorded on sound recording apparatus.

1.8 Commissioning of experts

1.8.1 Decision on the form of the opinion

Rule 121(1)

If the competent department decides of its own motion to obtain an expert opinion (D-VI, 1, 6th paragraph), it will have to decide in what form it should be submitted by the expert whom it appoints. The opinion should be drawn up in written form only in cases where the competent department considers that this form is adequate in view of the content of the opinion and provided that the parties agree to this arrangement. As a rule, in addition to submitting a written opinion and introducing it orally, the expert will also be heard (see IV, 1.6).

A copy of the opinion must be submitted to the parties. The copy will be produced by the EPO. *Rule 121(3)*

1.8.2 Objection to an expert

The parties may object to an expert. Therefore, before commissioning an expert to make an opinion, the competent department should inform the parties of the expert whom it intends to ask to draw up an opinion and of the subject-matter of the opinion. The communication to the parties should state a time limit within which objections to the expert may be made. If the parties do object to an expert, the competent department will decide on the objection. *Rule 121(4)*

1.8.3 Terms of reference of the expert

The terms of reference of the expert must include: a precise description of his task, the period laid down for the submission of his opinion, the names of the parties to the proceedings and particulars of the rights which he may invoke under the provisions of Rule 122(2) to (4) (regarding travel and subsistence expenses and fees, see IV, 1.10). *Rule 121(2)(a)-(d)*

1.9 Costs arising from oral proceedings or taking of evidence

As a rule, each party to proceedings before the EPO meets the costs he has incurred. This principle notwithstanding, the competent body in the opposition proceedings may for reasons of equity (cf. D-IX, 1.4) decide to apportion in some other way the costs arising for the parties in respect of oral proceedings or taking of evidence (cf. D-IX, 1) and the costs arising for the EPO in respect of witnesses and experts (cf. IV, 1.10). The competent body may make the taking of evidence conditional upon deposit with the EPO by the party who requested the evidence to be taken of a sum the amount of which is to be fixed by reference to an estimate of the costs. This procedure should be applied where at the request of a party to grant or opposition proceedings evidence is to be taken by hearing witnesses or seeking an expert opinion, unless no costs will arise because the witness or expert has waived his right to indemnification. If the party requesting evidence to be taken does not comply with the requirement of making such a deposit, the evidence need not be taken. In opposition proceedings the party requesting the evidence bears the costs of indemnifying witnesses or experts, unless for reasons of equity in individual cases other arrangements are made for the apportionment of costs under Art. 104(1) in conjunction with Rule 88. Any shortfall between the deposit lodged and the amounts payable by the EPO under Rule 122(4), 2nd sentence, is fixed by the EPO of its own motion. Any unused amount of the deposit lodged is refunded. The Office's internal costs arising through oral proceedings or taking of evidence, e.g. any associated staff travel and subsistence costs, are to be met by the EPO itself. *Art. 104(1) and (2)* *Rule 122(1) and (2)*

1.10 Entitlements of witnesses and experts

1.10.1 Expenses for travel and subsistence

Rule 122(2) Witnesses and experts who are summoned by and appear before the EPO are entitled to appropriate reimbursement, by the EPO, of expenses for travel and subsistence (see IV, 1.10.3). This applies even if the witnesses or experts are not heard, e.g. where evidence is to be produced concerning an alleged prior use and shortly before the taking of evidence such prior use is substantiated by a document already published. Witnesses and experts may be granted an advance on their expenses for travel and subsistence. Witnesses and experts who appear before the EPO without being summoned by it but are heard as witnesses or experts will also be entitled to appropriate reimbursement of expenses for travel and subsistence.

1.10.2 Loss of earnings, fees

Rule 122(3) Witnesses entitled to reimbursement of travel and subsistence expenses are also entitled to appropriate compensation, by the EPO, for loss of earnings, and experts to fees from the EPO for their work (see IV, 1.10.3). These payments must be made to the witnesses and experts after they have fulfilled their duties or tasks.

1.10.3 Details of the entitlements of witnesses and experts

Rule 122(4) The Administrative Council of the European Patent Organisation has laid down the details governing the entitlements of witnesses and experts set out under IV, 1.10.1 and 1.10.2, see document CA/D 5/77 (published in OJ 3/1983, 100). Payment of amounts due must be made by the EPO.

2. Conservation of evidence

2.1 Requirements

Rule 123(1) On request, the EPO may, without delay, hear oral evidence or conduct inspections, with a view to conserving evidence of facts liable to affect a decision, where there is reason to fear that it might subsequently become more difficult or even impossible to take evidence. This could for example be the case where an important witness is about to emigrate to a distant country or where perishable matter, e.g. a food-stuff, is adduced as involving a use made accessible to the public.

2.2 Request for the conservation of evidence

Rule 123(2) The request for the conservation of evidence must contain:

Rule 123(2)(a) (i) the name, address and nationality of the person filing the request and the State in which his residence or principal place of business is located, in accordance with the provisions of Rule 41(2)(c);

Rule 123(2)(b) (ii) sufficient identification of the European patent application or European patent in question;

(iii) the designation of the facts in respect of which evidence is to be taken; *Rule 123(2)(c)*

(iv) particulars of the way in which evidence is to be taken; and *Rule 123(2)(d)*

(v) a statement establishing a prima facie case for fearing that it might subsequently become more difficult or impossible to take evidence. *Rule 123(2)(e)*

The request is not deemed to have been filed until the fee for conservation of evidence has been paid. *Rule 123(3)*

2.3 Competence

The decision on the request and any resulting taking of evidence are incumbent upon the department of the EPO required to take the decision liable to be affected by the facts to be established. *Rule 123(4)*

Responsibility for the decision and the taking of evidence will therefore normally rest with:

(i) the Examining Division, from the date of filing until the date of the decision on the granting of the patent;

(ii) the Opposition Division, from the latter date until expiry of the time allowed for filing notice of opposition and during opposition proceedings; and

(iii) the Board of Appeal, from the date of a final decision by the Opposition Division until it becomes legally binding or while appeal proceedings are pending.

2.4 Decision on the request and the taking of evidence

The competent department must decide upon the request without delay. If it grants the request, it must also immediately make a decision on the taking of evidence. *Rule 123(1)* *Rule 117*

The provisions with regard to the taking of evidence in proceedings before the EPO are applicable. *Rule 123(4)*

The date on which the measures are to be taken must therefore be communicated to the applicant for or proprietor of the patent and the other parties in sufficient time to allow them to attend. They may ask relevant questions. *Rule 123(1)* *Rule 118(2)* *Rule 119(3)*

3. Taking of evidence by courts or authorities of the Contracting States

3.1 Legal co-operation

Upon receipt of letters rogatory from the EPO, the courts or other competent authorities of Contracting States will undertake, on behalf *Art. 131(2)*

of the EPO and within the limits of their jurisdiction, any necessary enquiries.

3.2 Means of giving or taking evidence

3.2.1 Taking of evidence on oath or in equally binding form

Rule 120(3) The principal case where evidence is taken by a competent court will be the hearing of parties, witnesses or experts. In such instances the competent department may request the competent court to take the evidence on oath or in an equally binding form.

3.2.2 Cases where evidence is taken by a competent court

Rule 120(3) The competent department will, if necessary, request a competent court to take evidence, where appropriate under oath, where:

(i) the taking of evidence by that department would entail disproportionately high travelling costs or the taking of evidence by the competent court appears to be appropriate on other grounds;

Rule 120(2) (ii) the competent department considers it advisable for the evidence of a party, witness or expert it has heard to be re-examined under oath or in an equally binding form (see IV, 3.2.1);

Rule 120(1) (iii) there has been no reply to the summons by the expiry of a period fixed by the competent department in the summons (see IV, 1.5(iii)); or

Rule 120(1) *Rule 150(3)* (iv) a party, witness or expert who has been summoned before that department requests the latter in accordance with IV, 1.5(iii), to allow his evidence to be heard by a competent court in his country of residence. If the party, witness or expert simply refuses to be heard by the responsible Division, he should be notified that the competent national court will have the relevant national legal possibilities to oblige him to appear and to testify.

3.3 Letters rogatory

Rule 150(2) The EPO must draw up letters rogatory in the language of the competent authority or must attach to such letters rogatory a translation into the language of that authority.

Rule 150(1) Letters rogatory should be addressed to the central authority designated by the Contracting State.

3.4 Procedures before the competent authority

Rule 150(5) The EPO must be informed of the time when, and the place where, the enquiry is to take place and must inform the parties, witnesses and experts concerned.

If so requested by the EPO, the competent authority shall permit the attendance of members of the department concerned and allow them to question any person giving evidence either directly or through the competent authority. Whether the parties may put questions or not will depend on the laws of the Contracting States concerned. *Rule 120(3)* *Rule 150(6)*

3.5 Costs of taking evidence

The execution of letters rogatory does not give rise to any reimbursement of fees or costs of any nature. Nevertheless, the State in which letters rogatory are executed has the right to require the European Patent Organisation to reimburse any fees paid to experts and interpreters and the costs incurred as a result of the attendance of members of the competent department when evidence is taken. *Rule 150(7)*

3.6 Taking of evidence by a person appointed by the competent authority

If the law applied by the competent authority obliges the parties to secure evidence and the authority is not able itself to execute the letters rogatory, that authority may, with the consent of the competent department, appoint a suitable person to do so. When seeking the consent of the department concerned, the competent authority must indicate the approximate costs which would result from this procedure. If the competent department gives its consent, the European Patent Organisation must reimburse any costs incurred; without such consent, the Organisation is not liable for such costs. *Rule 150(8)*

4. Evaluation of evidence

4.1 General remarks

The competent department must examine whether the conclusions drawn by the parties from the evidence and facts are correct and give grounds for the conclusions it itself freely arrives at on the basis of the situation as a whole.

The state of the art to be taken into consideration in individual cases for the purposes of Art. 54 is that laid down in C-IV, 6, 7 and 10, and D-V, 3.1 and 3.2.

The competent department is not obliged to take into consideration any facts or evidence not presented by the parties in due time, except within the limits specified in VI, 2.

4.2 Evaluation of the testimony of a witness

After the witnesses have been heard, the party or parties must be given an opportunity of making observations. The observations may be made either in oral proceedings following the taking of evidence or exceptionally in writing after transmission of the minutes of the taking of evidence. The decision on this matter will rest with the competent department. The parties may file requests accordingly.

Only when this has been done should the competent department proceed to evaluate the evidence. Where a witness's testimony which is crucial to the decision has been challenged by a party but the department regards it as credible, or where a witness's oral or written testimony is disregarded in its decision as being not credible, the department concerned must state the grounds for its view in its decision.

In evaluating a witness's oral or written testimony, special attention should be paid to the following:

(i) what is important is what a witness can relate concerning the points at issue on the basis of his own knowledge or views, and whether he has practical experience in the field in question. Second-hand assertions based on something heard from third parties are for the most part worthless on their own. It is also important from the point of view of the evaluation whether the witness was involved in the event himself or only knows of it as an observer or listener;

(ii) in the event of long intervals of time (several years) between the event in question and the testimony, it should be borne in mind that most people's power of recall is limited without the support of documentary evidence; and

(iii) where testimony appears to conflict, the texts of the statements concerned should be closely compared with one another. Apparent contradiction in the testimony of witnesses may sometimes be resolved in this way. For example, a close examination of apparently contradictory statements by witnesses as to whether a substance X was commonly used for a particular purpose may show that there is in fact no contradiction at all, in that while one witness was saying specifically that substance X was not used for that particular purpose, the other witness was saying no more than that substances like X, or a certain class of substances to which X belonged, were commonly used for this particular purpose without intending to make any statement regarding substance X itself.

4.3 Evaluation of the testimony of parties

Oral or written evidence given by parties or their refusal to give evidence should be evaluated in the light of their special interest in the matter. Because of their special interest, the testimony of parties possibly should not be evaluated on the same level as that of neutral witnesses. This applies above all where parties have been present when witnesses have been heard and have ascertained the attitude of the competent department. The considerations set out in IV, 4.2 (Evaluation of the testimony of a witness) apply mutatis mutandis.

4.4 Evaluation of an expert opinion

The competent department must examine whether the grounds on which an expert opinion is based are convincing. Notwithstanding its discretion in the evaluation of evidence, it may not disregard an expert opinion in the absence of grounds based on adequate specialist knowledge of its own or of another expert, irrespective of whether the latter expert is an independent expert commissioned under Rule 121 or an expert who testifies at the request of one of the parties.

4.5 Evaluation of an inspection

In the case of a demonstration, a specific test programme under specific conditions should be agreed in advance. During the demonstration itself care must be taken to ensure that the characteristics or conditions of operation claimed for the invention are complied with. Where an invention is compared under test with an item forming part of the state of the art, as far as possible the same or comparable test conditions must be applied to both.

Chapter V

Derogations from the language of the proceedings in oral proceedings

1. Use of an official language

Any party to oral proceedings before the EPO may, in lieu of the language of the proceedings, use one of the other official languages of the EPO, on condition that such party either gives notice to the EPO at least one month before the date laid down for such oral proceedings or makes provision for interpreting into the language of the proceedings. In the former case, it is the responsibility of the EPO to provide for interpretation at its own expense.

Rule 4(1) and (5)

2. Language of a Contracting State or other language

Any party may likewise use one of the official languages of the Contracting States, other than English, French or German, on condition that he makes provision for interpreting into the language of the proceedings. However, if the parties and the EPO agree, any language may be used in oral proceedings without interpreting or prior notice.

Rule 4(1) and (4)

3. Exceptions from sections 1 and 2

Derogations from the provisions of Rule 4(1) are permitted, and these are at the discretion of the EPO. Clearly such permission must depend on the circumstances of the individual case. It may, for example, be envisaged that a party is unable to give one month's notice through no fault of his own, and, although he has made arrangements for an interpreter, the latter is unable (e.g. through illness) to attend. If, in such circumstances, the EPO is unable to provide for interpreting, it should postpone the oral proceedings if they occur at the examination stage. However, in opposition proceedings, the oral proceedings should continue if the parties agree and the employees of the EPO involved in the proceedings can cope with the language. In other cases, the EPO should postpone the oral proceedings and any costs incurred by the innocent party as a result of the postponement should be a matter for apportionment under Art. 104.

Rule 4(1)

4. Language used in the taking of evidence

When the evidence is being taken, a party, witness or expert who is unable to express himself adequately in English, French or German or in any other official language of the Contracting States is permitted to use another language. The EPO is responsible for interpreting into the language of the proceedings, assuming that this is necessary, if the evidence is taken at the request of the EPO itself. However, if the taking of evidence follows a request by a party to the proceedings, the use of a language other than English, French or German should be allowed only if that party provides for interpreting into the language

Rule 4(3)

of the proceedings or, at the discretion of the EPO, into any one of English, French or German. This discretion should be exercised in opposition proceedings only if the other parties agree.

5. Language used by employees of the EPO

Rule 4(2)

Employees of the EPO may use any one of English, French or German in the course of all oral proceedings. If, prior to the commencement of oral proceedings, an employee is aware that he may need to use a language other than the language of the proceedings, he should ensure that the parties involved are informed of his intention. However, employees should not depart from the language of the proceedings without good reason, and unless the parties involved are competent in the language used and express no objection, the EPO should provide for interpreting into the language of the proceedings at its own expense.

6. Language used in the minutes

Where the official language actually employed in oral proceedings is not the language of the proceedings as defined in Art. 14(3), if the Examining or Opposition Division considers it appropriate and subject to explicit agreement of all parties concerned, the minutes may be recorded in the language actually employed in the oral proceedings.

Prior to the agreement of the parties, their attention should be drawn to the fact that the EPO will not provide translations of the minutes into the language of the proceedings as defined in Art. 14(3). This condition, as well as the declaration of agreement of the party or parties, should be recorded in the minutes.

Statements made in English, French or German are entered in the minutes of the proceedings in the language employed.

Statements made in any other language must be entered in the official language into which they are translated. Amendments to the text of the description or claims of a European patent application or European patent made during oral proceedings must be entered in the minutes in the language of the proceedings. If the proceedings are conducted in a language other than English, French or German and no interpretation is effected, statements should be entered in the minutes in the language employed and the EPO should subsequently provide in the minutes a translation into the language of the proceedings.

Chapter VI

Examination by the EPO of its own motion; facts, evidence or grounds not submitted in due time; observations by third parties

1. Examination by the EPO of its own motion

1.1 General remarks

In proceedings before it, the EPO examines the facts of its own motion; it is not restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought. This principle of examination by the EPO of its own motion must be complied with by the competent department during all proceedings pending before it. Thus, once proceedings have been initiated, e.g. once a valid request for examination has been filed or an admissible notice of opposition has been filed (although it may subsequently be withdrawn), if there is reason to believe, e.g. from personal knowledge or from observations presented by third parties, that there are facts and evidence not yet considered in the proceedings which in whole or in part prejudice the granting or maintenance of the European patent, such facts and evidence must be included in those examined by the EPO of its own motion pursuant to Art. 114(1). See D-V, 2, for the extent of substantive examination of the facts and evidence in opposition proceedings.

Art. 114(1)

1.2 Limits on the obligation to undertake examination

However, the obligation to undertake such examination should be kept within limits in the interests of procedural expediency. For example, in opposition proceedings, an offer to prove that an alleged public prior use took place should not be taken up if the opponent making such an allegation has ceased to participate in the proceedings and the necessary evidence cannot be easily obtained at a reasonable cost.

The unity of the subject-matter of the European patent is not to be examined in opposition proceedings (G 1/91, see D-V, 2.2).

2. Facts, evidence or grounds for opposition not submitted in due time or arguments presented at a late stage

(Where submissions of the parties are filed late in respect of the date indicated in the note to the summons to oral proceedings pursuant to Rule 116(1), refer primarily to III, 8.6.)

The EPO may disregard facts or evidence (e.g. publications) which are not submitted in due time by the parties concerned.

Art. 114(2)

This also applies to grounds for opposition not submitted in due time, together with supporting facts and evidence in opposition proceedings (see D-V, 2.2). Note in this respect that according to G 1/95 and G 7/95 (see OJ 11/1996, 615 and 626), Art. 100(a) does not constitute one single ground for opposition, but has to be considered a collection of individual grounds for opposition, i.e. individual legal bases for objection to the maintenance of a patent. This applies not only to distinctly different objections, such as subject-matter which is not patentable (Art. 52(2)) as compared to subject-matter which is not capable of industrial application (Art. 57), but also to an objection for lack of novelty as opposed to an objection for lack of inventive step.

New arguments based on facts, evidence and grounds constituting the legal and factual framework of the opposition cannot be disregarded.

In deciding whether to admit facts, evidence or grounds for opposition not filed in due time, their relevance to the decision, the state of the procedure and the reasons for belated submission are to be considered. If examination of late-filed grounds for opposition, late-filed facts or late-filed evidence reveals without any further investigation (i.e. **prima facie**) that they are relevant, i.e. that the basis of the envisaged decision would be changed, then the competent department has to take such grounds, facts or evidence into consideration no matter what stage the procedure has reached and whatever the reasons for belated submission. In that case, the principle of examination by the EPO of its own motion under Art. 114(1) takes precedence over the possibility of disregarding facts or evidence under Art. 114(2) (see T 156/84, OJ 10/1988, 372). Note, however, the limits on the obligation to undertake further examinations as set out in VI, 1.2. Otherwise, the department should inform the party concerned in the decision, with due regard to Art. 113(1) EPC (see T 281/00), that the facts, evidence and/or grounds for opposition were not submitted in due time and, since they are not relevant to the decision, will be disregarded pursuant to Art. 114(2). On the apportionment of any costs arising from the late filing of facts and evidence, see D-IX, 1.4.

The latest date up to which submissions can be considered at all is the date on which the decision is handed over to the EPO's internal postal service for transmittal to the parties (see G 12/91, OJ 5/1994, 285).

The above applies in written proceedings; in oral proceedings submissions can only be considered up to the pronouncement of the decision (see III, 9).

3. Observations by third parties and examination thereof

Art. 115
Rule 114(1)

Following publication of the European patent application under Art. 93, any person may present observations concerning the patentability of the invention. Such observations must be filed in

writing in English, French or German and must include a statement of the grounds on which they are based. That person may not be a party to the proceedings before the EPO.

Documentary evidence and, in particular, publications submitted in support of the arguments may be filed in any language. However, the EPO may request that a translation into one of its official languages be filed within a period to be specified; otherwise the evidence will be disregarded. Although the third party is sent acknowledgment of the receipt of his observations, the EPO does not inform him of any further action it takes in response to them. *Rule 3(3)*

The observations are communicated to the applicant or proprietor without delay and he may comment on them. If they call into question the patentability of the invention in whole or in part, they must be taken into account in any proceedings pending before a department of the EPO until such proceedings have been terminated, i.e. they must be admitted to the proceedings. If the observations relate to alleged prior art available other than from a document, e.g. from use, this should be taken into account only if the alleged facts either are not disputed by the applicant or proprietor or are established beyond reasonable doubt. Observations by third parties received after the conclusion of proceedings will not be taken into account and will simply be added to the file. *Rule 114(2)*

Chapter VII

Interruption and suspension of the proceedings

1. Interruption

1.1 Cases in which the proceedings may be interrupted

Proceedings before the EPO will be interrupted: *Rule 142(1)*

(i) in the event of the death or legal incapacity of the applicant for or proprietor of a European patent or of the person authorised by national law to act on his behalf. To the extent that the above events do not affect the authorisation of a representative appointed under Art. 134, proceedings will be interrupted only on application by such representative; *Rule 142(1)(a)*

(ii) in the event of the applicant for or proprietor of a European patent, as a result of some action taken against his property, being prevented by legal reasons from continuing the proceedings before the EPO; or *Rule 142(1)(b)*

(iii) in the event of the death or legal incapacity of the representative of an applicant for or proprietor of a European patent or of his being prevented for legal reasons resulting from action taken against his property from continuing the proceedings before the EPO. *Rule 142(1)(c)*

The parties will be informed of the interruption of the proceedings and the reasons for it.

1.2 Resumption of proceedings

When, in the cases referred to in VII, 1.1(i) and (ii), the EPO has been informed of the identity of the person authorised to continue the proceedings before the EPO, it will communicate to such person and to any interested third party that the proceedings are to be resumed as from a date to be fixed by the EPO. This date should be such that the person concerned has sufficient opportunity to become thoroughly familiar with the matter. *Rule 142(2)*

In the case referred to in VII, 1.1(iii), the proceedings will be resumed when the EPO has been informed of the appointment of a new representative of the applicant or when the EPO has notified to the other parties the communication of the appointment of a new representative of the proprietor of the patent. If, three months after the beginning of the interruption of the proceedings, the EPO has not been informed of the appointment of a new representative it will communicate to the applicant for or proprietor of the patent: *Rule 142(3)*

Rule 142(3)(a)

(i) where Art. 133(2) (mandatory appointment of a representative) is applicable, that the European patent application will be deemed to be withdrawn or the European patent will be revoked if the information is not submitted within two months after this communication is notified; or

Rule 142(3)(b)

(ii) where Art. 133(2) is not applicable, that the proceedings will be resumed with the applicant for or proprietor of the patent as from the date on which this communication is notified.

A copy of the communication will be forwarded to the other parties.

1.2.1 Resumption of time limits

Rule 142(4)

The time limits, other than the time limit for making a request for examination and the time limit for paying the renewal fees, in force at the date of interruption of the proceedings, begin again as from the day on which the proceedings are resumed. If such date is less than two months before the end of the period within which the request for examination must be filed, such a request may be filed up to the end of two months after such date.

1.3. Department responsible

Art. 20

The Legal Division is responsible for questions concerning the interruption or resumption of proceedings (see Information from the EPO, OJ 9/1990, 404).

2. Stay of proceedings when entitlement proceedings are pending

Rule 14(1)

If a third party provides proof to the EPO that he has opened proceedings against the applicant or proprietor for the purpose of seeking a judgment that he is entitled to the (grant of the) European patent, the EPO shall stay the proceedings unless the third party consents to the continuation of such proceedings. For further details see A-IV, 2.2 to 2.5 and D-VII, 5.1.

3. Stay of proceedings when a referral to the Enlarged Board of Appeal is pending

Where a referral to the Enlarged Board of Appeal is pending and the outcome of examination or opposition proceedings depends entirely on the decision of the Enlarged Board of Appeal, the proceedings will be stayed only upon request of at least one of the parties. Where the proceedings are not stayed, they will be decided according to existing practice (OJ EPO 10/2006, 538).

Chapter VIII

Time limits, loss of rights, further and accelerated processing and re-establishment of rights

1. Time limits and loss of rights resulting from failure to respond within a time limit

1.1 Determination of time limits

The EPC imposes time limits upon parties to proceedings. *Art. 120*

Some of these are fixed by the articles of the EPC, e.g. Art. 87(1) (priority period), and Art. 99(1) (opposition). Others are fixed in the Implementing Regulations, e.g. in Rule 30(3) (payment of late-furnishing fee), Rule 38 (payment of filing and search fee), Rule 39(1) (payment of designation fees), Rule 58 (correction of deficiencies in application documents), Rule 70(1) (request for examination), Rule 71(3) (filing translations of the claims and payment of fees for grant and printing) and Rule 112(2) (applying for a decision after notification of loss of rights).

Others take the form of a stipulated range, the precise period within this range being at the EPO's discretion.

In other cases, e.g. those dealt with in Rule 3(3) (filing translation of documentary evidence), or Rule 70(2) (invitation to the applicant to indicate whether he desires to proceed further with the European patent application), a period, but not its duration, is provided for in the EPC. The duration must be determined by the EPO in accordance with Rule 132 (see VIII, 1.2).

1.2 Duration of the time limits to be determined by the EPO on the basis of EPC provisions

The length of such periods should be based, in principle, on the amount of work which is likely to be required to perform the operation in question. However, in order to facilitate the work of parties and the EPO it has been decided, as a general rule, to adopt a uniform practice with respect to time limits. This practice is at present as follows:

(i) if deficiencies to be corrected are merely formal or merely of a minor character; if simple acts only are requested, e.g. under Rule 83 the subsequent filing of documents referred to by a party; or if observations are required on amendments which are merely of a minor character – two months;

(ii) communications from an Examining or Opposition Division raising matters of substance – four months.

Rule 70(2)

A longer time limit of up to six months should be set only in the exceptional cases where it is clear that in the circumstances a four-month time limit cannot be adhered to. Each case must be judged on its individual merits and it is difficult to give general guidance, but a six-month time limit might be justified if for example the subject-matter of the application or patent or the objections raised are exceptionally complicated. Where the applicant is invited to submit the indication provided for in Rule 70(2), a six-month time limit running from the publication of the search report is appropriate.

1.3 Time limits which may be freely determined

Time limits for operations in respect of which the setting of a time limit is not explicitly provided for in the EPC are not subject to the restrictions as to the duration of time limits laid down in Rule 132. They may be fixed by the EPO at its own discretion.

1.4 Calculation of time limits

Rule 131
Rule 126
Rule 134

Although Rule 131 allows other possibilities, any period fixed by the EPO will usually be specified in full months which will be calculated from the receipt of the communication by the person to whom it is addressed (see Rule 126(2)). Rule 131 gives precise details for the determination of the day of expiry of the period, whilst Rule 134 contains provisions covering certain contingencies, e.g. that the EPO is not open on the day on which a time limit expires, or that there is a general disruption in the postal facilities between the EPO and a Contracting State.

Rule 142

When proceedings have been interrupted because of the death of the applicant or proprietor or for any of the other reasons specified in Rule 142, time limits are subject to the provisions of Rule 142(4). The time limits for the payment of the examination fee and the renewal fees are suspended (see J 07/83, OJ 5/1984, 211).

1.5 Effect of change in priority date

Art. 88(2)

Certain time limits run from the date of priority, or in the case of multiple priorities, from the earliest date of priority. Where this date no longer applies (e.g. the right of priority is lost in accordance with the provisions of Art. 90(5)), any such time limits become determinable from the amended date of priority. This does not restore any loss of rights resulting from a time limit having already expired before the loss of priority date. Part A of the Guidelines deals with the procedure to be followed (see A-III, 6.9 to 6.11).

1.6 Extension of a time limit

Rule 132

Apart from the automatic extension of time limits under Rule 134 (see VIII, 1.4) and cases in respect of which the EPC specifies a fixed period which may not be extended, the duration of time limits may be extended, but the applicant must request this extension in writing

before expiry of the period that has been set. The extended period is to be calculated from the start of the original period (see Legal Advice No. 5/93 rev., Point III, OJ 4/1993, 229). No written confirmation is required for requests for extension of time limits filed by fax. For any communication raising a matter of substance, a request for extension, even if filed without reasons, should normally be allowed if the total period set does not thereby exceed six months. A short time limit for correcting a mere formal or minor deficiency should be extended under the same circumstances by two months. However, a request for a longer extension, especially if the total period set exceeds six months, should be allowed only exceptionally, when the reasons given are sufficient to show convincingly that a reply in the period previously laid down will not be possible. Such exceptional circumstances might be e.g. the fact that a representative or client is so seriously ill that he cannot deal with the case in time; or the need to perform extensive biological experiments or tests. On the other hand, foreseeable or avoidable circumstances (e.g. leave, pressure of other work) should not be accepted as a sufficiently exceptional circumstance (see Notice of the Vice-President of the Directorate-General 2 of the EPO, OJ 5/1989, 180).

If the request for an extension is granted, the party should be informed of the new time limit. Otherwise, he should be told that the relevant sanction has taken effect or will take effect (see VIII, 1.9.2).

Art. 106(2)

If the request for extension of a time limit filed in good time has been rejected and the applicant considers this unjust, he can only overcome the ensuing loss of rights by requesting further processing under Art. 121(1) and Rule 135(1). At the same time, he may request reimbursement of the fee for further processing. A decision rejecting the request for reimbursement is open to appeal, either together with the final decision or separately, as the case may be (see J 37/89, OJ 4/1993, 201).

1.7 Late receipt of documents

Rule 133(1)

The fiction that a time limit has been observed is created provided a document received late was posted or delivered to one of the delivery services recognised by the President of the EPO (Chronopost, Deutsche Post Express, DHL, Federal Express, LTA, TNT, SkyNet and UPS) at least five days before expiry of the time limit and was received no later than three months after expiry of the time limit (see Decision of the President of the EPO, OJ 6/2003, 283). Rule 133 applies to all time limits to be observed vis-à-vis the Office and/or the national authorities, including the priority period laid down in Art. 87(1). The document must have been sent as a registered letter or in a form of consignment corresponding to registration and, if posted outside Europe, by airmail. Within the meaning of Rule 133, a document is deemed to have been posted or delivered to a delivery service within Europe if it was despatched in one of the states belonging to the European Conference of Postal and Telecommunications Administrations (CEPT) (in addition to the EPC

Contracting States these are the states listed below) or in a state which is generally understood to be part of Europe. At the request of the EPO, confirmation of registration by the post office or of receipt by the delivery service must be provided as evidence that the document was posted in due time. Despite this legal fiction that the time limit has been observed, the filing date of the document remains the day on which it was actually received.

The following non-Contracting States belong to the CEPT (updated 1 July 2009):

Albania, Andorra, Azerbaijan, Belarus, Bosnia and Herzegovina, Georgia, Moldova, Russian Federation, Serbia, Ukraine and Vatican.

1.8 Failure to respond within a time limit

If a party has not acted within a time limit, various sanctions may be applied depending on the circumstances. For instance, under Art. 90(2) and Rule 55 the application will not be proceeded with; under Art. 90(5) the application will be refused or a right of priority lost; under Rule 5 a document may be deemed not to have been received. If the request for examination has not been filed in time, the application is deemed to be withdrawn (Art. 94(2)), and this sanction may also apply in those cases where the applicant fails to meet a time limit set by the EPO (e.g. the time limit for replying to an invitation to amend under Art. 94(3)).

If a particular time limit is not complied with and, in contrast to cases where mandatory legal sanctions are laid down (e.g. revocation of the European patent if the printing fee is not paid in due time (Rule 82(3)), no specific legal sanction is laid down in the EPC, submissions and requests from the parties made after expiry of the time limit but before a decision is handed over to the EPO's internal postal service for transmittal to the parties are to be regarded in the rest of the proceedings as if they had been received in time (see G 12/91, OJ 5/1994, 285); any facts or evidence are, however, to be treated as not filed in due time (Art. 114(2), see also VI, 2).

1.9 Loss of rights

1.9.1 Cases of loss of rights

Rule 112

If a party to the proceedings or a third party fails to comply with a time limit laid down in the EPC or fixed by the EPO, this will result in a loss of rights in certain cases specified in the EPC, without any decision concerning the refusal of the European patent application or the grant, revocation or maintenance of the European patent, or the taking of evidence.

1.9.2 Noting and communication of loss of rights

Art. 119
Rule 112(1)

If there has been a loss of any right as described in VIII, 1.9.1, a formalities officer will note such loss of rights and communicate this to

the person concerned. The communication will be notified to the person concerned as a matter of course (see also D-IV, 1.4.1).

1.9.3 Decision on loss of rights

If the person concerned considers that the finding of the EPO is inaccurate, he may, within two months after notification of the communication, apply for a decision on the matter by the EPO. *Rule 112(2)*

The competent department of the EPO will give such a decision only if it does not share the opinion of the person requesting it; otherwise it will inform the person requesting the decision and then continue with the proceedings. Since such decisions are subject to appeal, the reasons on which they are based must be stated. Only the person affected by the loss of rights noted will be party to the proceedings.

The request under Rule 112(2) for a review of the accuracy of the communication under Rule 112(1) exists in parallel to the legal remedies against the loss of rights. If the applicant fails to observe the time limit for requesting a decision under Rule 112(2), he may still apply for re-establishment of rights under Art. 122(1) and Rule 136(1) in respect of that time limit.

2. Further processing and re-establishment of rights

2.1 Request for further processing of the European patent application

If the European patent application is to be refused or is refused or deemed to be withdrawn following failure to reply within a time limit vis-à-vis the European Patent Office, the application is allowed to proceed if the applicant makes a request for further processing of the application. Further processing must be requested by payment of the prescribed fee within two months of the communication concerning either the failure to observe a time limit or a loss of rights. The omitted act must be completed within the period for making the request. The request is not deemed to have been filed until this fee has been paid. The department competent to decide on the omitted act also decides on the request for further processing. *Art. 121(1) and (2)* *Rule 135(1) and (3)*

As a general rule, further processing is the legal remedy for failure to observe a time limit during proceedings before grant, even where the consequence is a partial loss of rights (e.g. loss of priority right). However, the possibility of requesting further processing is ruled out for the periods referred to in Art. 121(4) and Rules 6(1), 16(1)(a), 31(2), 36(1)(a) and (b), 40(3), 51(2) to (5), 52(2) and (3), 55, 56, 58, 59, 62a, 63, 64 and 112(2). *Rule 135(2)*

2.2 Re-establishment of rights

2.2.1 General remarks

An applicant for or proprietor of a European patent who, despite taking all due care required by the circumstances, was unable to *Art. 122(1)*

observe a time limit vis-à-vis the European Patent Office not specifically excluded by Art. 122(4) and Rule 136(3) may apply to have his rights re-established. According to Art. 122(4) and Rule 136(3), re-establishment of rights is ruled out in respect of all periods for which further processing is available and in respect of the period for requesting re-establishment of rights. Re-establishment applies to the time limit under Rule 135(1) for requesting further processing and also to the time limits which are excluded from further processing according to Art. 121(4) and Rule 135(2). This means that, where further processing applies to a time limit, re-establishment cannot be requested for failure to observe that time limit. However, if further processing is available, but the applicant fails to request it in time, re-establishment of rights according to Art. 122 is available for the time limit for requesting further processing. Moreover, re-establishment of rights is possible where an applicant fails to file his application within the priority period of Art. 87(1). The conditions governing this application are fully set out in Art. 122(1) to (6) and Rule 136(1) to (4). The provisions of Art. 122 and Rule 136 might be invoked if e.g. the applicant's working documents have been destroyed by fire and he has been obliged to prepare fresh ones; or if a specialist agency sent him the wrong set of drawings relating to a priority document, and the error was not immediately apparent. In all instances it is necessary for the applicant or proprietor or representative, as the case may be, to supply evidence that he had exercised all due care required by the circumstances and that the delay was caused by unforeseeable factors. Errors of law, however, do not constitute grounds for re-establishment (see e.g. D 6/82, OJ 8/1983, 337, J 31/89 and J 2/02, both not published in OJ).

Failure by an applicant to meet the time limit for filing the notice of appeal (Art. 108) cannot be remedied by further processing (Art. 121(4)); only re-establishment is available (Rule 136(3)).

2.2.2 Extension of re-establishment of rights to opponents

Re-establishment of opponents in respect of the time limit for filing the appeal itself is excluded under Art. 122(1) (see T 210/89, OJ 8/1991, 433). However, an opponent who has filed an appeal can request re-establishment of rights in respect of the time limit for submitting the grounds for appeal (see G 1/86, OJ 10/1987, 447).

2.2.3 Relevant time limits

Art. 122(1)

"Time limit" is taken to mean a specific period of time within which an act vis-à-vis the EPO has to be completed. A time limit is therefore not a date, i.e. an appointed day. Accordingly, no provision may be made for re-establishment of rights in the event of failure to be present on the date appointed for oral proceedings.

The following are examples of cases where re-establishment of rights may be possible in the event of failure to comply with a time limit. They concern the time limits for: *Rule 82(2) and (3)* *Rule 88(3)* *Art. 108* *Art. 112a(4)*

– the payment of the fee for the printing of the new specification of the European patent; *Art. 87(1)*

– the filing of the translation of any amended claims in opposition proceedings;

– filing the request for a decision by the Opposition Division on the awarding of costs;

– appeals filed by applicants or patent proprietors (see XI, 6);

– filing a request for review by the Enlarged Board of Appeal; and

– claiming priority of an earlier first application according to Art. 87(1) (see A-III, 6.6).

2.2.4 Time limits not covered

Re-establishment of rights is expressly excluded as regards the time limit for requesting re-establishment of rights (see VIII, 2.2.1) and the time limits for which further processing is available (Art. 121). Furthermore, re-establishment of rights will not be permitted in cases of failure to comply with time limits which do not have the direct consequence of causing the refusal of the European patent application or of a request, or the deeming of the European patent application to have been withdrawn, or the revocation of the European patent, or the loss of any other right or means of redress. For example, there can be no re-establishment of rights as regards the time limits for submission by the patent proprietor in opposition proceedings of his observations on the written statements of the other parties to the proceedings or on communications from the Opposition Division. *Art. 122(4)* *Rule 136(3)*

2.2.5 Request for re-establishment of rights

The request for re-establishment of rights must be filed in writing within two months from the removal of the cause of non-compliance with the time limit. The omitted act must be completed within this period. As a general rule, the request is admissible within the year immediately following the expiry of the unobserved time limit. However, the time limit for requesting re-establishment of rights for the priority period or for filing a petition for review by the Enlarged Board of Appeal constitutes an exception to this general rule: in these cases, the request must be filed within two months of expiry of the relevant period laid down in Art. 87(1) and Art. 112a(4). *Rule 136(1)*

The request must state the grounds on which it is based, and must set out the facts on which it relies. It is not deemed to be filed until *Rule 136(2)*

after the fee for the re-establishment of rights has been paid in the amount laid down in the Rules relating to Fees under the EPC.

2.2.6 Special considerations in proceedings with more than one party

If, for instance in opposition proceedings, the proprietor of the patent files an application for re-establishment of rights, the opponents and any third parties, although not involved in the procedure for the re-establishment of rights, must be informed of the application for re-establishment of rights and the subsequent decision, if this involves the re-establishment of rights as regards a time limit connected with the opposition procedure.

2.2.7 Decision on re-establishment of rights

Rule 136(4)

The department competent to decide on the omitted act decides upon the application for re-establishment of rights. The grounds for the decision need only be stated if the application is disallowed. This also applies in opposition proceedings, since the opponents are not involved in the procedure for re-establishment of rights.

The department which took the contested decision will have to consider re-establishment of rights in respect of an unobserved time limit for appeal when the conditions for granting interlocutory revision are fulfilled (see XI, 7). It can, however, only decide to allow re-establishment if it can do so within the three-month time limit of Art. 109(2) and the conditions for re-establishment (see VIII, 2.2.1 to 2.2.5) are fulfilled. In all other cases, the appeal, together with the application for the re-establishment of rights, must be submitted to the competent Board of Appeal.

3. Accelerated prosecution of European patent applications

Applicants requiring faster search or examination can ask to have their applications processed under the programme for accelerated prosecution of European patent applications (PACE) (see the Notice from the EPO, Special edition No. 3, OJ EPO 2007, F.1).

4. Accelerated processing of oppositions

In cases where an infringement action in respect of a European patent is pending before a national court of a Contracting State, a party to the opposition proceedings may request accelerated processing. The request may be filed at any time. It must be filed in written reasoned form. In addition, the EPO will also accelerate the processing of the opposition if it is informed by the national court or competent authority of a Contracting State that infringement actions are pending (see the Notice from the President of the EPO dated 19 May 1998, OJ 7/1998, 361).

5. Accelerated processing before the Boards of Appeal

Parties with a legitimate interest may ask the Boards of Appeal to deal with their appeals rapidly. The Boards can speed up an appeal as far as the procedural regulations allow. Requests for accelerated

processing must be submitted to the competent Board either at the beginning of or during proceedings. They should contain reasons for the urgency together with relevant documents. This option is also available to the courts and competent authorities of the Contracting States (see the Notice from the Vice-President Directorate-General 3 dated 19 May 1998, OJ 7/1998, 362).

6. Renunciation of rights

6.1 Withdrawal of application or designation

The applicant may withdraw his application at any time up to the grant of the European patent (see also C-VI, 14.9), provided that no third party has proven to the EPO that he has initiated proceedings concerning entitlement to the application pursuant to Rule 15. *Rule 15*

The same also applies to the withdrawal of a designation (see also A-III, 11.3.8). If all designations are withdrawn, the application is deemed to be withdrawn. *Art. 79(3)* *Rules 39(2) and (3)*

Withdrawal of the application in due time before the eighteen month publication has the advantage that the contents of the application do not become known to the public (see A-VI, 1.2). If, furthermore, no rights have been left outstanding and the application has not served as a basis for claiming a right of priority, a subsequent application for the same invention can be considered as the first application for the purposes of determining priority (see C-V, 1.4.1). If the examination fee has been paid, it will be refunded in full or in part (see A-VI, 2.5). *Art. 87(4)*

6.2 Withdrawal of priority claim

The priority claim may also be withdrawn (see C-V, 3.5). If this is done before the technical preparations for publication of the application are completed, the publication will be deferred until 18 months after the date of filing of the European application (see A-VI, 1.1).

6.3 Statement of withdrawal

Any statement of withdrawal must be unqualified and unambiguous. It may, however, be conditional upon, e.g. avoidance of publication or refund of the examination fee.

6.4 Surrender of patent

A patent may not be surrendered in opposition proceedings by the proprietor filing a declaration of surrender with the EPO. Such a surrender must be declared before the competent authorities in the designated states in question (see D-VII, 6.1). Nevertheless, if a proprietor unambiguously declares to the EPO the surrender (or abandonment or renunciation) of the patent, this is deemed equivalent to a request that the patent be revoked (see also D-VIII, 1.2.5). *Rule 84(1)*

Chapter IX

Applications under the Patent Cooperation Treaty (PCT)

1. General remarks

The EPO may act as a "designated Office" or an "elected Office" for an international application filed under the Patent Cooperation Treaty (PCT) designating "EP" (Euro-PCT application). Such application is thereby deemed to be a European application (Euro-PCT application) for the purposes of the EPC. However, in the case of Euro-PCT applications, the provisions of the PCT apply in addition to those of the EPC, and where there is conflict between them, e.g. in the case of certain time limits, the provisions of the PCT prevail. According to Art. 153(1)(a), the EPO acts as a designated Office for Contracting States to the EPC in respect of which the PCT has entered into force, which are designated in the international application and for which the applicant wishes to obtain a European patent. If the applicant has elected a designated State, the EPO is an elected Office (Art. 153(1)(b), for details see IX, 6.1).

Art. 153(1)(a) and (b)
Art. 153(2)
Art. 150(2)

In addition to being a designated Office, the EPO may act as a receiving Office under the PCT within the terms set out in Art. 151. Furthermore, it may also act as an International Searching Authority (ISA) or/and as an International Preliminary Examining Authority (IPEA) under the terms of Art. 152. There are thus the following possibilities for a European application filed under the provisions of the PCT:

Art. 151
Art. 152

(i) the filing of the application and the international search take place at an office or offices other than the EPO (e.g. the Japan Patent Office). The EPO acts as a designated Office;

(ii) the application is filed at another office (e.g. the United Kingdom Patent Office) but the EPO performs the international search. The EPO acts as International Searching Authority and as a designated Office;

(iii) the application is filed at the EPO, which also performs the international search. The EPO acts as receiving Office, International Searching Authority and designated Office;

(iv) in addition to the cases mentioned under (i) – (iii), the applicant files a demand for international preliminary examination and elects the EPO from among the designated Offices. The EPO is the "elected Office";

(v) the EPO is the International Preliminary Examining Authority. It may carry out this function without being the receiving Office, a

designated Office or an elected Office. The EPO can, however, only act as an IPEA if the international search was carried out by the EPO, the Austrian, Spanish, Swedish or Finnish Patent Office or the Nordic Patent Institute.

In case (i), the European application will be accompanied by an international search report drawn up by another office. In cases (ii) and (iii), the international search report will be prepared by the Search Division of the EPO. In case (iv), the international search report and the international preliminary examination report may be drawn up by the EPO or by another International Searching Authority and International Preliminary Examining Authority.

2. The EPO as a receiving Office

Art. 151 The EPO may act as a receiving Office when the conditions referred to in Art. 151 apply.

Rule 157(2) Where the EPO acts as a receiving Office, the provisions of Rule 157(2) will apply to the international application and its related documents. The following documents must be filed with the EPO acting as receiving Office (Rule 157(2)): the request, the description, the claims, the abstract and the drawings, as well as the other documents referred to in Rule 3.3(a)(ii) PCT and listed on the right-hand side of Box VIII of the PCT request form (PCT/RO/101). The President of the EPO may, however, decide that the international application and any related item be filed in more than one copy.

If an international application is filed by fax, the hard-copy application documents complying with the Rules and the Request (Form PCT/RO/101) should be forwarded simultaneously and the fax should state that such documents have been forwarded. Otherwise, the EPO will invite the applicant to supply such documents within a non-extendable period of one month (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.3). To prevent duplication of files applicants are asked to indicate on the accompanying letter the fax date and to make it clear that the paper documents represent “confirmation of an application filed by fax”.

Rule 157(1) and (3) An international application for which the EPO is chosen by the applicant as the receiving Office must be filed directly with the EPO. An exception applies only where the applicant is obliged under the applicable national law of a Contracting State to file the international application concerned via a national authority (see Art. 75(2)). In that case, the national authority acts as intermediary (‘’filing office’’) of the EPO as receiving Office and is obliged to ensure that the application reaches the EPO not later than two weeks before the end of the thirteenth month after filing or, if priority is claimed, after the date of priority.

The international application and other documents relating to it may be filed electronically with the EPO as receiving Office.. Priority documents may be filed in electronic form only if they have been digitally signed by the issuing authority and the signature is accepted by the EPO (Decision of the President of the EPO dated 26 February 2009, OJ EPO 3/2009, 182).

The initial processing and formal examination of international applications are carried out by the receiving Office and the International Bureau of the World Intellectual Property Organization (WIPO) in accordance with the provisions of the PCT. When the EPO is acting as a receiving Office, EPO employees will work in accordance with the PCT Receiving Office Guidelines (see "PCT Resources" at www.wipo.int/pct/en/).

With regard to deadlines and procedural steps before the EPO as a receiving Office, see the latest version of the Guide for applicants: "How to get a European patent, Part 2: PCT procedure before the EPO - Euro-PCT". For applications concerning nucleotide or amino acid sequences, see A-VII, 4.2 and Special Edition No. 3, OJ EPO 2007, C.1.

3. The EPO as an International Searching Authority (ISA)

3.1 General remarks

If the EPO acts as an International Searching Authority under the terms of Art. 152, it establishes the international search report in accordance with the PCT International Search and Preliminary Examination Guidelines and transmits it to the International Bureau (see Art. 16(1) and 18 PCT). The EPO also establishes a ‘’written opinion of the International Searching Authority’’ (WO-ISA) (Rule 43bis PCT). The WO-ISA is transmitted to the IB together with the ISR. A copy of the ISR and, if applicable, the WO-ISA, is sent also to the applicant.

There is no possibility for a dialogue between the applicant and the EPO on the International Search Report (ISR) and the WO-ISA. However, in reaction to the ISR and WO-ISA, the applicant may file with the IB amended claims under Art. 19 PCT together with a brief statement explaining the amendments and indicating their likely effect on the description and drawings (see IX, 5.7). Further, the applicant may in response to the WO-ISA file ‘’informal comments’’. Amendments under Art. 19 PCT and informal comments must be sent directly to the International Bureau.

A copy of the international search report, and if applicable, the WO-ISA is also sent to the applicant who may, as a result, file with the International Bureau amended claims, and may also file a brief statement explaining the amendments and indicating their likely effect on the description and drawings (see IX, 5.7). *Art. 19(1) PCT*

With regard to deadlines and procedural steps before the EPO as an International Searching Authority, see the latest version of the Guide for applicants: "How to get a European patent, Part 2: PCT procedure before the EPO – Euro-PCT". For applications concerning nucleotide or amino acid sequences, see A-VII, 4.2 and Special edition No. 3, OJ EPO 2007, C.1.

3.2 Limitations

In accordance with the Agreement between the European Patent Organisation and the International Bureau of the World Intellectual Property Organization (OJ 11/2007, 617), the EPO may limit its search work as an ISA. For information on the limitations of the competence of the EPO as ISA, see OJ 3/2009, 206 and B-VIII, 1.

4. The EPO as an International Preliminary Examining Authority (IPEA)

4.1 General remarks

Art. 152

The EPO may act as an International Preliminary Examining Authority under the terms of Art. 152.

When the EPO acts as an International Preliminary Examining Authority, the provisions of the PCT International Search and Preliminary Examination Guidelines will apply to the examination procedure.

Art. 35 PCT
Rule 70 PCT

An international preliminary examination report (IPER) will be established within the prescribed time limit and in the form prescribed in Rule 70 PCT. One copy each of the international preliminary examination report and its annexes, if any, will be transmitted, on the same day, to the International Bureau and to the applicant (Rule 71.1 PCT).

With regard to deadlines and procedural steps before the EPO as an International Preliminary Examining Authority, see the latest version of the Guide for applicants: "How to get a European patent, Part 2: PCT procedure before the EPO – Euro-PCT". For applications concerning nucleotide or amino acid sequences, see A-VII, 4.2 and Special edition No. 3, OJ EPO 2007, C.1.

Art. 33 PCT

The objective of the international preliminary examination according to Art. 33(1) PCT is to formulate a preliminary and non-binding opinion on the questions whether the claimed invention appears to be novel, to involve an inventive step, and to be industrially applicable. With respect to these three criteria, substantially the same requirements apply as under the EPC (compare Art. 33(2), (3) and (4) PCT with Art. 54(1), 56 and 57 EPC).

Essential differences exist, however, between the procedures for international preliminary examination and the examination of European patent applications:

(i) international preliminary examination does not lead to the grant of a patent or refusal of the application;

(ii) for international preliminary examination the time limits set in Rule 69 PCT are to be met;

(iii) the procedure followed in cases of lack of unity of invention; and

(iv) in accordance with the Agreement between the European Patent Organisation and the International Bureau of the World Intellectual Property Organization (OJ 11/2007, 617), the EPO may limit its examination work as an IPEA. A limitation of the EPO's competence is applicable for applications relating to business methods filed by a US national or resident (OJ EPO 3/2009, 206). Further restrictions regarding the preliminary examination of applications relating to business methods follow from the application of Rule 67.1(iii) PCT and Rule 66.1(e) PCT.

4.2 The international preliminary examination report (IPER)

The international preliminary examination report constitutes a preliminary, non-binding opinion on whether the claimed invention appears to be novel, to involve an inventive step and to be industrially applicable (Art. 33(1) PCT). The opinion is formulated on the basis of the documents referred to in the report. These documents may be the following, in particular:

(i) the text of the application as filed with the receiving Office or, if appropriate, the published translation thereof (Art. 21 PCT);

(ii) the text of the application as filed with the receiving Office, taking into consideration any amendments made pursuant to Art. 19 PCT to the claims or, if appropriate, the published translation thereof (Art. 21 PCT);

(iii) the text of the application referred to in (i) or (ii), taking into consideration the documents (description, claims and drawings; see Art. 34(2)(b) and (3)(b) and Rules 66 and 68.2 PCT) attached in annex to the international preliminary examination report.

4a. Response to the WO-ISA, IPER or search opinion

Rule 161(1)

Where the application is not subject to the preparation of a supplementary European search report (because the international search report and accompanying WO-ISA were prepared by the EPO - see B-II, 4.3), the applicant is sent an invitation according to Rule 161(1), inviting him to respond to the WO-ISA or, where applicable, the IPER prepared by the EPO in the international phase. Subject to certain exceptions, the applicant is required to reply within a period of one month (see C-VI, 3.5.1 for details).

Rule 161(2)

Where the application is subject to the preparation of a supplementary European search report, the applicant will first be sent an invitation according to Rule 161(2) inviting him to amend the application within a period of one month. Thereafter, the supplementary European search report and accompanying search opinion will be prepared on the basis of the latest request filed by the applicant (see B-II, 4.3 and B-XII, 2). Subject to certain exceptions, the applicant is required by Rule 70a to respond to this search opinion (see B-XII, 9 and C-VI, 1.1.1 for details).

5. The EPO as a designated Office

5.1 General remarks

Art. 153(1)(a)
Art. 4(1)(ii) PCT

The EPO will act as a designated Office for those Contracting States to the EPC in respect of which the PCT has entered into force and which are designated in the international application, provided that the applicant informed the receiving Office in the international application that he wished to obtain a European patent for these States. The same applies if, in the international application, the applicant designated a Contracting State of which the national law provides that designation of that State has the effect of the application being for a European patent. The EPO is automatically designated in all international applications filed as of 1 January 2004 (Rule 4.9 PCT).

With regard to deadlines and procedural steps before the EPO as a designated Office, see the latest version of the Guide for applicants: "How to get a European patent, Part 2: PCT procedure before the EPO – Euro-PCT". For applications concerning nucleotide and amino acid sequences, see A-VII, 4.2 and Special edition No. 3, OJ EPO 2007, C.1.

Rule 159(1)

In order to initiate the European phase before the EPO acting as a designated Office, the requirements for entry into the European phase according to Rule 159(1) must be complied with (see A-VII, 1.2 and 1.3), as must the requirements of Rule 161(1) (see IX, 4a). For entry into the European phase, applicants are strongly recommended to use Form 1200, downloadable from the EPO website. The use of Form 1200 is particularly important where the applicant files amendments in response to the WO-ISA or IPER prepared by the EPO (either in the international phase or on entry into the European phase) and in so doing wishes to avoid having to respond to the communication according to Rule 161(1) (see C-VI, 3.5.1).

5.2 Communication to the EPO as a designated Office

Art. 20(1)(a) PCT
Rule 44bis.2 PCT

A copy of the application together with the international search report or a declaration in accordance with Art. 17(2)(a) PCT is communicated by the International Bureau to the EPO as a designated Office in accordance with Art. 20(1)(a) PCT. Furthermore, the EPO does not require the applicant to furnish a copy of the international application (Rule 49.1(a-bis) PCT). The EPO as a

designated Office will then examine the application for compliance with the requirements of the EPC (see in particular A-VII).

The International Bureau shall communicate the International Preliminary Report on Patentability (Chapter I of the PCT) and any informal comments received from the applicant to the EPO as designated Office at 30 months from the priority date.

5.3 Publication of the translation of the international application

Art. 153(3) and (4)
Rule 159

The international publication of a Euro-PCT application in an official language of the European Patent Office takes the place of publication of the European patent application and will be mentioned in the European Patent Bulletin. If the international publication of the Euro-PCT application is in another language, a translation into one of the official languages must be filed with the EPO within 31 months of the priority date (Art. 22(1) PCT and Rule 159(1)(a)). The EPO will publish the translation.

Rule 160(1)

If the translation is not supplied, the application is to be deemed withdrawn (Art. 24(1) PCT, Rule 160(1)). Furthermore, in this case, the application which has been published under the PCT is not considered as comprised in the state of the art in accordance with Art. 54(3) (see C-IV, 7.2). However, if the EPO finds that the application is deemed to be withdrawn because the translation was not filed in due time, it must first communicate this to the applicant (Rule 160(3)). Rule 112(2) applies mutatis mutandis. The loss of rights is deemed not to have occurred if, within two months as from notification of the communication, the translation is supplied, a request for further processing under Art. 121 and Rule 135(1) is filed, and the fee for further processing is paid.

5.4 Supplementary European search report

Art. 153(7)

When the application, in one of the official languages of the EPO, and the international search report have been communicated to the EPO and the fees have been paid, the Search Division will prepare a supplementary European search report, except where the Administrative Council has decided otherwise, as described in B-II, 4.3. For international applications filed as of 1 July 2005, this supplementary European search report is also accompanied by a search opinion under Rule 62(1). Where a supplementary European search report accompanied by a search opinion is drawn up on or after 1 April 2010, the applicant is required to respond to it (see B-XII, 9).

Hence, the application will reach the Examining Division containing either one or two search reports, which must be taken into consideration during the examination along with any comments or amendments filed in response thereto.

5.5 Delaying of the procedure before the EPO

Art. 23 PCT
Rule 44bis.2 PCT

When acting as a designated Office, the EPO must not process or examine an international application before expiry of the period applicable under Art. 22 PCT (Art. 23(1) PCT). However, the EPO may, on the express request of the applicant, process or examine an international application at any time (Art. 23(2) PCT). The applicant may request the International Bureau to communicate a copy of the Written Opinion established by the International Searching Authority to the EPO as designated Office once a request under Art. 23(2) PCT is made.

5.6 Review by the EPO as a designated Office

Rule 159(2)

The EPO may decide, in accordance with Art. 25 PCT, to allow an international application deemed to be withdrawn, or not accorded a filing date, to proceed as a European application. The Examining Division is competent to take decisions in relation to these applications, and the Receiving Section transfers copies of any documents received from the International Bureau under the circumstances of Art. 25(1)(a) PCT to the Examining Division. Where it is decided that the application can proceed as a European application, the search and examination is carried out as for other applications although the application may be accorded the date it was originally filed with the PCT receiving Office and may claim the priority date, if any, of the international application.

5.7 Examination and processing

Substantive examination of a Euro-PCT application is carried out as for any other European application, taking account of some specific provisions.

Art. 19(1) PCT

If amended claims were filed (see IX, 3.1) on an international application before its transmission to the EPO, these should be considered together with any accompanying explanatory statement, in the same way as for other amendments filed prior to the examiner's first communication with the applicant (see C-VI, 3, 9.4, and VI, 3.5.1, as well as B-XII, 9 for cases where a supplementary European search report is accompanied by a search opinion).

Art. 28 PCT
Rule 159(1)(b)
Rule 161

The examination must be conducted in accordance with Art. 28 PCT, which stipulates that the applicant must be given the opportunity to amend the claims, the description, and the drawings within a time limit prescribed pursuant to Rule 52.1(b) PCT (see also Rules 159(1)(b) and 161 and IX, 4a).

Rule 164(2)

If the Examining Division considers that the application documents which are to serve as basis for the European grant procedure do not meet the requirements of unity of invention, or if protection is sought for an invention not covered by the international search report (or, where a supplementary European search report has been established, by that report), it must invite the applicant to limit the

application to one invention covered by the international (or the supplementary European) search report.

If after receipt of the (supplementary) European search report the applicant files amended claims relating to an invention which differs from any of the originally claimed inventions and which does not combine with these inventions to form a single inventive concept, an objection under Rule 137(5) should be raised in the first communication pursuant to Art. 94(3) and Rule 71(2) (see also C-III, 7.11 and C-VI, 5.2(ii)). *Rule 137(5)*

5.8 Inspection of files

In its capacity as a designated Office, the EPO also allows access to its files pertaining to the international phase of applications, provided that international publication has taken place. The above applies mutatis mutandis to the communication of information from the files. *Art. 30(2) PCT*

6. The EPO as an elected Office

6.1 General remarks

The EPO will act as an elected Office if the applicant has filed a demand for international preliminary examination and has elected at least one Contracting State of the EPC which is designated in the international application and is bound by Chapter II PCT and for which a European patent is sought. The EPO will be automatically elected in all demands filed as of 1 January 2004. An international preliminary examination report will be drawn up on the basis of the demand by an International Preliminary Examining Authority (e.g. the EPO in accordance with IX, 4). Election of the EPO means that the applicant intends to use the results of the international preliminary examination report in proceedings before the EPO (see Art. 31(4)(a) PCT and IX, 4.2). *Art. 153(1)(b)*

With regard to deadlines and procedural steps before the EPO as an elected Office, see the latest version of the Guide for applicants: "How to get a European patent, Part 2: PCT procedure before the EPO – Euro-PCT". For applications concerning nucleotide or amino acid sequences, see A-VII, 4.2 and Special edition No. 3, OJ EPO 2007, C.1.

6.2 Opening of the European phase and of substantive examination

The EPO will be notified of its election by the International Bureau (WIPO) (Art. 31(7), Rule 61.2(a) PCT). European substantive examination must normally not begin before expiry of the 31st month from the earliest priority date (Art. 40(1) PCT). The only circumstance in which examination may begin earlier is if the applicant has expressly so requested (Art. 40(2) PCT).

In order to initiate the European phase before the EPO acting as an elected Office, the requirements for entry into the European phase *Rule 159*

according to Rule 159 must be complied with (see A-VII, 1.2 and 1.3). For entry into the European phase, applicants are strongly recommended to use Form 1200, downloadable from the EPO website.

6.3 Substantive examination of a Euro-PCT application accompanied by an international preliminary examination report (IPER)

The substantive examination is conducted in the same way as with European applications (see IX, 5.7). Where the EPO was the International Preliminary Examining Authority, the international preliminary examination will normally have been carried out by the examiner responsible for examining the related Euro-PCT application.

Art. 14(1)

The application to be examined will be accompanied by an international preliminary examination report drawn up in one of the official languages of the EPO. New documents in the original language may be attached in annex to the report (Art. 36(3)(a) PCT and Rule 70.16 PCT). The application will also be accompanied by a translation of the annexes, transmitted by the applicant, in the same language into which the international preliminary examination report was translated (Art. 36(3)(b) PCT).

Art. 41 and 42 PCT

The examination must be conducted in accordance with Art. 41 and 42 PCT, which stipulate that:

Rule 159(1)(b)
Rule 161

(i) the applicant must be given the opportunity to amend the claims, the description, and the drawings within a time limit prescribed pursuant to Rule 78.1(b) or 78.2 PCT (see also Rules 159(1)(b) and 161); and

(ii) the EPO cannot require that the applicant furnish copies, or information on the contents, of any papers connected with the examination relating to the same application in any other elected Office.

6.3.1 Comparative test results

Where the EPO has established the IPER and refers therein to the submission of test reports, the applicant is taken to agree to the use of these reports as the basis for proceedings before the EPO when he uses the standard form for entry into the European phase before the EPO as elected Office, i.e. Form 1200. If the latter is not used or the IPER – referring to the test reports – was established by another International Preliminary Examination Authority, the applicant is invited to submit these reports for the European application.

6.3.2 Documents forming the basis for substantive examination

Normally, the documents which are indicated in the international preliminary examination report as forming the basis for that report will also form the basis for the substantive examination in the EPO as an elected Office in the European phase. New documents (claims,

description, drawings) submitted during the international preliminary examination and replacing the earlier filed documents will be attached to the international preliminary examination report. If the documents attached to the international preliminary examination report are in a language other than the language of the proceedings of the European application in the European phase, the applicant must be requested to file the documents in the language of the proceedings within a fixed period.

The applicant may also request that the examination be based on the documents in the international application as published or on amendments made on entry into the European phase. If the declarations of the applicant are unclear in this respect, the examiner will have to clarify the situation.

6.3.3 Consideration of the contents of the international preliminary examination report during substantive examination

If the international preliminary examination report has been drawn up by the EPO, it is to be regarded as an opinion for purposes of examination, and generally the first communication will be based on the opinion expressed in the IPER and the applicant's response to it filed in accordance with Rule 161(1) (if applicable, see C-VI, 3.5.1). Such an opinion may be departed from if new facts relevant to assessing patentability are in evidence (e.g. if further prior art documents are to be cited or if evidence is produced of unexpected effects), where the substantive patentability requirements under the PCT and the EPC are different, where the applicant provides convincing arguments, appropriate amendments or relevant counter-evidence in his response to the IPER according to Rule 161(1), or conversely where the applicant provides amendments in response to the IPER which introduce further deficiencies.

Examination reports drawn up by other International Preliminary Examining Authorities must be examined carefully. If the reasons put forward in the international preliminary examination report are sound, they must not be disregarded.

6.4 Inspection of files

Rule 94.3 PCT

In its capacity as elected Office the EPO allows access to its files (including the entire PCT Chapter II file) relating to the international phase of applications filed on or after 1 July 1998, provided international publication has taken place and, as far as the PCT Chapter II file is concerned, the IPER has been completed. The above applies mutatis mutandis to the communication of information from the files.

Chapter X

Decisions

1. Basis of decisions

1.1 General remarks

The decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. *Art. 113(1)*

This provision is intended to ensure that no party can be taken by surprise by grounds for a decision against his application on which he did not have an opportunity to present his comments.

In substantive examination, the applicant must have an opportunity of presenting his comments on all the grounds invoked against his application.

In opposition proceedings, if the patent is to be revoked, it should be ensured that the proprietor of the patent in particular is given sufficient opportunity to defend himself and, similarly, if the oppositions are to be rejected or if, despite the claims of the opponents, the patent is to be maintained in amended form, the opponents in particular should be given the same opportunity.

1.2 Examples

The right to be heard is a right not just to present comments but also to have those comments duly considered. Amendments submitted by a party need to be considered, and the party must be given an opportunity to comment on the grounds and evidence brought forward by the Examining Division (see T 1123/04). A document should not be cited for the first time in a decision (see T 635/04) unless it has been introduced during oral proceedings. If a case is remitted from the Boards of Appeal for further prosecution, the Examining Division must check whether requests from examination proceedings prior to the appeal are still outstanding and must give the party an opportunity to comment (see T 1494/05). If the facts and grounds essential to a decision have been submitted by one party and if the party whose case is to be rejected has been afforded sufficient time to comment, the principle concerning the right to a hearing set out in Art. 113(1) will have been respected. If the decision in opposition proceedings is to be based on grounds which were raised in the examination proceedings but not in the notice of opposition, the observations by the parties or the communications of the Opposition Division, these must be introduced (i.e. raised for discussion) by the Opposition Division in the opposition proceedings before the decision is given so as to afford the parties an opportunity to comment. If the opposition is based on lack of inventive step, the proprietor of the patent must expect that the prior art newly designated in the opposition

proceedings will be considered in conjunction with the prior art described in the introductory part of an independent claim. However, if new facts and grounds are introduced during the proceedings or if the facts and grounds on which the envisaged decision is to be based were not stated so unambiguously and clearly in the written submissions of the parties as to give a party occasion to comment, the party concerned must be given an opportunity to submit an opinion and to produce evidence before the decision is given.

2. Consideration of time limits

A decision may not be given until any time limit set has expired, unless all the parties affected by the time limit expressly agree that it need no longer be observed or have submitted their final opinions before it expires. The decision to grant a patent may be given once the applicant is deemed to have approved the text submitted to him under Rule 71(3) and has fulfilled all other formal requirements, even if the time limit set in the Rule 71(3) communication has not yet expired.

Moreover, as a rule, decisions should not be given until an internal EPO time limit (e.g. 20 days) following upon the official time limit (but from which the parties may derive no rights) has expired, so as to ensure that documents received at the end of the period officially allowed have actually been entered in the files when the decision is being taken and can be taken into account in the decision.

With reference to submissions and applications received after expiry of a time limit, see VIII, 1.8.

3. Authoritative text of documents

Art. 113(2)

The EPO must decide upon the European patent application or the European patent only in the text submitted and agreed by the applicant or proprietor and last used as a basis for the proceedings. Consequently, for example, an amended version proposed by the Examining or Opposition Division (see C-VI, 14.1 and 14.2 and D-VI, 4.2 and 7.2) may only be adopted as a basis for the decision if it has been approved by the applicant or proprietor.

In the case of one or more subsidiary request(s) (sometimes referred to as "auxiliary requests") directed to alternative texts for grant or maintenance of a patent, every such request qualifies as a text submitted or agreed by the applicant or proprietor within the meaning of Art. 113(2) (see T 234/86, OJ 3/1989, 79), and therefore must be dealt with in the order indicated or agreed to by the applicant or proprietor, up to and including the highest-ranking allowable request, if any.

When considering such requests it is essential that they are treated in the correct order. Thus, for instance, if the only allowable request is an auxiliary request, but is accompanied by a higher auxiliary request for oral proceedings (e.g. a request that oral proceedings be held if

the main request cannot be granted) then a communication under Rule 71(3) could not be issued on the basis of the allowable request, but instead oral proceedings in accordance with the higher request would have to be appointed, or a further communication under Rule 71(1) issued (see X, 5). If the order of the requests is not clear from the applicant's submissions, then it would be necessary to contact the applicant to clarify the situation before proceeding.

4. Written form of decisions

4.1 General remarks

Decisions are to be produced in writing. The same applies to decisions delivered at the end of oral proceedings (see III, 9). *Rule 111(1)*

No complete rules can be laid down about the form and content of decisions, which will depend on the requirements of each particular case.

The written decision will contain:

– the names of the parties to the proceedings (applicant, proprietor, opponents) and, if applicable, their representatives;

– the order, and, if necessary;

– the facts and submissions;

– the reasoning;

– the communication of the possibility of appeal (Rule 111(2)); and

– the signature(s) and the name(s) of the employee(s) responsible. *Rule 113(1)*

If the decision is produced by the employee responsible using a computer, the EPO seal may replace the signature. If it is produced automatically by a computer the employee's name may also be dispensed with (Rule 113(2)). The file copy contains the names and the actual signature(s) of the employee(s) responsible.

The presentation of the facts and the submissions, the reasoning and the communication of the means of redress are generally omitted when a decision merely meets the requests of all the parties concerned; this applies in particular to the decision to grant, which is based on the documents that the applicant has approved (Rule 71(3)). The same applies when the patent is maintained in an amended form, because this is preceded by a final interlocutory decision pursuant to Art. 106(2) concerning the documents on which the maintenance of the patent is to be based (see D-VI, 7.2.2). In individual cases, consideration may also be given to the reasoning of those decisions which merely meet

the requests of the parties. If, for example, a number of reasons are invoked for a request for re-establishment, of which only one justifies re-establishment, a reasoned decision on re-establishment may be appropriate, in order to clarify the official action.

Even in those cases in which the decision contains no communication of the means of redress, an appeal can be filed if the decision is incorrect, e.g. if the grant was not made on the basis of the documents that the applicant had approved.

4.2 Order

The order may be, for example, as follows:

"The European patent application ... is hereby refused pursuant to Art. 97(2) EPC.";

"The opposition to the European patent ... is hereby rejected."; or

"The request for re-establishment of rights is hereby rejected".

4.3 Facts and submissions

Facts and submissions have to be given insofar as they are significant for the decision.

Under facts, a brief description of the case and a summary of the main reasons on which the decision is based and of the most important replies of the parties should be given. These points, however, are to be covered in detail in the subsequent reasoning. Facts and submissions which are irrelevant to the decision, e.g. requests for amendment which are not maintained, are to be omitted.

The facts and submissions must clearly indicate what is the subject of the application and show on which documents (in particular which claims) the decision is based. The text of the independent claim(s) and other especially important claims or passages of the description on which the decision is based must be cited verbatim in the language of the proceedings (Rule 3(2)). As regards the dependent claims, it may be sufficient to refer to the file content.

4.4 Decision on the file as it stands

Applicants may request a decision "on the file as it stands" or "according to the state of the file", e.g. when all arguments have been sufficiently put forward in the proceedings and the applicant is interested in a speedy appealable decision. In such a case, the decision will be of a standard form, simply referring to the previous communication(s) for its grounds and to the request of the applicant for such a decision.

5. Reasoning of decisions

Art. 113(1)
Rule 111(2)

The reasoning must contain, in logical sequence, those arguments which justify the order. It should be complete and independently comprehensible, i.e. generally without references. If, however, a question has already been raised in detail in a particular communication contained in the file, the reasoning of the decision may be summarised accordingly and reference may be made to the relevant communication for the details.

The conclusions drawn from the facts and evidence, e.g. publications, must be made clear. The parts of a publication which are important for the decision must be cited in such a way that those conclusions can be checked without difficulty. It is not sufficient, for example, merely to assert that the cited publications show that the subject of a claim is known or obvious, or, conversely, do not cast doubt on its patentability; instead, reference should be made to each particular passage in the publications to show why this is the case.

It is particularly important that special attention should be paid to important facts and arguments which may speak against the decision made. If not, the impression might be given that such points have been overlooked. Documents which cover the same facts or arguments may be treated in summary form, in order to avoid unnecessarily long reasoning.

The need for complete and detailed reasoning is especially great when dealing with contentious points which are important for the decision; on the other hand, no unnecessary details or additional reasons should be given which are intended to provide further proof of what has already been proven.

If during **examination proceedings** a main and subsidiary requests have been filed (see X, 3) and none of these is allowable, the reasons for the decision to refuse the application pursuant to Art. 97(2) must not be limited to the main request, but must also comprise the reasons for the non-allowability of each subsidiary request. If one of the requests is allowable, the communication pursuant to Rule 71(3) is to be issued on the basis of the (first) allowable request and must be accompanied by an explanation of the reasons why the higher-ranking requests are not allowable. Should the applicant, in response to the communication pursuant to Rule 71(3), maintain higher-ranking requests which are not allowable, a decision to refuse the application pursuant to Art. 97(2) will be issued; the reasons must set out the grounds for the non-allowability of each request which ranks higher than the allowable request. In respect of the allowable request, the decision to refuse must mention that the applicant has failed to give his approval to it. If the text of the requests maintained is not amended compared to that on file when the communication under Rule 71(3) was issued, then the requirement of Rule 71(4) for filing of translations and payment of fees does not apply. These matters are also dealt with in Legal Advice No. 15/05 (rev. 2), OJ 6/2005, 357.

Similarly, if in **opposition proceedings** the proprietor has submitted in addition to his main request one or more subsidiary requests, none of which is allowable, the patent must be revoked and the decision must set out, in respect of each request submitted and maintained by the proprietor, the reasons for not allowing it. Where one of the proprietor's requests directed to the maintenance of the patent in amended form is allowable, an interlocutory decision is to be issued on the basis of the (first) allowable request; it has to set out the reasons why this request meets the requirements of the EPC and, additionally, the reasons why the higher-ranking requests do not.

Insofar as a decision includes the rejection of any of the multiple requests, such decision may not be taken until the applicant or proprietor has been informed, with respect to each of these requests, of the reasons for not allowing them, so that the applicant or proprietor is not deprived of the opportunity to present comments (Art. 113(1) – right to be heard). Similarly, an opportunity to comment must be granted to the opponent(s) with respect to a subsidiary request before it is held allowable by an interlocutory decision (see D-VI, 7.2).

Practical considerations will determine at which point in the decision the subsidiary request is dealt with. The main emphasis should be laid on dealing with all the independent claims, whereas the reasoning as regards dependent claims does not need to be so detailed, unless special importance is attached to them in any particular case.

Rule 116
Rule 137(3)

If an Examining or Opposition Division has exercised its discretion under Rule 116 to refuse late-filed facts, evidence or requests, its decision must give the reasons for its refusal. A mere reference to the discretionary power given under Rule 116 is not sufficient. The same applies to the exercise of an Examining Division's discretion to refuse amendments under Rule 137(3) (see T 755/96, OJ 4/2000, 174).

There is no strict rule that a decision has to deal with all the points which are or may become contentious between the deciding authority and the parties concerned. For reasons of economy it is, however, appropriate to base a rejection on a number of separate reasons, in order to come as early as possible to a final decision in a case. Therefore an Examining or Opposition Division should deal with those questions which may be expected to become relevant at second instance insofar as this is possible without substantial additional effort, so that, in the event of a successful appeal, the matter does not have to be remitted to the deciding authority by the Board of Appeal.

6. Decisions which do not terminate proceedings – interlocutory decisions

Art. 106(2)

Interlocutory decisions may be given in principle. However, it should be borne in mind that pursuant to Art. 106(2), a decision which does

not terminate proceedings as regards one of the parties can only be appealed together with the final decision, unless the decision allows separate appeal.

The competent department should use its discretion as to the need for an interlocutory decision (see, however, D-VI, 7.2.2 with respect to the interlocutory decision for maintenance of a patent in amended form in opposition proceedings). To avoid fragmentation of the proceedings, such decisions should be the exception rather than the rule and should be given only if the duration or cost of the proceedings as a whole is thereby reduced. The interests of the parties should also be borne in mind as appropriate. In the normal course, an interlocutory decision should be contemplated only for the purpose of ruling that separate appeal may be made, as only in this way can a decision be obtained on a preliminary point before the final decision terminating the proceedings is reached. (The proceedings must be suspended until the decision has become final.) It is especially important to allow separate appeal where the continuation of the proceedings depends on a preliminary ruling on a fundamental point of law, e.g. where different Boards of Appeal have given different rulings or conflicting decisions have been given by different Examining or Opposition Divisions and no decision on appeal has been given in the matter. Interlocutory decisions must state the reasons on which they are taken; if it is decided not to allow separate appeal, the reasons for this ruling may be given only in the final decision.

7. Binding nature of decisions on appeals relating to the same case

If a department has to give a decision in a case which has already been remitted by the Board of Appeal for further prosecution to that department, it is bound by the ratio decidendi of the Board of Appeal, insofar as the facts, e.g. the subject-matter of the patent and the relevant state of the art, are the same. *Art. 111(2)*

An Opposition Division is not bound by a decision of a Board of Appeal on appeal against a decision from an Examining Division (see T 167/93, OJ 6/1997, 229). The exclusive phrasing of the last sentence of Art. 111(2), only mentioning the Examining Division being bound by the decision on appeal against a decision of the Receiving Section, makes this clear. Opposition proceedings are entirely separate from the examination proceedings, and the Opposition Division is entitled to examine the facts, evidence and arguments anew, particularly since another party (the opponent) is now involved. It should, however, take due notice of the assessment of these facts, evidence and arguments as contained in the reasons of the decision of the Board of Appeal.

8. Information as to means of redress

Decisions of the EPO which are open to appeal must be accompanied by a written communication of the possibility of appeal. The communication must also draw the attention of the parties to the *Rule 111(2)*

provisions laid down in Art. 106 to 108 and Rules 97 and 98, the text of which must be attached. The parties may not invoke the omission of the communication.

9. Notification

Art. 119 Decisions must be notified as a matter of course (see I, 2).

10. Correction of errors in decisions

Correction of errors in decisions must be clearly distinguished from correction of errors in documents filed by the applicant (or patentee) pursuant to Rule 139. For the latter, see A-V, 3 and C-VI, 5.4. Correction of errors made by the applicant (or patentee) in application (or patent) documents cannot be arrived at in a roundabout manner through correction of the decision to grant (or maintain in amended form).

Rule 140 Correction of a decision is admissible only if the text of the decision is manifestly other than intended by the department concerned. Thus only linguistic errors, errors of transcription and obvious mistakes in decisions can be corrected.

The documents approved by the applicant for grant or approved by the patentee for maintenance in amended form are part of the decision to grant (see T 850/95, OJ 4/1997, 152) or to maintain in amended form, respectively. If a decision relates to wrong or incomplete documents, e.g. in the case of omission from a granted patent of claims, description parts or drawings which had already been filed as replacements and whose admissibility was never at issue during earlier proceedings, a correction of the text of the description or claims or of the drawings should be allowed.

However, this does not relieve the applicant or patentee from the duty to properly check the documents as proposed for grant or for maintenance in amended form, respectively.

Corrections of decisions are to be made by a decision at the reasoned request of one of the parties or by the EPO of its own motion. If the request for correction is refused, this decision must be reasoned (see T 850/95, OJ 4/1997, 152). These reasons must previously have been communicated to the requester (Art. 113(1)).

Chapter XI

Appeals

1. Suspensive effect

The Boards of Appeal are not bound by any instructions. Therefore this chapter deals in detail only with those questions which are relevant for interlocutory revision. At this stage of the proceedings the department of first instance is still competent.

Art. 23(3)
Art. 109

Appeals shall lie from decisions of the Receiving Section, Examining Divisions, Opposition Divisions and the Legal Division.

Art. 106(1)

An appeal has suspensive effect. This means that decisions may not yet become final and their effects are suspended. As the decision may not then be enforced, the following do not take place: entry in the Register of European Patents, mention in the European Patent Bulletin and, where appropriate, publication of a new specification of the European patent.

2. Appeals after surrender or lapse of the patent

An appeal may be filed against the decision of the Opposition Division even if the European patent has been surrendered or has lapsed for all the designated States.

Rule 98

3. Appeals against the apportionment of costs

The apportionment of costs of opposition proceedings cannot be the sole subject of an appeal. A party to the proceedings who feels that he has been adversely affected by the apportionment of costs may therefore only file an appeal against the decision on costs if he also lodges an appeal against the decision on the opposition on other admissible grounds.

Rule 97(1)

4. Appeals against the decision of the Opposition Division on the fixing of costs

In accordance with Rule 97(2), the decision of the Opposition Division fixing the amount of costs of opposition proceedings may be appealed if the amount is in excess of the fee for appeal.

Rule 97(2)
Art. 13 RFees

5. Persons entitled to appeal and to be parties to appeal proceedings

Any party to proceedings adversely affected by a decision may appeal. Any other parties to the proceedings are parties to the appeal proceedings as of right.

Art. 107

6. Time limit and form of appeal

Notice of appeal must be filed with the EPO within two months of the date of notification of the decision appealed from. The notice is not deemed to have been filed until after the fee for appeal has been paid in the amount laid down in the Rules relating to Fees under the EPC.

Art. 108

Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed.

7. Interlocutory revision

7.1 General remarks

Art. 109(1) If the department whose decision is contested considers the appeal to be admissible and well founded, it must rectify its decision. This does not apply where the appellant is opposed by another party to the proceedings.

The obligation or possibility of rectification may thus arise in connection with a decision by the Receiving Section, the Legal Division or an Examining Division. In opposition proceedings, it only arises in the special case that all the notices of opposition have been withdrawn and the proprietor of the patent files an appeal.

Art. 109(2) After receipt of the statement of grounds, only three months are available for rectification of the decision by the department of the first instance. That department must therefore consider the appeal with the highest priority and start the examination on admissibility immediately, and if the appeal is considered admissible in the form in which it has been filed, the competent department will start its examination on allowability immediately.

The department concerned will rectify its decision if convinced in the light of the grounds of appeal that the appeal is admissible and well founded. This could arise, for example, because:

(i) the department failed to take due account of some of the material available to it at the time the decision was made;

(ii) the department did not receive material filed at the EPO in due time before the issue of the decision, owing to an office error; or

(iii) the decision of the department concerned does not appear to be incorrect, but the applicant presents new information or evidence or files amendments to the application, which overcome the objections of the decision under appeal (see T 139/87, OJ 3/1990, 68).

Hence, in case of newly submitted amendments which meet the substantive objections dealt with in the decision under appeal, the decision must be rectified. This could be the case, for example, if the amendments were ones which were actually suggested by the Examining Division in the course of the proceedings, but which the applicant was previously unwilling to make. If the amendments meet the objections contained in the decision under appeal, but raise new ones not yet discussed, interlocutory revision must also be allowed as the applicant has the right to two instances (see T 219/93, not

published in OJ). The new objections may make it necessary to issue a further communication and/or to arrange for oral proceedings before a further decision is taken (see T 691/91 and T 919/95, neither published in OJ).

For the advantages of a decision covering more than one objection, see X, 5, last paragraph.

7.2 Remittal to the Board of Appeal

If the appeal is not allowed within three months after receipt of the statement of grounds, it must be remitted to the competent Board of Appeal without delay, and without comment as to its merit. *Art. 109(2)*

7.3 Reimbursement of appeal fees

In the event of interlocutory revision, reimbursement of appeal fees will be ordered by the department whose decision has been impugned if such reimbursement is equitable by reason of a substantial procedural violation. This is particularly the case when essential facts or evidence were not taken into consideration in arriving at a decision, e.g. where a document filed at the EPO in good time by the party concerned is not placed in the file before a decision is reached or where the decision is based on facts or evidence on which the party concerned had no opportunity of presenting his comments. *Rule 103(1)(a)* *Art. 109*

If the decision is rectified by an interlocutory revision not because of any substantial procedural violation but e.g. because the party concerned submits amendments at the time of filing the appeal, there will be no reimbursement of appeal fees.

If the department whose decision is contested considers the requirements of Art. 109 for interlocutory revision to be fulfilled, but not the requirements of Rule 103(1)(a) for reimbursement of the appeal fee, it must rectify its decision and remit the request for reimbursement of the appeal fee to the board of appeal for a decision (see J 32/95, OJ 12/1999, 713).

The request for reimbursement of the appeal fee will be remitted to the board of appeal only if it was filed together with the appeal (see G 3/03 and T 21/02)

Where amendments have been filed (i.e. interlocutory revision must be carried out) but a substantial procedural violation has occurred, the appeal fee is to be reimbursed, even if this was not explicitly requested by the appellant (see G 3/03).

8. Rules of Procedure for the departments of second instance

Details of the procedure before the Boards of Appeal can be found in the Rules of Procedure of the Boards of Appeal (OJ 3/2003, 89). The Enlarged Board of Appeal has also adopted Rules of Procedure (OJ 5/2007, 303).

Chapter XII

Request from a national court for a technical opinion concerning a European patent

1. General

Art. 25

At the request of the competent national court trying an infringement or revocation action, the EPO is obliged, against payment of an appropriate fee, to give a technical opinion concerning the European patent which is the subject of the action. The Examining Divisions are responsible for the issue of such opinions.

Only requests from a national court in a Contracting State will be accepted by the EPO. It is not, however, up to the EPO to check whether the requesting court is "competent" to deal with the action or not. The Examining Division, however, should check whether a European patent is the "subject of the action".

The Examining Division responsible for the technical opinion should give the parties an opportunity to submit arguments in writing if the court so permits. However, the parties have no right to be heard before the EPO. Nevertheless, where the Examining Division considers it necessary, it may invite the parties, via the court and provided that the court so permits, either to be heard before the Examining Division or to submit supplementary observations on specific points identified by the Examining Division. If the parties are heard, such a hearing is not considered to constitute oral proceedings within the meaning of Art. 116.

The technical opinion is not a decision of the EPO. The parties to the national proceedings therefore have no right of appeal before the EPO against an unfavourable opinion.

2. Scope of the technical opinion

The Examining Division is obliged to give a "technical opinion" upon request. This means that the Division is bound to give an opinion only insofar as the questions put are of a technical character. However, the Examining Division should not be too restrictive in this regard but should attempt to assist the national court as much as is reasonably possible, while remembering that the actual decision on infringement or revocation is exclusively a matter for the national court.

Generally speaking, the Examining Division should attempt to give a technical opinion on any question which is similar to those normally dealt with in European substantive examination work, even when the question has a legal, as well as a technical, aspect. On the other hand, the Examining Division should decline to make any specific statement on whether a patent is valid or on whether it is infringed. It

should also not give any opinion on the extent of protection (Art. 69 and the accompanying Protocol).

A request from a national court is to be expected to be clearly and precisely formulated, so that the Examining Division will be in no doubt as to the questions on which the court wishes to have an opinion. Since the court is responsible for deciding the issues of law involved in the questions and since most questions include a mixture of legal and technical aspects, the court is expected where possible to separate clearly the legal aspects from the technical aspects upon which it seeks the opinion of the EPO.

3. Composition and duties of the Examining Division

3.1 Composition

The composition of the Examining Division to which the request is referred must be as defined in Art. 18(2). This means that the Division must include three technical examiners; normally a legally qualified examiner will also be included. The main responsibility for dealing with the request up to the time of formulating the opinion is entrusted to one technical examiner, hereinafter referred to as the "primary examiner".

In order to guarantee that the opinion given is not influenced by earlier proceedings within the EPO on the application/patent in question, examiners who have taken part in such earlier proceedings as members of an Examining or Opposition Division should be excluded from the Examining Division set up under Art. 25. Where this is not practicable, the national court and the parties should be informed of the proposed members of the Examining Division under Art. 25 and of which among these members participated in European examination or opposition proceedings on the case. The court should be asked to state whether, in the circumstances, the request for a technical opinion is maintained.

3.2 Duties

The primary examiner will act on behalf of the Examining Division and will normally be responsible for issuing communications to the court. The primary examiner should also draft the written opinion and should circulate the draft to the other members of the Examining Division for consideration. If any changes are proposed in the draft and there are differences of view on such changes, the Chairman should arrange a meeting to resolve the matter. The final opinion should be signed by all members of the Division.

4. Language to be used

In principle the language to be used should be the language of the proceedings of the European patent; however, if the court so requests, another official language of the EPO may be used. At least the request itself, any submissions from the parties, and any amendments to the patent should be in that language or translated

into that language. The opinion should also be produced in that language. However, where appropriate, the Examining Division should pay regard to the provisions of Art. 70(2) to (4).

Regarding documents to be used as evidence, the provisions of Rule 3(3) apply (see A-VIII, 3).

The court or the parties are responsible for providing any translations which may be required to satisfy the above conditions.

5. Procedure

It is envisaged that the procedure will normally involve the following stages.

5.1 Formalities check

The formalities officer will check whether the fee has been paid and whether there are any obvious deficiencies as to the language requirements. If there are any deficiencies in these respects, the formalities officer will write to the national court informing it that no substantive work on the opinion will begin until the deficiencies have been remedied. However, no time limit can be imposed on the court. *Art. 2, No. 20, RFees*

If the file indicates that the court permits the parties to submit written arguments to the EPO and such arguments are not already on the file, the formalities officer will write via the court to the parties giving them a time limit (say two months) for submitting such arguments.

5.2 Preliminary examination

When the formal requirements have been met, and, where appropriate, the arguments of the parties are on file, the case will be referred to the directorate responsible for the technical field of the patent in order for the Examining Division to be established. Assuming that an Examining Division consisting entirely of new members can be formed or, where this is not possible, that the court maintains its request for a technical opinion (see XII, 3), the primary examiner will perform a preliminary examination to determine whether:

(i) the questions put by the national court are such as the Examining Division is competent to answer, at least in part; and

(ii) the papers filed are sufficiently complete and the necessary translations have also been filed.

If there are any deficiencies in these respects, the primary examiner will write to the national court accordingly.

5.3 Withdrawal of the request

If the request for a technical opinion is withdrawn before the Examining Division starts any substantive work on the opinion, 75% of the fee will be refunded. *Art. 10 RFees*

5.4 Establishment and issue of the technical opinion

After any deficiencies as referred to in XII, 5.1 or 5.2, above have been met, the Examining Division should establish the technical opinion as soon as possible.

The opinion should be sent to the national court. Any papers received from the court which belong to the national proceedings should be sent back with the opinion.

5.5 File inspection

The file of a request for a technical opinion is not a file within the meaning of Art. 128 and is not available for file inspection.

5.6 Appearance before the national court

If, after the opinion is issued, the national court asks the Examining Division to appear before it, the court should be informed that the EPO is willing to send one member of the Division provided that his costs are paid and on the understanding that this member will be required only to answer questions on the technical opinion given and will not be required to give an opinion on additional matters unless notice in writing of these additional matters is given to the Examining Division at least one month before the appearance before the court.

Chapter XIII

Registering transfers, licences, other rights, etc.

1. Transfer of the European patent application

A European patent application may be transferred for one or more of the designated contracting states. *Art. 71*

Without prejudice to Art. 72, the transfer of a European patent application is recorded in the Register of European Patents at the request of an interested party and on production of documents satisfying the EPO that such transfer has taken place. The request is deemed not to have been filed until such time as the prescribed administrative fee has been paid. *Rule 22(1) and (2)*

Any kind of written evidence suitable to prove the transfer is admissible. A declaration signed by both parties is appropriate, but a declaration of transfer signed by the assignor would in any case be sufficient, as the assignee will in any case be notified by the EPO of the entry in the Register. Formal documentary proof (originals or certified copies), such as the instrument of transfer or official documents verifying the transfer or extracts thereof, are equally appropriate.

If the evidence presented is found to be unsatisfactory, the EPO informs the party requesting the transfer accordingly, and invites it to remedy the stated deficiencies.

If the request complies with the requirements of Rule 22(1), the transfer is registered with the date on which the request, the required evidence or the fee has been received by the EPO, whichever is the latest.

On the above date, the transfer becomes effective vis-à-vis the EPO, i.e. from that date the newly registered applicant is entitled to exercise the right to the European patent application in proceedings before the EPO (Art. 60(3)). If the transfer was for certain designated states only, Art. 118 applies. *Rule 22(3)*

The competent department for adverse decisions regarding entries in the Register of European Patents is the Legal Division. *Art. 20*

2. Transfer of the European patent

The above applies mutatis mutandis to the registration of a transfer of the European patent during the opposition period or during opposition proceedings. *Rule 85*

3. Licences and other rights

Art. 71
Art. 73
Rule 23(1)
Rule 24(a) and (b)

A European patent application may give rise to rights in rem, may be licensed and may be the subject of legal means of execution. Rule 22(1) and (2) apply mutatis mutandis to the registration of the grant, establishment or transfer of such rights (see XIII, 1).

A licence will be recorded in the Register of European Patents as an exclusive licence if the applicant and the licensee so require. A licence will be recorded as a sub-licence where it is granted by a licensee whose licence is recorded in the Register of European Patents.

Rule 22(2)
Rule 23(2)

Upon request and subject to the payment of the prescribed administrative fee, registered licences and other rights are cancelled on production of documents satisfying the EPO that the right has lapsed, or of a declaration of the proprietor of the right that he consents to the cancellation.

4. Change of name

Changes in the name of the applicant for or proprietor of a European patent must be entered in the Register on production of supporting evidence (e.g. copy from the commercial register).